

Exhibit H - Part One



Baker&Hostetler LLP

Washington Square, Suite 1100
1050 Connecticut Avenue, N.W.
Washington, DC 20036-5403

T 202.861.1500
F 202.861.1783
www.bakerlaw.com

Andrew M. Grossman
direct dial: 202.861.1697
agrossman@bakerlaw.com

July 9, 2018

VIA CERTIFIED MAIL

General Counsel
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Re: Freedom of Information Appeal for Request No. F-18-00014 (Modification and Fee Waiver Request)

Dear FOIA Appeals Officer:

I represent Gilbert P. Hyatt. Mr. Hyatt hereby appeals the United States Patent and Trademark Office's ("PTO") Decision of May 25, 2018, denying Mr. Hyatt's request for a fee waiver and determination concerning commercial use for FOIA Request No. F-18-00014, as modified.

Background

On February 12, 2018, Mr. Hyatt filed a FOIA request seeking documents from certain current and former PTO personnel. Ex. AA. Following the recommendations and advice of PTO FOIA personnel, Mr. Hyatt narrowed that request to seek only the following:

All records concerning Mr. Hyatt or his patent applications created by, sent by, or received by (a) Diego Gutierrez during 2012 and 2013 or (b) Gregory Morse from and including 2013 through 2018, excluding (1) email attachments, (2) documents contained in the file histories of Mr. Hyatt's applications, and (3) drafts of documents contained in the file histories of Mr. Hyatt's applications.

Copies of all Performance Appraisal Plans for, and signed by, Examiner Walter Briney for fiscal years 2013, 2014, 2015, 2016, 2017, and 2018.

General Counsel

July 9, 2018

Page 2

Ex. BB. Mr. Hyatt requested that the PTO grant a fee waiver in the public interest and determine that the request is not one for a commercial use. In support, Mr. Hyatt submitted a sworn statement, accompanied by voluminous documentation, explaining in detail how the PTO has engaged in misconduct in the examination of his pending and abandoned patent applications, how it has withheld from the public important information about its treatment of patent applicants and applications, how he intends to use the requested documents to make the public aware of the PTO's hitherto undisclosed operations and misconduct, and how the PTO has recognized that Mr. Hyatt's patent applications and their prosecution are matters of public interest.

The PTO denied Mr. Hyatt's fee waiver and non-commercial use determination request on May 25, 2018. Ex. CC. The PTO's decision ignored entirely Mr. Hyatt's FOIA request for performance plans, without producing records responsive to that request.

Mr. Hyatt now timely appeals from the May 25 Decision pursuant to 37 C.F.R. § 102.10.

Discussion

I. Mr. Hyatt Is Entitled to a Fee Waiver for His Modified Request

In his modified request, Mr. Hyatt explained that he was entitled to a fee waiver under the criteria set forth at 5 U.S.C. § 552(a)(4)(A)(iii) because “[d]isclosure of the [requested] information is in the public interest because it is likely to contribute significantly to public understanding of the operations or activities of the government and is not primarily in the commercial interest of the requester.” *Cf.* 37 C.F.R. § 102.11(k)(1)(ii).

As to the first factor, the subject matter of the request, Mr. Hyatt explained that the records specifically concern identifiable operations or activities of the government in the form of the management and operation of Art Unit 2615 and the examination of Mr. Hyatt's patent applications. Ex. BB, p. 3. The PTO's May 25 decision did not dispute this contention, which weighs in favor of granting the fee-waiver request.

Regarding the second factor, Mr. Hyatt explained that the request will contribute to an understanding of those government operations and activities because the requested records will show how the persons responsible for establishing and managing Art Unit 2615 performed their duties. Mr. Hyatt further explained that the request will shed light on PTO policies related to “sensitive” applications. Finally, Mr. Hyatt explained that this information is not in the public domain. Ex. BB, p. 3.

The PTO's May 25 decision erroneously found that this second factor does not support Mr. Hyatt's fee-waiver request because his request is too narrowly tailored and focused on Mr. Hyatt and based on the PTO's purported lack of understanding about how records concerning Mr. Hyatt and his applications would contribute to an increased public understanding of government operations and activities. Ex. CC, pp. 2–4. The reasoning of the May 25 Decision is meritless on both counts.

General Counsel

July 9, 2018

Page 3

The PTO correctly does not dispute that the examination of Mr. Hyatt's patent applications, and the management and operation of Art Unit 2615, is an activity or operation of the Office. Accordingly, responsive documents will contribute to the understanding of government operations and activities related to its performance of official business presented to the office by Mr. Hyatt and his patent applications, regardless of whether the PTO believes that the request is narrowly tailored and focused on Mr. Hyatt.

In addition, the disclosure of the requested materials would greatly assist the public in understanding the government's operations and activities. The PTO's actions in purporting to examine Mr. Hyatt's patent applications are themselves a government activity of public interest. The PTO established an Art Unit to deal primarily, if not exclusively, with Mr. Hyatt's patent applications. Ex. DD, p. 9. This Art Unit is called the Hyatt Unit by its examiners. *Id.* The Hyatt Unit is such a prominent part of the PTO's operations that it employed 20 percent of the GS-15 examiners in the entire Office at the time it was established. As opposed to other GS-14 and GS-15 primary examiners in other art units, all Hyatt Unit GS-15 examiners lack Signatory Authority for action on Mr. Hyatt's applications, requiring higher PTO officials to approve their actions. Ex. DD, p. 120. The Supervisor of the Hyatt Unit testified that since October 2012, the PTO expended in just the examiners' salaries "about \$10 million." Ex. BB, p. 150. In fact, the PTO argued in its unsuccessful attempt to have several of Mr. Hyatt's legal actions against the PTO dismissed for prosecution laches that "Mr. Hyatt's applications have tied up the resources of many examiners, including an entire art unit since 2013, dedicated to examining his applications. But for Mr. Hyatt's [] conduct, these resources could have been used to examine the applications of other patent applicants." Ex. EE, p. 50. The public has a compelling interest in understanding whether these resources are being utilized appropriately by the PTO. Also, as explained below with respect to the third factor, the PTO itself has recognized repeatedly that the public has an interest in the prosecution and examination of Mr. Hyatt's applications.

Moreover, the requested materials concerning Mr. Hyatt's applications are necessarily relevant broadly because PTO officials have offered sworn testimony that it purports to have treated his applications under the same policies and rules that it applied to other applicants.¹ Such disclosure is "meaningfully informative about Government operations or activities"

¹ PTO supervisors testified that Mr. Hyatt's applications were subject to the same policies and rules as applied to other applicants: Ex. FF, p. 12 ("Q. Was the MPEP an examination policy that applied regarding Mr. Hyatt's patent applications? A. Well, MPEP is our guidance for all applications, as you know. Q. Including Mr. Hyatt's applications? A. Yes, I mean, on the examination policy."); *Id.* ("Q. My question was whether there were any portions of the MPEP that did not apply as examination policy for Mr. Hyatt's patent applications. A. I don't think so, ... , again, our goal was, you know, to apply MPEP on every case."); *Id.* at p. 74 ("Q ... you have told us how the issues in these three cases are -- would significantly impact Mr. Hyatt's applications. Would they impact other applications in the same way? A I don't think the rules would be different for anyone else.").

General Counsel

July 9, 2018

Page 4

with respect to other applicants and therefore “is likely to contribute significantly to public understanding of the operations or activities of the government.”

Finally, as to this factor, the records requested will contribute to public understanding of how the PTO views and exercises its authority in its treatment of disfavored patent applicants and applications.

The third factor, how “disclosure will contribute to the understanding of a reasonably broad audience of persons interested in the subject,” was likewise satisfied as Mr. Hyatt explained that he intends and has made concrete plans to disseminate the information obtained through Internet publication, collaboration with news media, and collaboration with nonprofit organizations that work on government accountability, intellectual property, and regulatory reform issues. Ex. BB, pp. 7–9. The PTO erroneously found against Mr. Hyatt on this factor.

The PTO’s claim that the records would not be disseminated to a broad audience of persons interested in the subject because Mr. Hyatt did not provide information about how many people had viewed the ACET website fails. Presumably what the PTO meant is not that website-viewer information is required, but that Mr. Hyatt either did not demonstrate sufficient indication of public interest in Mr. Hyatt’s patent applications and his treatment by the PTO or did not demonstrate sufficient ability to convey the information to the public. Either way, the PTO’s rationale is incorrect.

The PTO’s belief that the ACET website is an unsuitable vehicle for facilitating public understanding of the PTO’s conduct is wrong. For example, the PTO claims that the “ACET website appears to be a single issue website and the sole subject of its content is Mr. Hyatt.” In fact, the leading topics of the ACET website involve the Paperwork Reduction Act (“PRA”) in two separate projects, “OMB Accountability,”² and “USPTO Accountability,”³ which also includes records from the PTO SAWS program. Numerous agency responses to FOIA requests have been posted on these pages since 2016 and none of these involve Mr. Hyatt or his applications.

Similarly, the PTO’s claim that “the ACET blog only has four entries ... suggests interest on this matter is quite limited” is without basis. For example, one of the ACET blog entries titled “*PRA-101 — The procedures, scope, and power of the Paperwork Reduction Act*”⁴ is a general informational piece of broad interest to any person interested in the workings of the PRA. And another blog entry titled “*OMB’s obscure exemption of USPTO ‘bootleg’ information Collection presently reaching \$3 billion per year*”⁵ is also “disseminated to a broad audience of

² See <http://acet-usa.org/omb/>.

³ See <http://acet-usa.org/uspto/>.

⁴ At <http://acet-usa.org/pr-101-the-procedures-scope-and-power-of-the-paperwork-reduction-act/>.

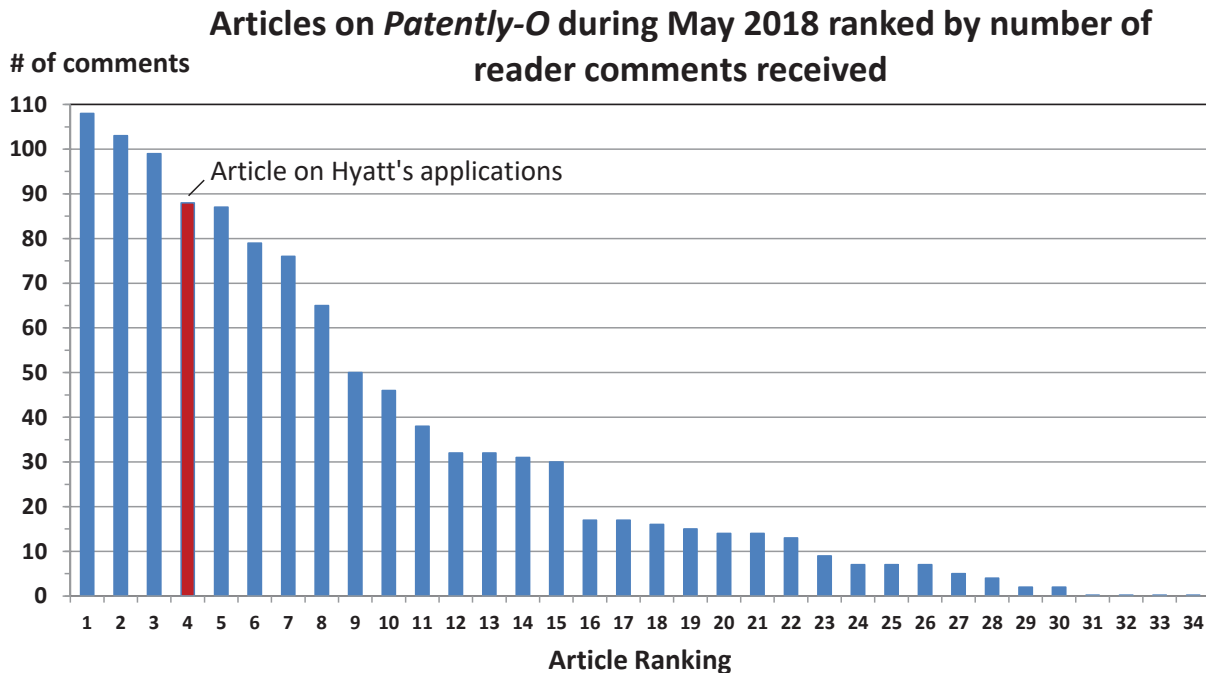
⁵ At <http://acet-usa.org/omb-bootleg-exemption/>.

General Counsel

July 9, 2018

Page 5

persons interested in the subject,” as the financial magnitude of the alleged PRA violation is comparable to the annual budget of the entire agency.



Mr. Hyatt’s patent applications, and the treatment of those applications and him personally, has been a matter of significant public attention over the years. The intellectual property trade press and even such national publications as *USA Today* publish articles about Mr. Hyatt, his applications, and the legal disputes between him and the Office related to those applications. Ex. GG (collecting articles). These articles themselves often attract public interest, with one recent article concerning Mr. Hyatt’s mandamus lawsuit alleging PTO misconduct in the examination of his applications prompting 87 comments from interested members of the public.⁶ As the figure above shows, this article ranked No. 4 out of 34 articles posted during May 2018 on *Patently-O*, indicating a substantially “broad audience of persons interested in the subject.” PTO management are sufficiently aware of the public attention that Mr. Hyatt and his patent applications have engendered that they actually circulate press about Mr. Hyatt internally. Ex. HH (collecting press-circulating emails).

The PTO’s treatment of Mr. Hyatt’s applications is also a matter of particular public interest for Congress. In June 2012, then-PTO Director David Kappos testified before the Senate Judiciary Committee. A Question for the Record was submitted to Mr. Kappos by the

⁶ Dennis Crouch, *Hyatt v. USPTO: Mandamus Action Requesting an Impartial Administrative Review*, *Patently-O* (May 22, 2018), <https://patentlyo.com/patent/2018/05/requesting-impartial-administrative.html> (last visited June 5, 2018).

General Counsel

July 9, 2018

Page 6

Committee Chairman inquiring about the hundreds of pending “pre-1995” applications and expressing his understanding that “they are pending because of delaying tactics by the applicants.” In his written response, then-Director Kappos stated that “[t]here are currently 491 such applications pending, with 381 of these being held by a single individual. These applications have been the source of some frustration within the Office; ... [applicant] delaying tactic[s] ha[ve] contributed to the long pendency of many of the applications at issue. Nevertheless, the USPTO has made significant progress in examining them in the last few years and is continuing to work diligently to enter final rejections and/or allowances in the remaining cases.” Ex. II, p. 25.

Director Kappos’ reference to the single individual holding the 381 applications was to Mr. Hyatt, as revealed by a PTO letter sent in June 2013 to the Judiciary Committees of both chambers of Congress. Director Kappos’ testimony on Mr. Hyatt’s applications that “*the USPTO has made significant progress in examining them in the last few years*” misrepresents the reality of the PTO’s actions, as the PTO had in fact suspended examination of Mr. Hyatt’s applications in the years preceding his testimony and had generally not acted on them since 2003. The public interest in disclosure of the true facts related to Mr. Hyatt’s applications is at its height when such disclosure can help set the record straight concerning Mr. Hyatt’s applications.

Moreover, as Mr. Hyatt explained, the PTO has repeatedly argued to various courts that Mr. Hyatt’s prosecution conduct is a matter of public interest. In addition to the examples that Mr. Hyatt provided in his declaration, Ex. BB, p. 10, the PTO has represented to the United States Court of Appeals for the Federal Circuit that there is a “‘considerable public interest’ implicated by [Mr. Hyatt’s] applications.” Ex. JJ, pp. 22–23. Likewise, the PTO has argued that Mr. Hyatt’s prosecution conduct has caused “negative consequences...to the public and the patent system.” Ex. KK, p. 5. It is arbitrary and self-serving at best, and prejudicial and discriminatory at worst, for the PTO to argue that Mr. Hyatt should not have the ability to obtain patent protection for his inventions because those inventions implicate vast public interest, while arguing that there is no public interest in information regarding the PTO’s treatment of those applications and of Mr. Hyatt as an applicant.

The PTO’s suggestion that Mr. Hyatt does not intend to disclose the requested records because 300 of his patent applications are unpublished is a non sequitur and is contrary to undisputed (and undisputable) facts. The request in question seeks certain performance plans and certain records from Messrs. Morse and Gutierrez, but specifically excludes email attachments and documents in the file histories of Mr. Hyatt’s applications. The “unpublished patent applications” that the PTO’s decision mentions are “contained in the file histories of Mr. Hyatt’s applications” and therefore are outside the scope of the request. It is further worth noting that the specifications for every one of Mr. Hyatt’s patent applications are, in fact, publicly available either because a patent whose claims are described in the specification has issued or because the specification is part of the public docket in *Hyatt v. Iancu*, Nos. 05-2310, 09-1864, 09-1869, and 09-1872 (D.D.C.).

General Counsel

July 9, 2018

Page 7

If the PTO is not simply mistaken on this point but instead is claiming that disclosure of the requested records will not contribute to the understanding of a reasonably broad audience of interested persons unless Mr. Hyatt also waives his statutory right to confidentiality under 35 U.S.C. § 122(a) as to other application materials that are not subject to this request, then the PTO is acting in a frivolous and arbitrary manner and seeking to impose an unlawful condition on Mr. Hyatt. The PTO's statutory duty under 35 U.S.C. § 122(a) to keep applications confidential except where "necessary to carry out the provisions of an Act of Congress or in such special circumstances as may be determined by the Director" has nothing to do with whether disclosure of the requested documents will assist the public in understanding how a PTO unit that includes 20 percent of the Office's GS-15 grade examiners is carrying out its activities. And the PTO has no authority to condition the disclosure of records on Mr. Hyatt forfeiting his rights under 35 U.S.C. § 122(a).

To the extent that the PTO is suggesting that, contrary to his sworn statement, Mr. Hyatt does not actually intend to make publicly available the records that he receives, then the PTO is acting arbitrarily and contrary to the record. Mr. Hyatt offered a sworn statement that he intends to make records available to the public, and the PTO has identified no basis to disregard Mr. Hyatt's sworn statement. *Hensley v. United States*, 292 F. Supp. 3d 399, 411 (D.D.C. 2018) ("conclusory statements" that make no findings of fact regarding credibility or fraud as to why an agency discounted a sworn affidavit in an agency proceeding where affidavit "would establish...claim" is an abuse of discretion). And the PTO knows that Mr. Hyatt has been attempting to make publicly available other documents evidencing PTO misconduct that are already in his possession by motion in the *Hyatt v. Iancu* cases currently pending in federal district court, *see* Ex. JJ, *because the PTO has been opposing Mr. Hyatt's efforts in an attempt to prevent the public from learning about its misconduct*. The PTO's consistently expressed desire to shield its unfair and unlawful treatment of Mr. Hyatt and his applications from public scrutiny is not shared by Mr. Hyatt, as the agency is well aware.

In this regard, the PTO's assertion that Mr. Hyatt would not disseminate the materials on the <http://www.ptomisconduct.com> website because he had not done so at the time of the request only reinforces the PTO's bad faith in dismissing Mr. Hyatt's sworn statement that he intends to disseminate records. As a moment's research would have revealed, the alleged "black and white picture of a drunk and falling cat" is the default parked domain page for websites hosted by Dreamhost, a large, commercial web hosting service. What the "falling cat" image means is that Mr. Hyatt had purchased the "ptomisconduct.com" domain, arranged domain name system service for it, and arranged a web server to serve content to the public—the preliminary technical steps that are prerequisites to disseminating information online. Since filing his modified request, Mr. Hyatt has populated the <http://www.ptomisconduct.com> website with materials related to the PTO's misconduct

General Counsel

July 9, 2018

Page 8

towards him and plans to post additional materials and information over the coming weeks and months.⁷

The fourth factor, that disclosure is likely to contribute significantly to the public understanding of Government operations or activities, is likewise satisfied because, absent disclosure, the public will know little to nothing about the management and operation of Art Unit 2615, an important component of the PTO. The erroneous understanding of the Senate Judiciary Committee Chairman that pre-GATT applications “are pending because of delaying tactics by the applicants,” and not by the PTO, manifests the large gap in public knowledge on the subject, indicating that the “public’s understanding of the subject in question must be significantly enhanced by the disclosure” of the true facts.

The PTO’s May 25 decision that this factor is not satisfied because “[m]erely focusing on issues that directly affect oneself is not indicative of information that would necessarily contribute significantly to the public understanding of Government operation or activities” is entirely wrong. Ex. CC, p. 4. Government misconduct that affects a discrete individual, whether it be a single individual subjected to physical violence, a single individual subjected to unlawful surveillance, or a single individual subject to government misconduct in the patent examination process, is highly informative to the public. In this instance, the records requested will help the public understand how the PTO views the extent of its legal authority and discretion and how it wields that authority against inventors and, in particular, Mr. Hyatt, whose long-pending applications are, according to the PTO, a matter of public interest. And, again, given that the PTO has conceded that the operation of Art Unit 2615 in examining Mr. Hyatt’s patent applications is a government operation or activity, the PTO cannot maintain an objection to the fee waiver on the basis that documents pertaining to this function would not enhance public understanding of government operations.

The final factor, whether disclosure is primarily in the commercial interest of Mr. Hyatt, likewise favors a fee waiver, as the PTO has consistently maintained that any possible bad faith or misconduct on its part in the handling of Mr. Hyatt’s patent applications is legally irrelevant to their merit and issuance and that its handling of his applications is guided by law and necessity alone. The PTO’s May 25 decision ignored entirely the PTO’s position on the relevance of the requested documents to the issuance of any patent application, simply finding that “Mr. Hyatt’s interest is purely commercial, as Mr. Hyatt currently has several pending lawsuits against the USPTO.” The May 25 decision relies on PTO FOIA regulations that define commercial interest to “include furthering those interests through litigation,” 37 C.F.R. § 102.11(b)(1). But neither the FOIA itself nor the OMB FOIA fee

⁷ The PTO’s contention that the cat in the default parked domain page was “drunk” evidences its lack of professionalism in processing Mr. Hyatt’s request, as nothing in the request or default parked domain page related to alcohol; as a moment’s research would have revealed, according to Dreamhost, the cat was tired.

General Counsel

July 9, 2018

Page 9

guidelines—to which agency regulations must conform⁸—include litigation interests in the definition of commercial interests. *See* Office of Mgmt. & Budget, *Uniform FOIA Fee Schedule & Guidelines*, 52 Fed. Reg. 10,012, 10,017–18 (Mar. 27, 1987) (interpreting “commercial use” in 5 U.S.C. § 552(a)(4)(A)(ii) as a use that “furthers the commercial, trade or profit interests of the requester”). In so doing, the OMB specifically revised the definition of “commercial use,” by deleting the term “related to” commerce, to avoid “too tenuous a connection.” *Id.* at 10,013.

The PTO’s May 25 decision invoking the existence of litigation relies on “too tenuous a connection.” Mr. Hyatt’s interest in the information is not rendered “commercial” merely based on the possibility that the information could help him in litigation. *See McClellan Ecological Seepage Situation v. Carlucci*, 835 F.2d 1282, 1285 (9th Cir. 1987) (holding that FOIA “[i]nformation helpful to a tort claim furthers a requester’s interest in compensation or retribution, but not an interest in commerce, trade, or profit”); *McClain v. U.S. Dep’t of Justice*, 13 F.3d 220, 220 (7th Cir. 1993) (“McClain sought the documents primarily to facilitate a challenge to his conviction; this is not a ‘commercial’ interest.”).

In fact, the records sought by the request could not even be used in most of Mr. Hyatt’s pending lawsuits. *Hyatt v. PTO*, No. 17-1722 (Fed. Cir.), is an APA lawsuit concerning the lawfulness of an MPEP provision concerning the reopening of prosecution and, if Mr. Hyatt is successful in his appeal, will be decided on the administrative record. *Hyatt v. Iancu*, Nos. 05-2310, 09-1864, and 09-1872 (D.D.C.), have already been tried on the merits and the time for evidentiary submissions is closed. *Hyatt v. Iancu*, No. 09-1869 (D.D.C.) was resolved in the PTO’s favor on summary judgment and is awaiting entry of judgment. Only *Hyatt v. PTO*, No. 1:18-cv-00546-TSE-MSN (E.D. Va.) is pending, and the Federal Rules of Civil Procedure provide that Mr. Hyatt will be entitled to conduct discovery of evidence relating to any legally viable claims in that lawsuit. Accordingly, that lawsuit (even assuming that it relates to some commercial interest as opposed to enforcement of Mr. Hyatt’s statutory and constitutional rights) does not depend in any way on the PTO’s response to Mr. Hyatt’s FOIA request.

Rozet v. HUD, 59 F. Supp. 2d 55 (D.D.C. 1997), which the PTO relies on exclusively for its commercial interest analysis, is inapposite. In that case, the Department of Housing and Urban Development had been sued by a FOIA applicant and several of his corporations for fraud, with the FOIA applicant shortly thereafter filing FOIA requests for information about himself, his corporations, and HUD press releases about the applicant and his corporations. Unlike the *Rozet* FOIA applicant, Mr. Hyatt does not have ongoing commercial interests related to his patent applications and, while he would like to obtain patent protection for his inventions and to commercialize technology that he believes would improve the lives of his fellow Americans, the documents he seeks pertain to examiner practices and procedural matters, not to the merits of the technology described or claimed in his patent applications

⁸ The FOIA empowers OMB to promulgate “guidelines ... which shall provide for a uniform schedule of fees for all agencies.” 5 U.S.C. § 552(a)(4)(A)(i).

General Counsel

July 9, 2018

Page 10

or the merits of the patent claims contained in those applications. Likewise, there was no indication in *Rozet* that the FOIA applicant had been the subject of significant government misconduct for an extended period of time, that the FOIA applicant had expressed his intention to make records available to the public through concrete publication, that the applicant's request excluded (as Mr. Hyatt's does) matters pertaining directly to any ostensible commercial interest, and that the public was interested in the underlying subject matter of the request.

Moreover, disclosure related to the government's violation of a citizen's rights, including his constitutional rights, is not inherently commercial at all.

Finally, Mr. Hyatt is 80 years old and has been subject to significant PTO misconduct for decades. At this point, Mr. Hyatt's primary interest is not commercial but instead is in publicly exposing the PTO's misconduct towards him. Even if there were a commercial interest in the request, it would be dwarfed by Mr. Hyatt's interest in exposing PTO misconduct.

II. Mr. Hyatt Does Not Intend To Put the Records to Commercial Use

Mr. Hyatt does not intend to put the records to a commercial use, but instead to understand the PTO's unusual actions on his applications, understand how the PTO has treated and is treating applications that it has identified as "sensitive," assess any violations of his rights, inform the public of those things so as to advance public understanding, hold to account those responsible for any misconduct, and ensure that similar misconduct is averted in the future.

The PTO's commercial-use determination is erroneous for many of the reasons described above in conjunction with the commercial interest component of the fee-waiver analysis.

In addition, the PTO improperly dismisses the public interest in disclosure of information regarding the PTO's SAWS program. The PTO tacitly acknowledges that the SAWS program is of interest to the public but asserts that "this program was terminated over three years ago; thus, it is hard to fathom how information about the program today would really inform the public about 'important operations that have not been meaningfully disclosed.'" But the patent community continues to be interested in the operation of the secret SAWS program,⁹ and the PTO has never disclosed much information on its operation, especially

⁹ In fact, the SAWS program is the subject of ongoing FOIA litigation brought by members of the patent community to shed more light on the program and class litigation based on its effect on patent applicants' rights. *See generally, e.g., R. Huntington v. U.S. Dep't of Commerce*, No. 18-5086 (D.C. Cir., filed Mar. 29, 2018) (FOIA litigation brought by patent attorney); *eVideo, Inc. v. U.S.*, No. 18-1722 (Fed. Cir. filed Mar. 26, 2018) (class action litigation brought by patent applicants); *see also Huntington v. U.S. Dep't of Commerce*, 234 F. Supp. 3d 94, 108–09 (D.D.C. 2017) (compelling the PTO to perform a more adequate search for responsive records on the SAWS program under FOIA). These cases have been well-

General Counsel

July 9, 2018

Page 11

regarding the flagging and treatment of particular applications. In the case of Mr. Hyatt's applications, the PTO has issued sworn statements that five of Mr. Hyatt's patent applications were included in the SAWS program, Ex. DD, pp. 60–61, and Mr. Hyatt's request seeks records dating to 2012, which included years of SAWS treatment for those applications. Beyond what the PTO has admitted, other high-level PTO officials have offered sworn statements that all of Mr. Hyatt's applications were subject to the SAWS program. Ex. MM. Based on the PTO's actions towards him, Mr. Hyatt believes that his applications continue to receive the equivalent of SAWS treatment continuing to this day, despite the PTO's claims that it has terminated the SAWS program. And, in any instance, information regarding SAWS continues to be relevant and of interest to the public because it reveals the PTO's interpretation of its legal authority and its mode of exercising that authority—things that any patent applicant or practitioner would want to know in dealing with the agency.

Accordingly, the denial of Mr. Hyatt's fee-waiver request and request that his request not be considered a commercial use request was in error.

Mr. Hyatt reserves the right to dispute any and all grounds that may be asserted by the PTO for its denial of his FOIA request.

III. The PTO's Decision Ignores Entirely Mr. Hyatt's Request for Performance Plans

The PTO's modified request also sought, in addition to records from Messrs. Gutierrez and Morse, "Copies of all Performance Appraisal Plans for, and signed by, Examiner Walter Briney for fiscal years 2013, 2014, 2015, 2016, 2017, and 2018." Ex. BB. The PTO's May 25 decision ignored entirely this request in its rationale. The PTO should immediately produce those documents without cost to Mr. Hyatt.

Preservation Notice

The PTO is reminded of its obligations in connection with the parties' ongoing litigation and under the Federal Records Act, 44 U.S.C. § 3101 *et seq.*, to preserve and not destroy, alter, or erase, any paper or electronic documents in your possession or control relating to Mr. Hyatt's request. Document preservation is of particular concern to Mr. Hyatt, as he has

covered in various patent and trade publications. *E.g.*, David Embree, Judge Orders PTO To Disclose More About "Sensitive" Patent Applications, Westlaw Daily Intell. Prop. Briefing, 2017 WL 3197898 (June 28, 2017), *reprinted in* 24 No. 8 Westlaw J. Intell. Prop. 3, 2017 WL 3283941 (Aug. 2, 2017), *reprinted in* 249 Intell. Prop. Couns. NL 2 (Westlaw Sept. 2017); Mark Engstrom, Patent—Fed. Cl.: Patent Applicants Could Not Pursue S.A.W.S.-Based Breach Of Contract Claims Against PTO, Wolters Kluwer Intell. Prop. L. Daily, 2018 WL 579429 (C.C.H.) (Jan. 29, 2018); Corrado Rizzi, eVideo sues United State Over Patents Tossed Into 'SAWS' Program, Classaction.org (May 22, 2017), <https://www.classaction.org/news/evideo-sues-united-states-over-patents-tossed-into-saws-program>.

General Counsel

July 9, 2018

Page 12

obtained records demonstrating that the PTO has employed so-called “trouble shooters” for decades to alter the PTO’s records concerning his applications. Ex. NN. Please continue to retain these documents until further notice.

Conclusion

The denial of Mr. Hyatt’s FOIA fee-waiver request, his non-commercial use request, and the PTO’s failure to respond to his request for the performance plans was in error. The PTO should grant Mr. Hyatt’s fee-waiver request, his non-commercial use request, and produce the requested document(s) to Mr. Hyatt.

Sincerely,

Andrew M. Grossman

Counsel to Gilbert P. Hyatt

Exhibit AA

BakerHostetler

Baker&Hostetler LLP

Washington Square, Suite 1100
1050 Connecticut Avenue, N.W.
Washington, DC 20036-5403

T 202.861.1500
F 202.861.1783
www.bakerlaw.com

February 12, 2018

Andrew M. Grossman
direct dial: 202.861.1697
agrossman@bakerlaw.com

VIA ELECTRONIC MAIL (FOIARequests@uspto.gov)

USPTO FOIA Officer
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Dear FOIA Officer:

I represent Gilbert P. Hyatt, as attested by the attached letter of consent, and make the following requests on his behalf. Pursuant to the Freedom of Information Act ("FOIA"), 5 U.S.C. § 552, and the Privacy Act, 5 U.S.C. § 552a, please provide me with the following records:

1. All records from Art Unit 2615 concerning Mr. Hyatt or his patent applications, excluding records contained in the file histories of Mr. Hyatt's patent applications and excluding records already produced to Mr. Hyatt in litigation. This request includes without limitation all responsive records from any instant messaging, text messaging, or similar communications system used, with or without PTO authorization, by Art Unit 2615 personnel. This request seeks responsive records created or obtained from January 1, 2012, to the present.
2. All records from the Office of Patent Legal Administration ("OPLA") concerning Mr. Hyatt or his patent applications, excluding records contained in the file histories of Mr. Hyatt's patent applications and excluding records already produced to Mr. Hyatt in litigation. This request includes without limitation all responsive records created, obtained, or maintained by the following OPLA personnel: Robert Spar, Kenneth Schor, Hiram Bernstein, Gerald Dost, Karin Ferriter, Fred Silverberg, Anthony Caputa, and Nancy Le. This request seeks all responsive records, without time limitation.
3. All records from the Office of Under Secretary and Director, and any predecessor office, concerning Mr. Hyatt or his patent applications, excluding records contained in the file histories of Mr. Hyatt's patent applications and excluding records already produced to Mr. Hyatt in litigation. This request includes without limitation all responsive records from the PTO's Management Council. This request seeks all responsive records, without time limitation.

Atlanta Chicago Cincinnati Cleveland Columbus Costa Mesa Denver
Houston Los Angeles New York Orlando Philadelphia Seattle Washington, DC

USPTO FOIA Officer

February 12, 2018

Page 2

4. All records from the Office of the Commissioner for Patents, and any predecessor office, concerning Mr. Hyatt or his patent applications, excluding records contained in the file histories of Mr. Hyatt's patent applications and excluding records already produced to Mr. Hyatt in litigation. This request includes without limitation all responsive records from the Office of the Deputy Commissioner for Patent Operations, Office of the Deputy Commissioner for Patent Examination Policy, Office of Petitions, Office of Patent Administration, and Office of the Deputy Commissioner for Patent Quality, as well as any predecessors to those offices. This request does not include records maintained only by PTO Technology Centers or Art Units, or by predecessors of those entities or by personnel of those entities or predecessor entities. This request seeks all responsive records, without time limitation.

5. All records from the Office of the General Counsel, and any predecessor office, concerning Mr. Hyatt or his patent applications, excluding records contained in the file histories of Mr. Hyatt's patent applications and excluding records already produced to Mr. Hyatt in litigation. This request includes without limitation all responsive records from the Office of the Solicitor and any predecessor office. This request seeks all responsive records, without time limitation.

6. All records from the Patent Trial and Appeal Board and the Board of Patent Appeals and Interferences concerning Mr. Hyatt or his patent applications, excluding records contained in the file histories of Mr. Hyatt's patent applications and excluding records already produced to Mr. Hyatt in litigation. This request seeks all responsive records, without time limitation.

7. All records from the Office of Government Affairs, and any predecessor office, concerning Mr. Hyatt or his patent applications, excluding records contained in the file histories of Mr. Hyatt's patent applications and excluding records already produced to Mr. Hyatt in litigation. This request seeks all responsive records, without time limitation.

8. To the extent that they are not encompassed by the previous requests, all records created, obtained, or maintained by any of the following PTO personnel concerning Mr. Hyatt or his patent applications, excluding records contained in the file histories of Mr. Hyatt's patent applications and excluding records already produced to Mr. Hyatt in litigation:

- 1) Michelle Lee,
- 2) David Kappos,
- 3) Teresa Stanek Rea,
- 4) Jon Dudas,
- 5) James Rogan,
- 6) Q. Todd Dickinson,
- 7) Robert Stoll,
- 8) Margaret "Peggy" Focarino,
- 9) Drew Hirshfeld,
- 10) Lawrence Goffney,
- 11) Edward Kazenske,

USPTO FOIA Officer

February 12, 2018

Page 3

- 12) Esther Kepplinger,
- 13) Bruce Lehman,
- 14) Michael Razavi,
- 15) Stephen Kunin,
- 16) Robert Bahr,
- 17) Derris Banks,
- 18) Diego Gutierrez,
- 19) Tariq Hafiz,
- 20) John LeGuyader,
- 21) Andrew Faile,
- 22) Karna Cooper,
- 23) Leslie Fansler,
- 24) Thomas Lee,
- 25) Terrell Fears,
- 26) Robert Pascal,
- 27) Rolf Hille,
- 28) Gerald Goldberg,
- 29) Vincent Trans,
- 30) Daniel Swerdlow,
- 31) Richard Hjerpe,
- 32) Nicholas Godici,
- 33) John Doll,
- 34) Andrew Christensen,
- 35) Jose Cuso,
- 36) Leo Boudreau,
- 37) Brian Werner,
- 38) Parshotam Lall,
- 39) David Knepper,
- 40) Joseph Mancuso,
- 41) James Dwyer,
- 42) Wellington Chin,
- 43) Daniel Hunter,
- 44) Xiao Wu,
- 45) Joseph Rolla,
- 46) Samir Ahmed,
- 47) Vu Le,
- 48) Vikkram Bali,
- 49) Allen MacDonald,
- 50) Pinchus Laufer,
- 51) John Lane,
- 52) Eileen Lillis,
- 53) William Grant,
- 54) Reginald Bragdon,
- 55) Jeffery Brier,

USPTO FOIA Officer

February 12, 2018

Page 4

- 56) Robert Harrell,
- 57) Elizabeth Rosen,
- 58) Cindy Khuu,
- 59) Ponnoreay Pich,
- 60) Ram Kackar,
- 61) Giovanna Colan,
- 62) Michael Rutland Wallis,
- 63) Kee Tung,
- 64) Nishant Divecha,
- 65) George Neurauter,
- 66) David Welch,
- 67) Matthew David,
- 68) Michael Roswell,
- 69) Philip Lee, and
- 70) John Lee.

This request seeks all responsive records, without time limitation.

* * *

Relevant search terms for all of these requests include: “Gilbert P. Hyatt”, “Gilbert Hyatt”, “Hyatt”, “Gil”, possessive forms of the preceding terms, “Bulk Filer”, “Bulk Filers”, “Submarine”, “Submariner”, “Submariners”, “2615”, and “Team Exam Six”.

Requests Include Records of Personnel: Each request for records from a PTO office or other organizational unit includes without limitation responsive records created, obtained, or maintained by personnel of that office or unit.

Identifying Records Responsive to Request 1: Because Art Unit 2615 is in large part devoted to processing Mr. Hyatt’s patent applications, many records responsive to Request 1 (i.e., that concern Mr. Hyatt or his patent applications) will not refer directly to Mr. Hyatt using the search terms identified above or any other ascertainable set of search terms. Accordingly, keyword searching will be inadequate to identify records responsive to Request 1. To reasonably identify responsive records for that Request, a FOIA Officer should directly review records created, obtained, or maintained by Art Unit 2615. To provide the greatest likelihood of identifying responsive records, this review should begin with records created, obtained, or maintained by the head of Art Unit 2615, Gregory Morse.

Rolling Production: I request rolling production of responsive documents. In other words, please produce responsive records in batches, as they are identified.

Index of Withheld Records: In the interests of efficiency and furthering the purposes of the Freedom of Information Act and Privacy Act, I request that you maintain and produce, on a

USPTO FOIA Officer

February 12, 2018

Page 5

rolling basis, an index that identifies any records withheld, in whole or in part, and the statutory basis of the withholding.

Items Determined Not To Be Agency Records: I request that you identify to me any otherwise responsive records withheld on the basis that they are not agency records.

Preservation Requirement: Pursuant to 37 C.F.R. § 102.3(d), the PTO “shall preserve...copies of all requested records” and “shall not dispose of records while they are the subject of a pending request, appeal, or lawsuit under FOIA.” 37 C.F.R. § 102.3(d).

Thank you.

Sincerely,

Andrew M. Grossman
Counsel to Gilbert P. Hyatt

Attachment

February 7, 2018

Gilbert P. Hyatt
P.O. Box 81230
Law Vegas, NV 89180

Dear U.S. Patent and Trademark Office FOIA Officer:

I have authorized Andrew M. Grossman, of the law firm Baker & Hostetler LLP, to request and obtain on my behalf any and all U.S. Patent and Trademark Office records pertaining to me through the Freedom of Information Act and the Privacy Act. Accordingly, I consent to disclosure of any and all such records to Mr. Grossman.

Sincerely,

A handwritten signature in cursive script that reads "Gilbert P. Hyatt".

Gilbert P. Hyatt

Exhibit BB

BakerHostetler

Baker&Hostetler LLP

Washington Square, Suite 1100
1050 Connecticut Avenue, N.W.
Washington, DC 20036-5403

T 202.861.1500
F 202.861.1783
www.bakerlaw.com

Andrew M. Grossman
direct dial: 202.861.1697
agrossman@bakerlaw.com

April 27, 2018

VIA EMAIL (louis.boston@uspto.gov)

Louis Boston
USPTO FOIA Officer
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Re: Freedom of Information Request No. FP-18-00014

Dear Mr. Boston:

I write in response to your letter of April 17, 2018, and thank you for the information you provided regarding the PTO's partial fee estimate for the above-referenced FOIA request filed by my client, Gilbert P. Hyatt. In particular, this letter responds to your request that Mr. Hyatt "provide a meaningful description of how you wish to limit the scope of your request no later than April 27, 2018." I have every expectation that this response will enable you to provide a final fee estimate and allow us all to move on the actual carrying out the FOIA request and production of responsive documents.

As you know, Mr. Hyatt's request contained eight subparts. By this letter, Mr. Hyatt is narrowing one of them.

Subpart One

Subpart one is narrowed as follows:

All records concerning Mr. Hyatt or his patent applications created by, sent by, or received by (a) Diego Gutierrez during 2012 and 2013 or (b) Gregory Morse from and including 2013 through 2018, excluding (1) email attachments, (2) documents contained in the file histories of Mr. Hyatt's applications, and (3) drafts of documents contained in the file histories of Mr. Hyatt's applications.

Atlanta Chicago Cincinnati Cleveland Columbus Costa Mesa Denver
Houston Los Angeles New York Orlando Philadelphia Seattle Washington, DC

Louis Boston
April 27, 2018
Page 2

Copies of all Performance Appraisal Plans for, and signed by, Examiner Walter Briney for fiscal years 2013, 2014, 2015, 2016, 2017, and 2018.

As provided in Mr. Hyatt's original request, this subpart continues to include without limitation all responsive records from any instant messaging, text messaging, or similar communications system used, with or without PTO authorization, by Art Unit 2615 personnel.

We also request that your processing of this subpart begin with Mr. Gutierrez's records, before moving on to Mr. Morse's.

The other general terms applicable to this subpart are the same as laid out in our initial request, and I reproduce them here for your convenience (striking out several portions that are no longer applicable to the request, as narrowed):

Relevant search terms for all of these requests include: "Gilbert P. Hyatt", "Gilbert Hyatt", "Hyatt", "Gil", possessive forms of the preceding terms, "Bulk Filer", "Bulk Filers", "Submarine", "Submariner", "Submariners", "2615", and "Team Exam Six".

~~**Requests Include Records of Personnel:** Each request for records from a PTO office or other organizational unit includes without limitation responsive records created, obtained, or maintained by personnel of that office or unit.~~

~~**Identifying Records Responsive to Request 1:** Because Art Unit 2615 is in large part devoted to processing Mr. Hyatt's patent applications, many records responsive to Request 1 (i.e., that concern Mr. Hyatt or his patent applications) will not refer directly to Mr. Hyatt using the search terms identified above or any other ascertainable set of search terms. Accordingly, keyword searching will be inadequate to identify records responsive to Request 1. To reasonably identify responsive records for that Request, a FOIA Officer should directly review records created, obtained, or maintained by Art Unit 2615. To provide the greatest likelihood of identifying responsive records, this review should begin with records created, obtained, or maintained by the head of Art Unit 2615, Gregory Morse.~~

Rolling Production: I request rolling production of responsive documents. In other words, please produce responsive records in batches, as they are identified.

Index of Withheld Records: In the interests of efficiency and furthering the purposes of the Freedom of Information Act and Privacy Act, I request that you maintain and produce, on a rolling basis, an index that identifies any records withheld, in whole or in part, and the statutory basis of the withholding.

Louis Boston
April 27, 2018
Page 3

Items Determined Not To Be Agency Records: I request that you identify to me any otherwise responsive records withheld on the basis that they are not agency records.

Preservation Requirement: Pursuant to 37 C.F.R. § 102.3(d), the PTO “shall preserve...copies of all requested records” and “shall not dispose of records while they are the subject of a pending request, appeal, or lawsuit under FOIA.” 37 C.F.R. § 102.3(d).

Subparts Two Through Eight

In light of your description of the PTO’s limited resources available to respond to FOIA requests, as well as the public interest in timely production of relevant records, Mr. Hyatt hereby withdraws the other subparts (i.e., subparts two through eight) of his original request and may refile them as a separate request or requests at a later date.

Fee Waiver

Your previous fee estimate incorrectly assumed that Mr. Hyatt is requesting records for commercial use and may therefore be assessed fees for the agency’s review of records. That assumption, however, misunderstands the nature and purpose of Mr. Hyatt’s request. Mr. Hyatt seeks to ascertain the extent and details of the violation of his constitutional and statutory rights by the PTO and PTO personnel and to inform the public, through publication, about PTO important operations that have not been meaningfully disclosed to date and about potentially serious misconduct by a government agency and its personnel.

On that basis, Mr. Hyatt is entitled to a fee waiver. As consideration of the applicable factors demonstrates, “[d]isclosure of the [requested] information is in the public interest because it is likely to contribute significantly to public understanding of the operations or activities of the government and is not primarily in the commercial interest of the requester.” 5 U.S.C. § 552(a)(4)(A)(iii).

The public interest in disclosure is overwhelming. First, it is indisputable that the requested records specifically concern identifiable operations or activities of the government: the PTO’s treatment of a patent applicant, Mr. Hyatt, and his applications through the creation and operation of an Art Unit principally focused on his applications and a set of policies carried out by that Art Unit and potentially other PTO divisions.

Second, the requested records are likely to contribute to an understanding of those government operations and activities, because they will be meaningfully informative with respect to them, focusing on the persons responsible for establishing and managing that Art Unit in the relevant time periods. The requested records will also shed light on PTO policies related to flagging “sensitive” applications, a matter of intense public interest about which key details remain undisclosed. This information is not already in the public domain.

Louis Boston
April 27, 2018
Page 4

Third, the disclosure of these records will contribute to public understanding because Mr. Hyatt intends and has made concrete plans to disseminate the information obtained through Internet publication, collaboration with news media, and collaboration with nonprofit organizations that work on government accountability, intellectual property, and regulatory reform issues. In particular, Mr. Hyatt is affiliated with the American Center for Equitable Treatment (“ACET”), a nonprofit group with which he has collaborated in the past to obtain and disseminate information of public interest. Both he and ACET have demonstrated expertise in these areas, such that they can help explain to the public the meaning and relevancy of the requested information. Likewise, Mr. Hyatt and his counsel have demonstrated their ability to bring matters involving government accountability and misconduct to the public attention.¹

Fourth, disclosure of the requested information will contribute significantly to public understanding, given the extremely limited understanding of these operations or activities as a result of the PTO’s lack of public disclosure and actual hindrance of public disclosure. The public, of course, has an overwhelming interest in being informed about the way that the PTO treats patent applicants, about government misconduct, about government spending on the operations and activities at issue, and about the agency’s processing of long-pending patent applications. And today the public knows little or nothing about these things, as well as the PTO’s handling of Mr. Hyatt’s applications, which themselves implicate public rights.

By contrast, Mr. Hyatt’s commercial interests are all but non-existent. The PTO has consistently maintained that any possible bad faith or misconduct on its part in the handling of Mr. Hyatt’s patent applications is legally irrelevant to their merit and issuance and that its handling of his applications is guided by law and necessity alone. In particular, the PTO does not consider any of the information requested by Mr. Hyatt to be relevant to its examination or other handling of his applications, such that (in the PTO’s view) any use of that information in his applications pending before the agency would not advance their prosecution or otherwise advance their issuance. Mr. Hyatt may disagree on those points, but the agency’s consistent position is that the requested information is irrelevant to the issuance of any patents to Mr. Hyatt and therefore irrelevant to any commercial interest he may have their issuance. In any instance, Mr. Hyatt’s principal interest is identifying and exposing the PTO’s unusual treatment of him, its secret policies and procedures, and the likely violation of his constitutional and statutory rights by the PTO, which is not at all a commercial interest.

Accordingly, the magnitude of any commercial interest is minimal at most, while the identified public interest in disclosure is overwhelming. The public interest in disclosure is therefore the primary interest. As such, Mr. Hyatt is entitled to a fee waiver.

¹ For example, two of Mr. Hyatt’s attorneys, including the undersigned, were involved in exposing the “John Doe” scandal in Wisconsin.

Louis Boston
April 27, 2018
Page 5

Lack of Commercial Use

If you determine that Mr. Hyatt is not entitled to a waiver of all review-related fees, Mr. Hyatt still may not be required to pay fees for the agency's review of records because his intended use of the requested records is not a commercial one, as described above. As you know, "commercial-use" designation "turn[s] on the use to which the requested information would be put, rather than on the identity of the requester,"² and Mr. Hyatt's intended use is to understand the PTO's unusual actions on his applications, understand how the PTO has treated and is treating applications that it has identified as "sensitive," assess any violations of his rights, and inform the public of those things so as to advance public understanding, hold to account those responsible for any misconduct, and ensure that similar misconduct is averted in the future. Mr. Hyatt describes his intended use of the requested records in the attached declaration, which I ask that you consider in evaluating Mr. Hyatt's request for a fee waiver and whether his intended use is commercial.

Thank you again for your prompt attention to this matter.

Sincerely,

A handwritten signature in blue ink, appearing to read "Andrew Grossman", with a long horizontal flourish extending to the right.

Andrew M. Grossman
Counsel to Gilbert P. Hyatt

Attachment

² "Fees and Fee Waivers," Dep't of Justice Guide to the Freedom of Information Act (2013 ed.).

DECLARATION OF GILBERT P. HYATT

Pursuant to 28 U.S.C. § 1746, I, Gilbert P. Hyatt, declare and state as follows:

1. I am an engineer, scientist, and inventor and holder of more than 70 patents issued by the United States Patent and Trademark Office (“PTO”). I have over 300 patent applications pending before the PTO (including what I believe to be unlawfully abandoned applications that I expect to get un-abandoned) covering subject matter including microcomputer structure, computer memory architecture, illumination control systems, display systems, graphics systems, image processing systems, and sound and speech processing. Most of my pending patent applications have been pending for over 22 years, with about a dozen applications pending for over 35 years.

2. Over the course of prosecuting these patent applications, I have come to believe that the PTO is not treating my patent applications fairly and that the PTO has established policies and procedures that are intended to preclude me from ever obtaining patent protection for any of my pending patent applications. I have detailed some of these concerns, and their factual bases, in the attached declaration, dated December 27, 2016, which is attached and specifically incorporated into this declaration. (Ex. A).

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

4. On February 12, 2018, I caused to be sent a Freedom of Information Act (“FOIA”) request for certain records relating to me that I believe to be under the control of the

PTO. In order to respond to concerns that the PTO has raised about the scope of that original request, I have deferred all requests except the following:

All records concerning Mr. Hyatt or his patent applications created by, sent by, or received by (a) Diego Gutierrez during 2012 and 2013 or (b) Gregory Morse from and including 2013 through 2018, excluding (1) email attachments, (2) documents contained in the file histories of Mr. Hyatt's applications, and (3) drafts of documents contained in the file histories of Mr. Hyatt's applications.

Copies of all Performance Appraisal Plans for, and signed by, Examiner Walter Briney for fiscal years 2013, 2014, 2015, 2016, 2017, and 2018.

5. The request concerns the PTO's treatment of my patent applications, which have been pending before the agency for many years. Supervisor Diego Gutierrez was the initial supervisor of Art Unit 2615, to which the PTO assigned my patent applications; Gregory Morse is his successor, serving as the supervisor of that Unit today. Walter Briney served as an examiner in that Unit working on my applications throughout the period from 2012 through 2018.

6. The purpose of the FOIA request is to ascertain and publicize the extent and details of the unusual treatment by the PTO of my applications, so as to inform the public about the agency's operations and allow the agency and its personnel to be subject to public accountability. This unusual treatment includes actions that I have reason to believe were taken in violation of my constitutional and statutory rights by the PTO and PTO personnel, and I intend to inform the public, through publication, about PTO operations and policies that have not previously been meaningfully disclosed and about potentially serious misconduct by a government agency and its personnel.

7. For example, the disclosed information will inform the public about PTO's operations and actions carrying out a previously secret program that included my applications and others'. In particular, it will reveal how the PTO and its examiners and officials treated my

applications that, by PTO's own admission, were flagged under the Sensitive Application Warning System ("SAWS") program. The SAWS program was a secret program established in 1994 for flagging applications the PTO deemed "sensitive" to ensure that they would not issue even if an examiner allowed the application. Since the public revelation in 2014 of this program's existence, it has been the subject of extensive press coverage, congressional inquiries, and controversy within the patent community. Although SAWS has been subject to widespread curiosity and interest, the PTO has refused to identify which applications it flagged under SAWS and has never disclosed the full details of the operation of SAWS, including the full range of effects and consequences of an application being flagged under SAWS and the role of senior PTO management in implementing and operating SAWS. Because there is definitive evidence that my applications were flagged under SAWS, publication of the information disclosed under this request will inform the public for the first time about certain important aspects of the PTO's treatment of SAWS applications.

8. The disclosure of the requested information will significantly contribute to, and enhance the understanding of a reasonably broad audience of persons interested in the subject. I intend to provide the records that I obtain through the FOIA request to the American Center for Equitable Treatment ("ACET"), a non-profit corporation with which I am affiliated as a member. ACET is dedicated to educating Americans about the economic and social benefits of the federal government's fair, efficient, and effective administration of technology, innovation, and intellectual property laws and policies. Through its Accountability Projects involving investigations, reports, legal filings, and ACET Blog posts, ACET promotes government accountability and transparency to protect the laws and regulations central to America's world

leadership in technology, innovation, and intellectual property protection. ACET serves as a free information resource for scholars, policy makers, journalists, and citizens.

9. One of ACET's projects is its "USPTO Accountability Project," which uses government publications and the Freedom of Information Act to gather information of potential interest to the public from the PTO and to disseminate that information to advance public understanding both of government process and of the effect such process has on technological innovation, intellectual property protection, and economic prosperity. ACET posts its information requests and the USPTO's responses for public review and also publishes analyses and commentary on such information.

10. In particular, the ACET publishes information that it obtains from FOIA requests as part of the USPTO Accountability Project on its website at <http://acet-usa.org>.

11. I also intend to publish any records obtained from this FOIA request at <http://www.ptomisconduct.com>, which I have reserved specifically for that purpose.

12. Additionally, I intend to ensure that information shedding light on the PTO's activities are extracted, synthesized, and effectively conveyed to the public through publication of analyses of any misconduct identified in the materials and through the media, both general interest and trade-specific. ACET has the capability of performing these activities, and I do, too. In particular, I have the capability of extracting, synthesizing, and effectively conveying information concerning the inner workings of the PTO to the public through my many decades of experience working with the PTO on patent examination. I am also a registered patent agent. Moreover, I intend to, and routinely do associate with individuals with expertise in extracting, synthesizing, and effectively conveying information concerning the inner workings of the PTO to the public. In sum, I am uniquely situated and involved in proceedings at the PTO on which I

seek information that has relevance to a broad segment of the public, and I have the expertise in the subject area and the ability and intention to effectively convey such information to the public.

13. Although the FOIA request concerns records pertaining to me, those records are, viewed objectively, of significant interest to the public. For example, Mr. Gregory Morse, the supervisory patent examiner who heads the Hyatt Unit (Art Unit 2615) offered sworn testimony that “the PTO has expended a lot of people and resources and money in department salaries trying to examine Mr. Hyatt’s applications,” to the tune of about \$10 million just in examiners’ salaries over the past five years. Trial Tr. 57:1–25 (Oct. 12, 2017 AM) (Ex. C). The public and other users of the patent system have a legitimate interest in understanding how that money was spent, what purposes it was spent to accomplish, and whether the PTO is accomplishing those purposes. I am not aware that any information regarding these things has been made available to the public.

14. Moreover, the PTO has represented in court that my patent prosecution conduct and the prosecution of my patent applications are of interest to the public. For example, the PTO Solicitor’s Office recently represented to the United States District Court for the District of Columbia in a case concerning my patent prosecution conduct that “[i]t’s the government’s view that the particular prosecution laches issue that we have brought to the Court here is an issue that is raised in the public interest to prevent the abuse of the patent system.” Trial Tr. 5:18–21 (Oct. 6, 2017 AM) (Ex. C).

15. I do not have any commercial interest in the records that are sought by the FOIA request. The information I seek pertains to examiner practices and procedural matters, not to the merits of the technology described or claimed in my patent applications or the merits of the patent claims contained in those applications. I do not currently engage in any patent licensing

activities, and the PTO has consistently maintained (in administrative proceedings and in court) that any possible bad faith or misconduct on its part in the handling of my patent applications is legally irrelevant to their merit and issuance and that its handling of my applications is guided by law and necessity alone. In particular, the PTO's position, as it has expressed in litigation, is that it does not consider any of the information requested here to be relevant to its examination or other handling of my applications on the merits, such that (in the PTO's view) any use of that information in my applications pending before the agency would not advance their prosecution, otherwise advance their issuance, or otherwise alter the PTO's processing of them.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. Executed on April 27, 2018.


Gilbert P. Hyatt

Exhibit A

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

GILBERT P. HYATT,

Plaintiff,

v.

MICHELLE K. LEE,

Defendant.

Civil Action No. 05-2310 (RCL)
Civil Action No. 09-1864 (RCL)
Civil Action No. 09-1869 (RCL)
Civil Action No. 09-1872 (RCL)
ECF

**Declaration of Gilbert P. Hyatt in Support of
Plaintiff's Motion for Discovery Pursuant to Rule 56(d)**

Pursuant to 28 U.S.C. § 1746, I, Gilbert P. Hyatt, declare as follows:

1. I am an engineer, scientist, and inventor and holder of more than 70 patents issued by the United States Patent and Trademark Office ("PTO"). I have over 370 patent applications ("applications") pending before the PTO covering subject matter including microcomputer structure, computer memory architecture, illumination control systems, display systems, graphics systems, image processing systems, and sound and speech processing systems. Most of my pending patent applications have been pending for over 21 years, with about a dozen applications pending for over 35 years.

2. I submit this declaration in support of the Plaintiff's Motion for Discovery Pursuant to Rule 56(d) to provide a factual basis for certain of the facts for which I am requesting to conduct discovery.

Hyatt-Specific Policies and Procedures

3. Based on my communications and interactions with PTO personnel over the years, I know that PTO has adopted, at various times, a number of policies and procedures specifically addressing the treatment of my applications. Documents setting forth these policies and procedures, however, are not included in the file histories for my applications or in the administrative records before this Court.

4. Although my applications covered diverse technology subject matter that are examined in different PTO Technology Centers (“TCs”), the PTO assigned Richard Hjerpe, a Supervisory Patent Examiner, to work with my patent attorney and me in the late-1990s through the mid-2000s to manage the examination of my patent applications, including the four patent applications in the instant actions. Mr. Hjerpe communicated with me personally from at least 1996. The telephone conference record attached hereto as Exhibit 1 describes a 1996 telephone call that I received from Mr. Hjerpe. Mr. Hjerpe stated that he was in charge of all my patent applications and that my patent attorney and I should work through him on my patent applications. In order to assist the PTO in examining my applications, we had numerous telephone conferences and several meetings with Mr. Hjerpe at the PTO.

5. Mr. Hjerpe mentioned many times in telephone conversations from the late-1990s to the mid-2000s that he communicated often with the examiners working on my applications to keep track of their progress and ensure consistency in their actions. These communications, which Mr. Hjerpe often said took place through email, are not included in the file histories or in the record before this Court.

6. Mr. Hjerpe mentioned in one of the telephone conferences in the early-2000s that the PTO was taking special care of my patent applications and that the PTO had “special procedures” for handling them. Mr. Hjerpe also mentioned the Patent Application Location and Monitoring (“PALM”) system. Based on my conversations with Mr. Hjerpe and other timing considerations, it is likely that the four patent applications at issue in these cases were subject to these “special procedures.”

7. I understand that the “special procedures” included the creation and use of a “Hyatt room” at the PTO to organize the work of a team of patent examiners (“examiners”) responsible for certain of my applications. Mr. Hjerpe mentioned several times in telephone conversations in the early- and mid-2000s that the PTO had a “Hyatt room” where it kept the file histories and prior art references for my patent applications. The telephone

conference record attached hereto as Exhibit 2 describes the protocol for providing prior art references, which I understood were kept in the “Hyatt room,” and the Information Disclosure Statement (“IDS”) attached hereto as Exhibit 3 is one of many IDSs that references the telephone conference record for the submission of prior art references. The telephone conference record is referenced in the footnote on the first page of Exhibit 3. Based on my conversations with Mr. Hjerpe and other timing considerations, it is likely that the four patent applications at issue in these cases were maintained in the “Hyatt room” at the PTO.

8. I had several meetings at the PTO and numerous telephone conversations with Brian Werner, who was responsible for many of my applications, in the mid-2000s.

9. In a telephone conversation, Mr. Werner told me that he had a special procedure by which he could generate a large office action on each of my patent applications in two days. I understood him to be referring to the lengthy, repetitive, and burdensome-to-respond-to actions that were being issued on many of my applications around that time—actions that appeared calculated to frustrate my ability to comply with the PTO’s demands and obtain substantive action on my applications. He indicated that a team had been assembled specifically to work on my applications. Two of the four applications in the instant actions were examined personally by Mr. Werner. It is Mr. Werner’s rejections that are the subject of these two appeals.

10. I understand that, in early 2013, after years of inaction, the PTO assigned almost all of my applications to a single examination group, Art Unit 2615, which worked exclusively on my applications. Exhibit 4. The PTO called this group the “Bulk Filers” group, apparently reflecting the PTO’s prejudgment that the mere fact that I filed a large number of applications (covering a wide range of technology subject matter) somehow implies that my pending applications are without merit. This is despite the fact that I hold a number of issued patents and have been recognized for my technological innovations. I am

unaware of any PTO art unit dedicated solely to “bulk filers” such as IBM that file thousands of patent applications every year.

11. I understand that a number of my pending patent applications were, for a number of years, subject to the PTO’s secret Sensitive Application Warning System (SAWS) program. This program was created at least as far back as 1994. It established a secret review process for some pending U.S. patent applications selected based on secret criteria made up by the PTO. It was designed to flag what the PTO deemed “sensitive” applications and subject them to special scrutiny, even though the term “sensitive” is not found in, nor could be reasonably interpreted from, any statutory criteria for patentability. The SAWS program had not been adopted by reference to any specific statutory or regulatory authority, nor was it disclosed to the public by the PTO. It was secret. Freedom of Information Act (“FOIA”) disclosures revealed that the PTO used SAWS to target applications “which if issued would potentially generate extensive media coverage” (i.e., news, blogs, forums), “applications...claiming subject matter that, if issued, would potentially generate high publicity” for the USPTO, and “[a]pplications with pioneering scope.” Exhibit 5 at 1–2. Applications “which have old effective filing dates (pre 6/8/1995, i.e. pre-GATT) with broad claim scope” were also flagged under SAWS. Exhibit 5 at 2. In other words, the SAWS program was the PTO’s “Be On the Lookout,” or “BOLO,” list of certain patent applications. Importantly, SAWS applications were flagged in the PALM system “to prevent issuance.” Exhibit 6.

12. The PTO’s Board of Appeals was informed of any application that came up on appeal that was flagged under SAWS. The PTO instructed examiners to write an Impact Report for some SAWS applications, projecting likely impact on the public and the PTO should the application issue. FOIA records reveal that such SAWS applications would be referred to the “10th floor,” specifically to the PTO’s Office of Patent Legal Administration (“OPLA”), for review. The OPLA may approve issuance, may ask for changes in the

application to allow, or may say “no way”—the application “could not get allowed (had to be withdrawn from issue).” Exhibit 6.

13. The program was said to have been terminated in March 2015, in the midst of a public controversy over its operation and a Senate inquiry that was in process. Because my applications met the SAWS criteria (pre-GATT applications, “claiming to subject matter that, if issued, would potentially generate high publicity” for the USPTO), I understand that my applications were identified as being subject to SAWS, including when they were appealed to the Board of Appeals, potentially prejudicing its consideration of my appeals. This likely included the four applications in the instant actions which are appealed from the decisions of the Board. Of particular significance is the fact that PTO management on “the 10th floor,” exercised extraordinary power under this secret program to refuse allowance, or withdraw from issue, claims to patentable inventions which they deem too “sensitive.” The treatment of my applications has the hallmark of PTO’s secret exercise of such power—the “no way” determination made at the “10th floor” to prevent issue—including an indefinite withdrawal from issue of one of my allowed applications. *See infra* ¶ 57.

14. Other experiences with the PTO, some of which are described below, have indicated that the PTO is applying other Hyatt-specific practices, policies, and procedures. In many instances, the PTO has issued waves of identical or related actions in numerous of my applications within a short period of time, reflecting that it is carrying out some kind of policy or directive. In many instances, the application of these policies and procedures has consisted of or caused delays in the prosecution of my applications, induced delays in the prosecution of my applications, induced the conduct the Defendant described in the motion to dismiss, and I understand and believe frustrated the regularity of the PTO’s examination of my applications.

PTO’s Inducement of Challenged Conduct

15. At all times, I have sought to prosecute my applications according to the requirements of law, so that they will be granted. To that end, I have often taken direction

from the PTO on how it prefers that I proceed, and worked collaboratively with PTO personnel, to facilitate expeditious action on my applications.

16. I took numerous actions before the PTO at Mr. Hjerpe's behest in an attempt to assist the PTO, with the understanding that taking such actions would expedite consideration of my applications. For example, Mr. Hjerpe stated in a telephone communication and in a meeting that the PTO wanted to expedite processing of my patent applications and that he would work with my patent attorney and me to get my patent applications issued. Mr. Hjerpe was representing PTO management at a high level; for example, Mr. Hjerpe stated that this was the IDS procedure decided by the directors of the groups examining my pending applications. Exhibit 2. Because we wanted to assist the PTO, my patent attorney and I cooperated with Mr. Hjerpe for that purpose. Exhibit 3. Mr. Hjerpe did not mention delays, laches, or any other such issue and he did not mention that the PTO had any problem with my patent applications.

17. The PTO assigned Michael Razavi, a Supervisory Patent Examiner, to work with my patent attorney and me between the late-1990s and the mid-2000s to simplify the examination of my patent applications. Mr. Razavi and I had a meeting at the PTO and several telephone conferences.

18. Because I wanted to assist the PTO in processing my applications, I took numerous actions before the PTO at Mr. Razavi's behest, with the understanding that taking such actions would expedite consideration of my applications. For example, Mr. Razavi reviewed and pre-approved amendments to patent applications that I drafted and filed. True copies of three excerpted telephone conference records for telephone conferences with Mr. Razavi are attached hereto as Exhibit 7. Mr. Razavi suggested that my patent attorney and I inform the patent examiners that the amendments were pre-approved by him and we did so. An excerpt from such an amendment informing an examiner to that effect is attached hereto as Exhibit 8. Mr. Razavi did not mention delay, laches, or any other such issue, and he did not mention that the PTO had any problem with my patent applications.

Based on timing and other considerations, it is likely that all four patent applications at issue in these cases were subject to Mr. Razavi's involvement.

19. I had several meetings with Gerry Goldberg, Director, at his office at the PTO and several telephone conversations with Mr. Goldberg in the late-1990s and in the early-2000s. Mr. Goldberg gave me guidance on issues such as claim drafting. I understood that following his guidance would expedite consideration of my applications. Mr. Goldberg did not mention delay, laches, or any other such issue and he did not mention that the PTO had any problem with my patent applications.

20. I also had meetings and telephone conversations with Mr. Werner. In my meetings and conversations with Mr. Werner, he did not mention delay, laches, or any other such issue and he did not mention that the PTO had any problem with my patent applications.

21. These facts, and others, lead me to believe that the PTO had a policy of encouraging and inducing me to take actions that it now claims resulted in or contributed to unreasonable delays.

PTO's Policy of Delaying Examination

22. Based on the PTO's actions, I believe that the PTO has numerous times implemented a policy of intentionally delaying examination of my applications.

23. For example, on page 43 of the Defendant's motion to dismiss, the PTO concedes that it suspended prosecution of the four applications at issue in these cases, among many others, for years. MTD at 43.

24. That was not the only instance where PTO suspended prosecution across many of my applications at once.

25. For example, Mr. Hjerpe and Mr. Razavi and four PTO TC Directors (Andrew Faile, Mark Powell, Joseph Rolla, and Nestor Ramirez) signed more than 2,000 suspensions of action for a period of six months each for my patent applications, causing

more than 1,000 years of aggregate delay in the prosecution of my patent applications during the 2000s.

26. Altogether, these more than 2,000 suspensions of action caused more than 1,000 years of aggregate delay by the PTO in the prosecution of my patent applications in the mid-2000s. An example of a suspension issued by the PTO is shown in Exhibit 9.

27. These delays were contrary to the PTO's own operating procedures, which specify that "[s]uspension of action at the initiative of the Office should be avoided, if possible," and that subsequent suspensions should issue only "in an extraordinary circumstance." *Manual of Patent Examining Procedure* ("MPEP") § 709(II). These more than 2,000 suspensions of action were produced in waves of hundreds of nearly identical suspensions issued together at different times over and over again in the same applications. There was also no apparent examination-related basis for these actions, which were often entered simultaneously across numerous applications that are unrelated technically or legally.

28. In addition to the delays caused by the suspensions, there were long periods during which the PTO simply took no action, without formally entering suspensions of action.

29. I objected to these delays and attempted to expedite—not delay—action on my applications. To that end, I sent numerous status inquiry letters, filed over 1,000 petitions for an action on the merits or, in cases that had already been appealed, for an examiner's answer (the PTO version of an opposition brief to my appeal brief) or a waiver thereof, without which the appeal will not be decided by the Board of Appeals. Under the PTO's own procedures, the patent examiners should have filed responsive examiner's answers within two months, *see* MPEP § 1207.02, but the examiners never did so. My petitions, both in appealed and non-appealed cases, were either ignored by the PTO or were dismissed, and were often followed by more suspensions. Exhibit 10 provides the detailed events of 80 appealed applications which the PTO delayed by withholding examiner's

answers, refusing to pass the appeals to the Board of Appeals, and issuing waves of suspensions of prosecution. Exhibit 11 shows the timeline of these 80 appealed applications, including my repeated petitions for action and the waves of simultaneous PTO suspensions in these applications.

30. Many of my applications, despite being assigned to an examiner, have languished due to the PTO's unexplained inaction. Yet, pursuant to MPEP § 707.02, applications are considered "special" if they have been pending for more than 5 years. A patent application that is deemed "special" is entitled to prioritized treatment and may be advanced out of turn for examination. *See generally* 37 C.F.R. § 1.102. All of my applications must be considered "special" and have long been entitled to expedited treatment.

31. In my conversations with Mr. Hjerpe regarding the examination of my applications, he explained to me about the PALM system and docketing. He also mentioned "dockets" and "docketing" numerous times, stated he would put my applications on an examiner's docket, and informed me they were on an examiner's docket or that he would docket them. As I understand it, every material activity, action, or transaction in a patent application is recorded in the PALM system by status codes and event codes. For each patent examiner, the PALM system provides examiner-specific bi-weekly docket reports identifying docketed applications for examination as regular, special, or expedited applications in priority order; the individual examiner rejected applications; the individual examiner new applications, sorted by month of filing. MPEP § 1704. Thus, PALM records and bi-weekly examiner docket reports generated by the PALM system can reveal when applications were placed on the examiner's docket for action and when examiners were actually working on specific applications and other internal actions taken by PTO. This information is not generally available outside of the PTO. I understand that the PALM records and reports are preserved and backed-up in their entirety. I believe that the full PALM records, as well as related records and reports maintained by the PTO would therefore provide evidence of PTO's prioritization and processing of my applications.

32. The PTO's policy of delaying the examination and appeal of my patent applications continues in force to this day, based on actions it has taken to delay examination and frustrate appeals in many of my applications.

PTO's Misrepresentations Regarding Its Consideration of My Applications

33. On a number of occasions, the PTO has misled me to believe that it intended to expedite consideration of my applications or otherwise take prompt action on them. In reality, it has delayed action on them for many years, for which it now blames me.

34. I have filed petitions asking that the PTO act on about 184 of my pending applications that languished for years at the PTO with no examiner action. In my petitions I explained that my applications have been pending longer than 5 years and so were considered "special" pursuant to MPEP § 707.02 and entitled to prioritized treatment. *See, e.g.,* Exhibit 12.

35. In answering my petitions, the PTO acknowledged that the patent applications were "special" and thus entitled to special expedited treatment but dismissed the petitions *as moot* because the "application by virtue of its prolonged pendency is already special in accordance with PTO policy." Exhibit 13. The PTO also stated that "[t]he examiner will be notified that this application should be considered as 'special' and appropriate for expedited action." *Id.*

36. Contrary to these misleading promises to treat the applications as "special" and act promptly, I received no examiner action in any of these 184 cases. Instead, around May of 2007, the PTO proceeded against my applications in two ways. First, in actions signed by Mr. Razavi, it abandoned at least five of my applications by falsely asserting that I failed to respond to PTO actions mailed in 2003 (applications in Dockets 373, 380, 386, 405, and 468). I successfully petitioned to withdraw the holding of abandonment, and Mr. Razavi's actions were reversed by the Office of Petitions in all five cases. Second, around the same time, the PTO began issuing suspensions of examination in all of these applications, on average 2.5 years after the PTO represented in its petition decisions that

there would be prompt examiner action. Exhibit 14 is a table illustrating the chronology of these events. All but three of the petition decisions were signed by Kenneth A. Wieder, Special Program Examiner of TC 2600. At the time these petitions were decided, the TC's Special Program Examiners were overseeing and deciding petitions to make applications "special." *See* MPEP § 708.02(XII) (8th ed., Rev. 2, May 2004) ("Petitions to make special are decided by the Special Program Examiner of the TC...."). Therefore, the Special Program Examiner's promise for prompt action in these applications carried an imprimatur of authority for ensuring "special" treatment and prompt action, on which I relied.

37. The PTO's misrepresentations and false promises were uniformly orchestrated across all 184 petitions not only by using identical stock petition decision language, but also by denying subsequent examiner action on all of these applications for years. As Exhibit 14 shows, Mr. Razavi took over as examiner of record in most of these 184 applications, which had been previously assigned to dozens of examiners. Because it is unreasonable that Mr. Razavi could single-handedly do all work normally assigned to dozens of examiners, a reasonable inference can be drawn that the PTO had no intention of acting on these applications at that time—in other words, that Mr. Razavi was simply assigned as examiner of record in all these applications to "manage" inaction and issue suspensions. As the PTO records show, Mr. Razavi did not approve any patent applications for issuance for which he was the examiner of record.¹

38. In one instance, the first case listed in Exhibit 14, after I filed a petition for examiner action, Exhibit 15, the PTO denied it but stated that, "in view of the lengthy prosecution in the instant application, the file is being forwarded to the examiner for *immediate* action as appropriate. Any delay caused petitioner in the treatment of the petition

¹ Search of the PTO database at <http://patft.uspto.gov/netahtml/PTO/search-adv.htm> using the search string (EXA/"Razavi; Michael" OR EXP/"Razavi; Michael") yields no issued patents after February 2007.

and the Appeal Brief is regretted.” Exhibit 16 (emphasis added). That “immediate action” did not happen. Instead, the PTO took no action for more than a year and then issued a suspension.

39. Examiners of record at the time of my petitions for action in these applications were clearly not working on my applications. PTO records show that the examiners issued numerous other patents without examining my applications during the period that they were to treat my applications as “special”—i.e., first on their action docket. Exhibit 17. The PTO docket management procedures require that after a petition decision, the application files be “forwarded to the examiner” with a corresponding PALM time stamp to that effect. The specific applications must therefore appear on the examiners’ bi-weekly docket report as “special,” having expected examiner actions within 14 days on average with a maximum control ceiling of 28 days. *See* Patent Office Professional Association, *Patent Examiner Performance Appraisal Plan Guidelines* 55 (Apr. 2012). That “special” treatment did not happen in any of the 184 applications.

40. These actions, taken consistently across a group of 184 applications, reflect a policy by the PTO to delay action on my applications, even where expedition is required by agency rules, and to mislead me regarding the status of my applications and the PTO’s actions on them. Based on my interactions with the PTO, including those described in this Declaration, I have reason to believe that the same or similar policies were carried out with respect to many other of my applications.

PTO’s Bad Faith or Unclean Hands

41. Based on the PTO’s conduct and other evidence, I understand and believe that the PTO’s ultimate policy is to prevent my patent applications from issuing regardless of their merits.

42. The PTO has blocked the fair and impartial examination of my applications and, in many cases, blocked me from obtaining final agency action on the merits subject to judicial review.

43. I had a telephone conversation with a patent examiner who was examining many of my patent applications in the mid-2000s in one of what the PTO calls a “family” of applications. This patent examiner told me that he wanted to issue these patent applications but that his supervisor would not let him do so. These patent applications are still pending about a decade later, and most of them have been re-examined with totally new non-final rejections on the same claims that were examined a decade before. The PTO is thus starting over with non-final rejections on patent applications that it had examined about 20 years ago and on which at least one examiner stated that he wanted to issue patents to me. On further information and belief, there is discoverable evidence that several times during the 2000s examiners were told by supervisors that none of my patent applications would be permitted to issue, that my patent claims should be “rejected out of hand,” and that the examiners should erect all possible barriers to overwhelm me with paperwork burdens that would make it difficult for me to respond.

44. The PTO has tied up my applications in a never-ending cycle of administrative proceedings, which it refers to as “recycling.” I met with the Director of Technology Center 2600, Andrew Christensen, on November 16, 2006. This meeting occurred just after the Board of Appeals had reversed the rejections in two of my patent applications, and the PTO had then reopened prosecution instead of allowing the two applications to issue as patents. After I described this treatment, Mr. Christensen confirmed that it was the “policy” of the PTO to “recycle” my patent applications—going round and round from the examining groups to the Board of Appeals and then back to the examining groups and then back to the Board of Appeals. My meeting notes were contemporaneously sent to the PTO for filing in the records of the relevant applications. *See Exhibit 18.* Mr. Christensen also signed many of the suspensions. *See Exhibit 9.*

45. PTO has taken other actions to avoid judicial review of the merits of final actions denying issuance of patents for most of my applications. In particular, the PTO has

not only interposed delays in examination, but has also frustrated my ability to obtain final agency action on the merits that could be challenged in court.

46. For example, there are many instances in which I prevailed at the Board of Appeals only to have the PTO end-run the decisions of the Board of Appeals, reopen prosecution of these applications, issue non-final office actions, and cause additional years of delay. This PTO policy has caused years if not decades of delay in the prosecution of my patent applications while attempting to keep my applications from issuing as patents.

47. Similarly, the PTO has taken apparently coordinated action across numerous applications to frustrate administrative appeals that might result in issuance of patents or final agency action subject to judicial review.

48. During a typical appeal to the Board of Appeals the applicant files an Appeal Brief, the examiner files a response called an examiner's answer, and the applicant files a Reply Brief. However, in 80 of my applications, after many years of PTO delay, I filed Appeal Briefs in these patent applications. After a long period of additional delay by the PTO (typically more than five years), rather than file examiner's answers and forward the cases to the Board of Appeals, the examiners reopened prosecution without identifying any ground for rejection. Exhibit 10; Exhibit 11. For example, in one application, this action took these 80 applications back 20 years, to the beginning of the examination process. There is no PTO rule or procedure that permits examiners to reopen prosecution without giving notice of the new ground for rejection. Instead of giving a new ground of rejection, the examiners demanded that I select only a small subset of my claims for *repeated* examination. After I made claim selections under protest, the examiners issued rejections based on many of the same arguments that had already been addressed in the Appeal Briefs, which the PTO refused to consider. I filed petitions to have my Appeal Briefs considered by the examiners but the PTO denied the petitions. The patent examination was thus restarted from the very beginning with no consideration given to the 20 years of prosecution that had already occurred.

49. Based on my interactions with the PTO, I believe it has adopted a policy of drafting office actions and communications so as to maximize the burden and effort required for me to respond, even by raising issues that are frivolous. The result has been the imposition of a substantial time and expense burden on me, while putting me at risk of adverse action for failure to respond in full compliance.

50. In 2013, the PTO set back the examination process in nearly all of my applications to a time prior to the original non-final office actions generated 20 years ago (not including the four patent applications in the instant actions) through a series of about 400 office actions undertaken over a period of just six months. Many of these applications are still waiting for an imminent non-final office action three years after the 2013 actions and more than 20 years after the first non-final office actions were generated. The 2013 actions appear to have been coordinated across nearly all of my applications, suggesting a common policy and a lack of regard for the unique substance and circumstances of each application.

51. The PTO's 2013 actions, like other actions taken by PTO, prejudiced me in two respects. First, after years of inaction in all applications, when PTO takes hundreds of near-simultaneous actions in nearly all applications, rather than through the normal pipeline process of taking action at spaced intervals as would have occurred had action in these applications been unfrozen, it taxes the resources of even the most diligent applicant to respond to them all expeditiously. Second, because PTO placed my applications in limbo for years before suddenly requiring me to amend them, the experienced and knowledgeable attorneys and staff who assisted me in prosecuting my applications during the early- and mid-2000s were no longer available, requiring me to attempt to bring others up to speed rapidly on my inventions. As a result, I was not able to amend most of my patent applications before responding to the office actions, which I believe to have been the PTO's purpose in issuing so many actions at once.

52. The PTO has claimed at various times that it “lost” entire file histories for more than 50 of my patent applications—about 13 percent of my pending applications. In some cases, the PTO has lost and found the file histories of a single application several times, and in other cases I have had to replace the PTO’s lost file histories with copies from my files. A considerable delay is imposed on a patent application each time the PTO loses part or all of the file history. I am not aware of the PTO regularly “losing” other applicants’ file histories.

53. In my docket number 829, I filed a District Court action to compel examination of all of the claims, rather than only a subset imposed by the PTO. The PTO moved to dismiss the case to enable the Board of Appeals to render a decision that might moot the court case. My District Court action was dismissed without prejudice in 2000, pending a decision by the Board of Appeals. The Board of Appeals reversed the examiner’s rejections in part, and thus the PTO should have examined the rest of the claims. However, in 2016, about 15 years after the court dismissal and the Board decision, this application is still awaiting an examiner’s action.

Responsibility for Delay

54. PTO faults me for the sheer amount of time that has elapsed since my applications were filed. Three examples serve to demonstrate how PTO’s policies and practices that are unique to my applications, taken altogether, have caused decades of delay on my applications and have severely prejudiced me.

55. **Example 1.** This example involves instances of the PTO delaying its first actions on applications for 9 years after they had been filed, without any explanation.

- a. In 2004, I filed the patent applications of Docket Nos. 904 and 906. At that time, the average wait for a first action on an application was about 21 months. PTO, *Performance and Accountability Report for Fiscal Year 2005*, at 22.
- b. It was not until October 2013, 9 years after filing, that the PTO issued an action imposing certain requirements but without an action on the merits.

This was despite the fact that there could have been no antecedent factors for PTO delay, because these applications did not claim any priority to any other of my pending applications.

- c. This delay has not only prejudiced me by denying me patent protection for years, but it also prejudiced the public. Under 35 U.S.C. § 154(b)(1)(A)(i), the term of the patent shall be extended 1 day for each day beyond 14 months until the first PTO action is taken on the application. Thus, when patents are issued on these applications, their term would be adjusted by adding about 8 years—an extension that would deprive the public of free access to the technology for 8 years longer. The responsibility for this prejudice to the public lies squarely with the PTO.

56. **Example 2:** This example illustrates how the PTO can employ multiple approaches to delay action on what it considers a disfavored application for decades.

- a. I filed a patent application on *High Intensity Illumination Control System*, designated as Docket No. 146 on December 13, 1977 (40 years ago).
- b. After my claims were rejected, I filed a notice of appeal and an appeal brief in 1989, more than 25 years ago.
- c. The PTO Board of Appeals finally decided the appeal, reversing in part the examiner on May 20, 2013, approximately 25 years after I filed my appeal brief. The journey to this 2013 event is replete with many instances of the PTO's use of its favored arsenal for dilatory conduct, including losing file histories multiple times and taking years to find them, asking me to furnish copies of items purported to be irretrievably "lost" at the Office, falsely abandoning my applications several times, suspending action several times, not responding to numerous status inquiries, dismissing several of my petitions for action, and leaving other petitions unanswered for decades. This tortured record is provided in great detail in a submission I made to the Board

of Appeals found in Exhibit 19. The Board of Appeals decision contained new grounds of rejection, and I responded in July of 2013. Since July 2013, the application has been awaiting action by the examining corps. The delay is now 40 years and counting.

57. **Example 3:** This example illustrates the arbitrary and extremely prejudicial actions that PTO took against me in connection with its withdrawal from issue of my U.S. Patent 5,625,761.

- a. On September 20, 1991, I filed a patent application for *A Transform Processor System Having a Lower Resolution Higher Speed Transform Processor in Combination With a Higher Resolution Lower Speed Transform Processor*, Ser. No. 07/763,395 (Docket No. 342) (the “395 application”).
- b. After a final rejection by the examiner, I filed an appeal and the Board of Appeals reversed the examiner. I subsequently received a notice of allowance on January 4, 1996. I paid the issue fee, and Patent No. 5,625,761 was assigned. An issue notice including bibliographic information, a drawing, and the first claim were published in the PTO’s Official Gazette, 1197 OG 3543 (April 29, 1997) as is the PTO policy with newly issued patents. *See* Exhibit 20.
- c. A week before the publication in the Official Gazette, in a letter by Karna Cooper, Paralegal Specialist in the Office of the Director, the PTO withdrew the patent from issue under 37 C.F.R. § 1.313, stating only that the purpose is to “reopen prosecution.” A copy of the letter from Karna Cooper is attached hereto as Exhibit 21. At the time of withdrawal from issue, the MPEP required that when prosecution is reopened after the payment of issue fee, “[t]he examiner at once writes a letter in the case stating that the application has been withdrawn from issue, citing the new reference, and rejecting the claims met thereby. The letter is given a paper number and placed in the file.”

MPEP § 1308.01 (6th ed., Rev. 2, July 1996). No such claim rejection letter was provided, and no reason or ground of rejection of any previously-allowed claim was given.

- d. Although prosecution in the '395 application was nominally reopened, the PTO has been sitting on it without action on the merits for almost 20 years. I filed petitions for action on January 21, 2005, August 28, 2007, and March 30, 2009. Copies of the petitions for action are provided in Exhibit 22. The PTO ignored all these petitions. Instead, more than a year after my second petition, the PTO started issuing a series of suspensions of the application, on December 31, 2008, April 21, 2010, January 21, 2011, October 13, 2011, and June 13, 2012, without making a single rejection on any claim since it purportedly reopened prosecution in 1997.
- e. The PTO has issued no patent to me at any time after April 29, 1997, the date that my '395 application was to be issued as Pat. No. 5,625,761 had it not been withdrawn from issue. I believe that it was around that time that the PTO had adopted internal policies and procedures to avoid issuance of any of my meritorious patent applications.
- f. Despite its withdrawal from issue, the PTO made the '395 application available to the public in violation of law, published it in the Official Gazette in 1997 and on its public Patent Application Information Retrieval ("PAIR") website. In 1997, 35 U.S.C. § 122 (Confidential status of applications) prescribed: "Applications for patents shall be kept in confidence by the Patent and Trademark Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner." I have given no authority to the PTO to publish the '395 application without issuing it as a patent. No act of Congress

necessitated the publication of the '395 application, nor is there a record that the PTO Commissioner made any determination that special circumstances arose to warrant such publication.

- g. Between my payment of the issue fee on April 5, 1996, and the April 29, 1997 publication in the Official Gazette, the PTO had ample time and opportunity to ensure that the '395 application would not appear in the Official Gazette if it intended to withdraw it from issue. By making the '395 application available to the public without issuing a patent in exchange, the PTO irreversibly violated the patent bargain by disclosing my claimed invention without issuing me a patent. I am not aware of such an unlawful publication occurring to any other applicant.

58. These examples not only support my belief that PTO has adopted policies and procedures specific to my applications, but also demonstrate the cumulative effect of the application of those policies against me.

59. Based on these examples, others like them, and the other facts discussed in this memorandum, I believe that the PTO is no longer acting on my applications in good faith and that it has not been for some time.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Executed on the 27th day of December, 2016.


Gilbert P. Hyatt

Exhibit 1. Telephone record of Mr. Hjerpe's call to me

#7 1/2
6/25/97IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)
)
 GILBERT P. HYATT)
)
 Serial No. 08/471,598)
 08/471,700)
 08/471,704)
 08/471,702)
 08/479,087)
 08/466,953)
)
 Docket No. 509, 512, 514, 516,)
 517, 538 respectively)
)
 Filed: June 6, 1995)
)
 For: IMPROVED MEMORY ARCHITECTURE)
 HAVING A MULTIPLE BUFFER)
 OUTPUT ARRANGEMENT)
)

Group Art Unit: 3609

Examiners: Jeffrey Brier
Steven Saras
K. Farnandez StollRECEIVED
96 MAR 20 AM 10:44
GROUP 260TELEPHONE CONFERENCE RECORD

Hon. Assistant Commissioner
 For Patents
 Washington, D.C. 20231

Sir:

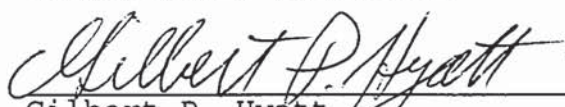
SPE Richard Hjerpe telephoned the Applicant on March 13, 1996. SPE Hjerpe told the Applicant that each of the six related applications listed above did not have the August 1995 preliminary amendment in the file wrapper. The Applicant checked and confirmed to SPE Hjerpe that an August 1995 preliminary amendment was filed in each of the six applications. SPE Hjerpe asked the Applicant for a copy of each of the six preliminary amendments and the Applicant said that he would supply copies thereof.

Transmitted herewith is a copy of each of the six preliminary amendments. Attached hereto as Exhibit A is a copy of each of the return postcards related to each of the six preliminary amendments.

The Applicant respectfully requests that a separate copy of this paper be placed in the file wrapper of each of the six applications identified above.

Dated: March 15, 1996

Respectfully submitted,



Gilbert P. Hyatt
Registration No. 27,647
P.O. Box 81230
Las Vegas, NV 89180
Phone (702) 871-9899

Exhibit 2. Telephone conference record on providing prior art for the “Hyatt Room”



APPENDIX - I

RECEIVED

MAR 05 1999

Group 2700

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)

GILBERT P. HYATT)

Serial No. 08/435,894)

Docket No. 500)

Filed: May 5, 1995)

For: AN MEMORY SYSTEM HAVING IMPROVED)
INFORMATION FLOW)

Group Art Unit: 2774

Examiner: Xiao Wu

TELEPHONE CONFERENCE RECORD

Hon. Assistant Commissioner
For Patents
Washington, D.C. 20231

Sir:

SPE Richard Hjerpe and the Applicant's representative, Mr. Vincent Turner, spoke on the telephone on December 10, 1998 and on December 15, 1998 regarding IDSs in the pending applications of the Applicant. SPE Hjerpe said that he had met with the directors of the groups examining the Applicant's pending applications regarding IDSs being filed by the Applicant. SPE Hjerpe stated that the Directors had decided that, when an IDS is relevant to multiple applications, the Applicant should file an individual IDS in each relevant application and that the Applicant should file three copies of each patent and nonpatent reference with SPE Hjerpe. This will make it more convenient for the Applicant and for the PTO. SPE Hjerpe suggested that the Applicant select an application and direct the copies of the references to that application for convenience. The Applicant has selected the instant application identified above.

SPE Richard Hjerpe and Mr. Vincent Turner spoke on the telephone on February 2, 1999. SPE Hjerpe suggested that the Applicant deliver the copies of the references to his office in room 6R01, in Crystal Park 2, on the sixth floor, at the PTO.

Respectfully submitted,

Dated: February 2, 1999

Vincent Turner

Vincent Turner

Registration No. 40,419

P.O. Box 33189

Las Vegas, NV 89133

Phone (702) 396-4670

Exhibit 3. IDS per Mr. Hjerpe's request

0271102

#38
2674

BEST AVAILABLE COPY

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
 RECEIVED
 FEB 19 2002
 Technology Center 2600

In re Application of)
)
 GILBERT P. HYATT)
)
 Serial No. 08/457,362)
)
 Docket No. 716)
)
 Filed: June 1, 1995)
)
 For: IMPROVED IMAGE PROCESSING)
 ARCHITECTURE)
)

INFORMATION DISCLOSURE STATEMENT

Hon. Assistant Commissioner
 For Patents
 Washington, D.C. 20231

Transmitted herewith is an Information Disclosure Citation (IDC) listing references for consideration by the Examiner.

The Applicant requests consideration by the Examiner of the references listed on the IDC transmitted herewith and initialing of the references listed on the IDC.

Copies of the listed references are being filed in the PTO contemporaneously herewith.

The listed references are relevant because they were cited by examiners in copending applications of the Applicant.

The instant Information Disclosure Statement is filed in accordance with directions provided by the PTO.¹

1. See the Telephone Conference Record dated February 2, 1999 regarding telephone conversations between SPE Hjerpe and Mr. Turner that took place on December 10, 1998 and February 2, 1999; which Telephone Conference Record was filed with other IDSs of record.



BEST AVAILABLE COPY

RECEIVED
FEB 19 2002
Technology Center 2600

I hereby certify that each of the listed references was cited in one of the actions in the copending applications listed hereinafter, which actions were received no more than three months prior to the mailing of this statement.

<u>DKT.</u>	<u>SERIAL NO.</u>	<u>DKT.</u>	<u>SERIAL NO.</u>
408	08/467,471	764	08/466,992
554	08/470,879	772	08/469,262
614	08/462,919	773	08/469,261
732	08/458,608	787	08/471,425
734	08/461,567	790	08/469,889
738	08/460,172	793	08/470,569
744	08/460,718		

CERTIFICATION OF MAILING BY EXPRESS MAIL: I hereby certify that this correspondence is being deposited with the United States Postal Service with Express Mail post office to addressee service under 37 CFR 1.10, postage prepaid, in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231 with the express mail label number EL819238669 on February 8, 2002.

Respectfully submitted,

Dated: February 8, 2002



 Gilbert P. Hyatt
 Registration No. 27,647
 P.O. Box 81230
 Las Vegas, NV 89180
 Phone (702) 871-9899

Exhibit 4. “Bulk Filers” Art Unit 2625

Internet Archive

Wayback Machine

92 captures
3 Jan 06 - 17 Aug 14

Go

http://www.uspto.gov/web/patents/contacts/tcmgrs.htm

371-272-6410

JAN FEB MAR
2012 2013 2014
10

ROBERT CHILDS

Return to Top

Quality Assurance Specialists (QAS)	Telephone
Wellington Chin	571-272-3134
John Peng	571-272-7272
Michael Horabik	571-272-3068
Kenneth A. Wieder	571-272-2986
Doris To	571-272-7629
Daniel Swerdlow	571-272-7531

Return to Top

TTSS Managers, HSAE's, Team Leads

HSLIE Supervisory Legal Instruments Examiner Earline Green	571-272-2993
Team 1 John W. Epps	571-272-3006
Team 3 Kimberly D. Williams	571-272-7282
Team 4 Sharone Moore	571-272-7269
Team 2 Sharon West	571-272-2996

Return to Top

2615 Bulk Filers
Director, Derris Banks

571-272-4650


Art Unit

Supervisory Patent Examiner (SPE)	Telephone
2615 Diego Gutierrez	571-272-2245

Return to Top

2630 Digital Communications
Director, Derris Banks

571-272-4650



Administrative Officers
INTERNET ARCHIVE
Wayback Machine

92 captures
3 Jan 06 - 17 Aug 14

http://www.uspto.gov/web/patents/contacts/tcmgrs.htm

Go

FEB APR JUN

15

2012 2013 2014

[Return to Top](#)

Quality Assurance Specialists (QAS)	
Wellington Chin	Telephone 571-272-3134
John Peng	571-272-7272
Michael Horabik	571-272-3068
Kenneth A. Wieder	571-272-2986
Doris To	571-272-7629
Daniel Swerdlow	571-272-7531

[Return to Top](#)

TTSS Managers, HSAE's, Team Leads	
HSLIE Supervisory Legal Instruments Examiner Earline Green	Telephone 571-272-2993
Team 1 John W. Epps	571-272-3006
Team 3 Kimberly D. Williams	571-272-7282
Team 4 Sharone Moore	571-272-7269
Team 2 Sharon West	571-272-2996

[Return to Top](#)

2615	Bulk Filers Director, Derris Banks	571-272-4650
Art Unit	Supervisory Patent Examiner (SPE)	Telephone
2615	Gregory Morse	571-272-3838

[Return to Top](#)

2630	Digital Communications Director, Derris Banks	571-272-4650
------	--	--------------



Wayback Machine

92 captures

3 Jan 06 - 17 Aug 14

http://www.uspto.gov/web/patents/contacts/tcmgrs.htm

Go

OCT NOV DEC

6

2012 2013 2014

TTSS Managers, HSAE's, Team Leads

Telephone

HSLIE Supervisory Legal Instruments Examiner Earline Green

571-272-2993

Team 1 John W. Epps

571-272-3006

Team 3 Kimberly D. Williams

571-272-7282

Team 4 Sharone Moore

571-272-7269

Team 2 Sharon West

571-272-2996

[Return to Top](#)

2615

Bulk Filers

Director, Tariq Hafiz

571-272-4650

Art Unit

Supervisory Patent Examiner (SPE)

Telephone

2615

Gregory Morse

571-272-3838

[Return to Top](#)

2630

Digital Communications

Director, Derris Banks

571-272-4650

Art Unit

Supervisory Patent Examiner (SPE)

Telephone

2631

Shuwang Liu

571-272-3036

2632

David Payne

571-272-3024

2632

Chieh Fan

571-272-3042

2633

Sam Ahn

571-272-3044

2634

Daniel Washburn

571-272-5551

[Return to Top](#)



Exhibit 5. SAWS Criteria



UNITED STATES PATENT and TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND
TRADEMARK OFFICE
WASHINGTON, D.C. 20231
WWW.USPTO.GOV

DATE: May 15, 2002

TO: Patent Examining Group Directors

FROM: Esther Kepplinger
Deputy Commissioner for Patent Operations

SUBJECT: Sensitive Application Warning System (SAWS) Program

The following reminders are being distributed about the SAWS program:

- Each Technology Center will distribute a SAWS memo to examiners at least semi-annually. The memo will briefly describe the SAWS program and will list both general Corps-wide SAWS criteria as well as Technology Center-specific SAWS criteria.
- Independent of the SAWS program, examiners should be encouraged to bring to their supervisor's attention any application that raises issues that they are uncertain how to handle, e.g. simple inventions for which art cannot be located.
- Each Technology Center will continue to use or implement an internal-TC tracking and/or flagging system.
- SAWS cases that have been through the TC-screening process and are at the allowance stage should be brought by the Director or his/her designee to the attention of the Deputy Commissioner for Patent Operations and the Deputy Commissioner for Patent Examination Policy.

SAWS Program Management Guidelines are attached.

Attachments: Management Guidelines for the SAWS Program

Management Guidelines for SAWS Program

- I. Program Overview
- II. Operational Overview
 - A. Corps-wide SAWS Subject Matter
 - B. Recommended Technology Center Practices
- III. Miscellaneous Issues
 - A. Pre-Grant Publication (PG-PUBS)

I. PROGRAM OVERVIEW:

The SAWS program is designed to assist in processing of patent applications identified as claiming subject matter of special interest, that, if issued, would potentially generate high publicity or would potentially have a strong impact in the patent community. It is also an information gathering system to apprise various segments of the USPTO of these patent applications.

As a program to assist in processing of patent applications, it is intended to ensure that the examination standards and guidelines are applied properly to such applications that include sensitive or noteworthy subject matter.

As an information gathering system, the SAWS program should be identifying applications that, if issued as a patent, would be controversial or noteworthy.

The initial identification of SAWS applications is performed by the examiners (may also include managers and classifiers). Therefore, it is important that examiners are well informed about this program and the identification criteria.

Independent of the SAWS program, examiners should be encouraged to bring to their supervisor's attention any application that raises issues that they are uncertain how to handle. Supervisors are responsible for determining which applications proceed through the SAWS program versus those applications having other issues which are normally addressed by existing examination procedures and established examination guidelines.

II. OPERATIONAL OVERVIEW:

It is recommended that the TCs handle the SAWS program based upon a tiered process of application identification. This process may utilize Examiners and SPEs to identify these applications, and a SAWS screening committee to verify their status.

Applications which have been identified and verified as containing SAWS material are reported the TC Group Director, and as needed, forwarded to the Deputy Commissioner for Patent Operations and the Deputy Commissioner for Patent Examination Policy prior to allowance.

A. Corps-wide Potential SAWS Subject Matter

The following subject matter has been determined to be criteria for identifying potential SAWS applications throughout the Patent Corps.

1. Applications which have old effective filing dates (pre 6/8/1995, i.e. pre-GATT) and claims of broad scope (submarines);
2. Applications with pioneering scope;
3. Applications dealing with inventions, which if issued would potentially generate extensive media coverage;
4. Applications which have objectionable or derogatory subject matter in the specification and/or drawing(s);
5. Applications having claims defining inventions which would endanger individuals, the environment, harm the security of our nation or threaten public safety;
6. Commissioner-ordered re-exams, except those ordered because of prior art timely filed, but not considered, before the patent issued, or for prior art submitted under 37 CFR §1.501;
7. Applications claiming a method or apparatus to take a human life (e.g. suicide machine, abortion);
8. Applications claiming a motor or power plant which is self-sustaining (perpetual motion) or appears to violate the laws of physics (e.g. antigravity, faster than the speed of light, etc.);
9. Applications claiming the prevention or curing of diseases which were previously considered impossible to prevent or cure; and
10. Human cloning.

B. Technology Center Recommended Practices:

1. Examiners are the first line of review since they are the most knowledgeable about the pending claims and application issues. Examiners will report potential SAWS cases to their SPE. Upon approval of the SPE, a person designated by the technology center will enter the SAWS case into the appropriate TC tracking system.
2. A reminder and an updated SAWS criteria list will be distributed, at least semi-annually, to examiners to stress the importance of SAWS application identification.
3. Flagging an identified SAWS application in PALM to ensure that the case does not issue until the flag has been removed.

4. Utilizing a TC-specific screening mechanism to remove non-SAWS applications from their SAWS designation. This screening mechanism permits a second review and will result in a recommendation as to whether the application contains SAWS subject matter. The screening mechanism can be performed by a committee made up of SPEs representing a cross section of the Technology Center and a SPRE or a QAS.
5. Applications that have been through the TC screening mechanism and have been identified as SAWS cases will be brought to the attention of the TC Group Director. The Group Director will bring them to the attention of the Deputy Commissioner for Patent Operations and the Deputy Commissioner for Patent Examination Policy.
6. For uniformity and process improvements, a SPRE, QAS, or a SAWS TC-screening committee should be utilized. A SPRE, QAS, or a SAWS TC-screening committee will be tasked to periodically review the SAWS processing guidelines and criteria to continually update and revise the program as needed.
7. Placing a PALM Flag on subject classes which encompass sensitive subject matter until a review of these cases is performed upon allowance (such as business methods, class 705).

III. MISCELLANEOUS ISSUES

A. Pre-Grant Publication

Pre-grant publication should not warrant SAWS consideration. Applications published under Pre-grant publication are published "as-filed" and the claims, as-published, have not gone through any examination.

A separate procedure for determining acceptability of what gets published under Pre-grant publication is being established.

SAWS Committee members and Contacts

1600

Brian Stanton

1700

Doug McGinty

Kat Gorgos

2100

Jack Harvey

Tod Swann

2600

Tommy Chin

John Peng

2800

Hien Phan

Clayton LaBalle

3600

Randy Reese

Ken Dorner

Dave Mitchell

3700

Derris Banks

Cliff Crowder

Paul Sewell

Hank Recla

Exhibit 6. SAWS Decision process and OPLA's practice of withdrawing patentable applications from issue

LeGuyader, John

From: LeGuyader, John
Sent: Friday, March 02, 2012 2:13 PM
To: Bragdon, Kathleen; Stone, Jacqueline
Subject: Re: Saws

Not ultimately my call but I would say no. 1600 is the outlier with this issue and that might be the only area I personally would want to know. 1600 would be emblematic of the OPLA issue is there is one at all.

From: Bragdon, Kathleen
Sent: Friday, March 02, 2012 02:05 PM
To: LeGuyader, John; Stone, Jacqueline
Subject: RE: Saws

I would need to check w/each TC individually. We track how many are in SAWS status every month, but we don't track "why" they leave (OPLA approved, OPLA asked for changes to allow, OPLA said "no way").

I you want me to check, I just need to know what to ask them. I can think of the below that might get at what you want? Some variation of this?

How many went for SAWS review? (time frame?)

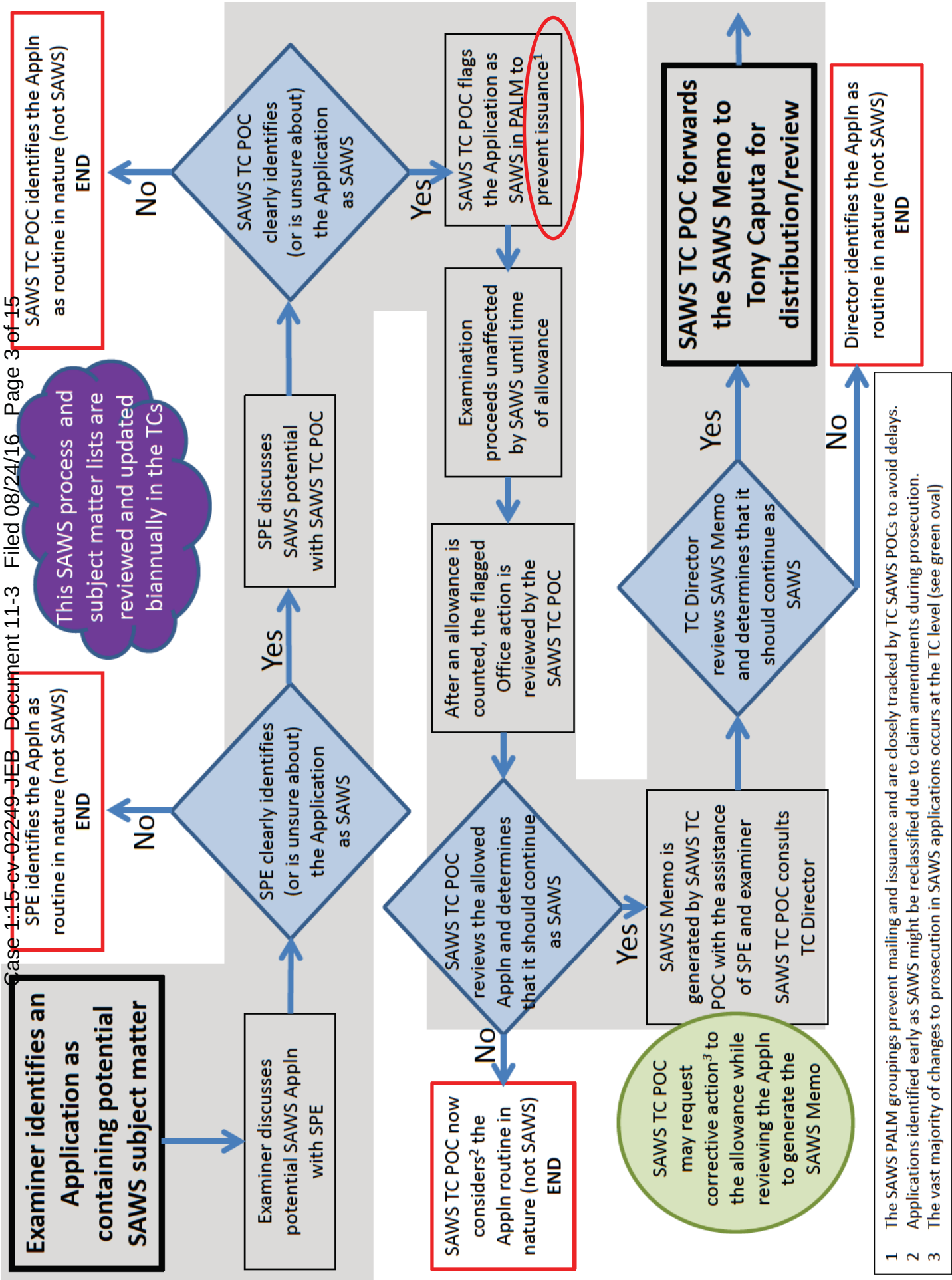
- How many cleared SAWS review w/out any issues?
- How many cleared SAWS review (as is) after working with the TC?
- How many only cleared after changes?
- How many were could not get allowed (had to be withdrawn from issue)?

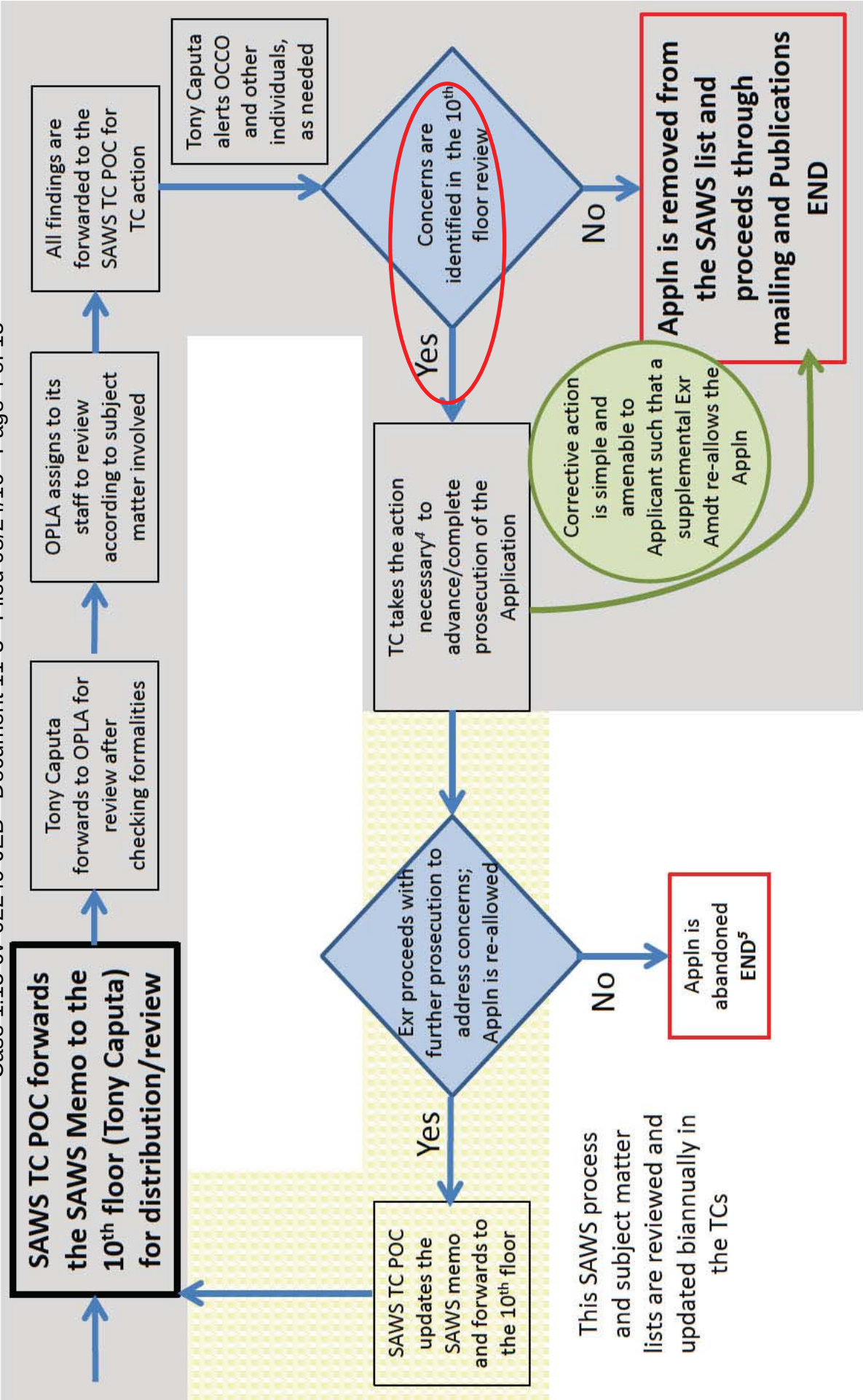
I can't imagine Tony keeps any kinds of records, he just seems to forward to OPLA and forward back from them.

Original Message

From: LeGuyader, John
Sent: Friday, March 02, 2012 11:12 AM
To: Stone, Jacqueline; Bragdon, Kathleen
Subject: RE: Saws

And since Tony Caputa is the 10th floor gate keeper on this (he receives for the 10th floor a SAWS from a TC at the director' discretion and handles as deemed necessary including forwarding to OPLA), he may have a better idea.





⁴ Necessary action can include specific claim amendments to address OPLA's concerns that Applicant might agree to (see green circle which expedites allowance), reinstating a previous (improperly dropped) rejection, and reopening to apply a new rejection.

⁵ Often ABN applications remain on the SAWS list in case they are revived; these cases are removed when provided statistics of pending SAWS cases

Exhibit 7. Telephone conference with Mr. Razavi



#15
6/24/97
RS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)	
GILBERT P. HYATT)	Group Art Unit: 2613
Serial No. 08/458,141)	Examiner: Gerard Del Rosso
(See Appendix-I for 99 other)	Joseph Mancouso
applications))	Larry Prikockis
Docket No. 700)	Bipin Shalwala
Filed: June 1, 1995)	Chanh Nguyen
For: IMPROVED IMAGE PROCESSING)	Jon Chang
ARCHITECTURE)	Team Exam-Six

TELEPHONE CONFERENCE RECORD

Hon. Assistant Commissioner
For Patents
Washington, D.C. 20231

RECEIVED
MAY 12 97
GROUP 2600

Sir:

This transmittal is submitted for filing in each of the 100 applications listed in Appendix-I.

If separate copies of this document are needed for placement in the file wrapper of each of the applications identified in Appendix-I, the Applicant will promptly provide same upon notice that such is necessary.

This is a telephone conference record. On March 24, 1997; the Applicant's representative, Mr. Vincent Turner, telephoned Mr. Michael Razavi, SPE of Art Unit 2613, and inquired about the procedure for filing a Conforming Amendment in each of 100 pending related application that are pending in SPE Razavi's art unit. SPE Razavi requested a draft copy of the Conforming Amendment and the Applicant transmitted by facsimile a draft copy on March 24, 1997. A copy of this draft copy of the Conforming Amendment is attached hereto as Exhibit A.

SPE Razavi telephoned Mr. Turner on April 15, 1997 and told Mr. Turner that the Conforming Amendment was acceptable and would be entered in the 100 related applications. SPE Razavi telephoned Mr. Turner on April 18, 1997 and told Mr. Turner that the Conforming Amendments in the 100 related applications should be filed in each application as a separate paper.

Respectfully submitted,

Dated: April 22, 1997

Vincent Turner

Vincent Turner
Registration No. P-40,419
P.O. Box 36370
Las Vegas, NV 89133
Phone (702) 396-4670

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)	
)	
GILBERT P. HYATT)	Group Art Unit: 2613
)	
Serial No. 08/458,141)	
(See Appendix-I for)	
45 other applications))	
)	
Docket No. 700)	
)	
Filed: June 1, 1995)	
)	
For: IMPROVED IMAGE PROCESSING)	
ARCHITECTURE)	
)	

TELEPHONE CONFERENCE RECORD

Hon. Assistant Commissioner
For Patents
Washington, D.C. 20231

Sir:

This is a telephone conference record for each of the 46 patent applications listed in Appendix-I.

The Applicant's representative, Mr. Vincent Turner, telephoned SPE Razavi on August 12, 1997. Mr. Turner left a message that amendments had been filed on August 11, 1997 in 46 related applications that are pending in SPE Razavi's art unit. SPE Razavi telephoned Mr. Turner on August 18, 1997 and told Mr. Turner that he had received the telephone message on August 12, 1997. SPE Razavi asked Mr. Turner to send by facsimile the serial numbers of those 46 applications. Mr. Turner agreed.

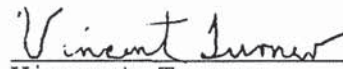
Attached hereto in Appendix-I is a list of the serial numbers in the 46 above discussed patent applications.

If separate copies of this Telephone Conference Record are necessary for placement in the file wrapper of each of the 46 applications identified in Appendix-I, the Applicant will promptly provide same upon notice that such is necessary.

CERTIFICATION OF TRANSMISSION: I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax No. (703) 308-5397) on August 19, 1997.

Respectfully submitted,

Dated: August 19, 1997



Vincent Turner
Registration No. 40,419
P.O. Box 36370
Las Vegas, NV 89133
Phone (702) 396-4670

APPENDIX-I

<u>DKT.</u> <u>NO.</u>	<u>SERIAL</u> <u>NO.</u>
700	08/458,141
703	08/458,142
704	08/456,339
705	08/457,360
707	08/457,726
710	08/457,448
714	08/458,104
716	08/457,362
717	08/456,398
720	08/456,296
722	08/458,006
724	08/459,158
725	08/460,607
727	08/459,152
729	08/460,737
731	08/460,705
733	08/460,433
735	08/459,221
736	08/458,206
738	08/460,172
739	08/458,549
742	08/465,083
744	08/460,718
745	08/460,753
746	08/459,648
750	08/463,824
751	08/464,034
756	08/465,071
760	08/465,072
766	08/465,200
776	08/466,600
777	08/466,599
778	08/469,407
780	08/471,542
781	08/469,321
782	08/471,695
784	08/471,600
785	08/471,701
786	08/471,123
788	08/471,136
789	08/469,580
790	08/469,889
793	08/470,569
795	08/469,592
797	08/471,255
798	08/471,042

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)	
GILBERT P. HYATT)	Group Art Unit: 2714
Serial No. 08/458,141)	
(and 99 other applications)	
as listed in Appendix I))	
Docket No. 700)	
Filed: June 1, 1995)	
For: IMPROVED IMAGE PROCESSING)	
ARCHITECTURE)	

Received
FEB 09 1998
Group 2700

TELEPHONE CONFERENCE RECORD

Hon. Assistant Commissioner
 For Patents
 Washington, D.C. 20231

Sir:

The Applicant's representative, Mr. Vincent Turner, telephoned SPE Michael Razavi on December 3, 1997. Mr. Turner told Mr. Razavi that the Applicant had prepared a Conforming Amendment and a Supplemental Amendment for each of 100 applications, a list of the 100 applications is provided in Appendix I attached hereto. Mr. Turner asked Mr. Razavi if he would review and comment on a draft of the amendments, for efficiency of examination, before the Applicant filed the amendments. Mr. Razavi agreed to review the draft amendments.

In response thereto the Applicant sent a copy of the draft amendments by facsimile to Mr. Razavi on December 5, 1997. A copy of this facsimile is attached hereto as Appendix A.

Mr. Turner telephoned Mr. Razavi on January 14, 1998 regarding the draft amendments. Mr. Razavi said that he had reviewed the draft amendments and that he found them to be acceptable and that they would be entered if filed in the individual cases. Mr. Turner said that the Applicant would file the amendments in the individual cases in due course.

CERTIFICATION OF MAILING BY EXPRESS MAIL: I hereby certify that this correspondence is being deposited with the United States Postal Service with Express Mail post office to addressee service under 37 CFR 1.10, postage prepaid, in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231 with the express mail label number EM375192259 on February 2, 1998.

Respectfully submitted,

Dated: February 2, 1998

Vincent Turner
Vincent Turner
Registration No. 40,419
P.O. Box 36370
Las Vegas, NV 89133
Phone (702) 396-4670

Exhibit 8. Excerpt of an amendment per Mr. Razavi's instructions



#15
6/24/97
RS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)	
GILBERT P. HYATT)	Group Art Unit: 2613
Serial No. 08/458,141)	Examiner: Gerard Del Rosso
(See Appendix-I for 99 other)	Joseph Mancouso
applications))	Larry Prikockis
Docket No. 700)	Bipin Shalwala
Filed: June 1, 1995)	Chanh Nguyen
For: IMPROVED IMAGE PROCESSING)	Jon Chang
ARCHITECTURE)	Team Exam-Six

TELEPHONE CONFERENCE RECORD

Hon. Assistant Commissioner
For Patents
Washington, D.C. 20231

RECEIVED
MAY 12 97
GROUP 2600

Sir:

This transmittal is submitted for filing in each of the 100 applications listed in Appendix-I.

If separate copies of this document are needed for placement in the file wrapper of each of the applications identified in Appendix-I, the Applicant will promptly provide same upon notice that such is necessary.

This is a telephone conference record. On March 24, 1997; the Applicant's representative, Mr. Vincent Turner, telephoned Mr. Michael Razavi, SPE of Art Unit 2613, and inquired about the procedure for filing a Conforming Amendment in each of 100 pending related application that are pending in SPE Razavi's art unit. SPE Razavi requested a draft copy of the Conforming Amendment and the Applicant transmitted by facsimile a draft copy on March 24, 1997. A copy of this draft copy of the Conforming Amendment is attached hereto as Exhibit A.

SPE Razavi telephoned Mr. Turner on April 15, 1997 and told Mr. Turner that the Conforming Amendment was acceptable and would be entered in the 100 related applications. SPE Razavi telephoned Mr. Turner on April 18, 1997 and told Mr. Turner that the Conforming Amendments in the 100 related applications should be filed in each application as a separate paper.

Respectfully submitted,

Dated: April 22, 1997

Vincent Turner
Vincent Turner
Registration No. P-40,419
P.O. Box 36370
Las Vegas, NV 89133
Phone (702) 396-4670

Exhibit 9. PTO Suspension of examination



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
 Address: COMMISSIONER FOR PATENTS
 P.O. Box 1450
 Alexandria, Virginia 22313-1450
 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/471,070	06/06/1995	GILBERT P. HYATT	547	8145

7590 GILBERT P HYATT P O BOX 81230 LAS VEGAS, NV 89180		05/02/2007
---	--	------------

EXAMINER	
RAZAVI, MICHAEL	

ART UNIT	PAPER NUMBER
2628	

MAIL DATE	DELIVERY MODE
05/02/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



UNITED STATES DEPARTMENT OF COMMERCE

U.S. Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450

APPLICATION NO/ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
--------------------------------	-------------	---	---------------------

EXAMINER

ART UNIT	PAPER
----------	-------

20070402

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

A court decision relevant to the examination of this application will be rendered soon. Ex parte prosecution is SUSPENDED FOR A PERIOD OF 6 MONTHS from the date of this letter. Upon expiration of the period of suspension, applicant should make an inquiry as to the status of the application.

Any inquiry concerning this communication should be directed to Michael Razavi at telephone number (571) 272-7664.

Andrew Christensen
Acting Director
Technology Center 2600

Exhibit 10. Events in the 80 appealed applications

Case Index	Family	Docket No.	Filing Date	Prior Appeal Brief Filed	Prior Appeal Concluded, reopen prosecution	Last Action Issued	Notice of Appeal Filed	Appeal Brief Filed	Reopen Prosecution (PTO's version)	PTO's Suspensions	Mr. Hyatt's Petitions	Application filing fees	Total Excess Claims Fees	Total Appeal Fees	Sum of PTO Fess Paid	"Bulk Filers" Group 2615
1	370	379	05/31/95			07/18/01	01/18/02	07/05/02	09/18/13	04/25/07, 03/17/08, 12/30/08, 09/24/09, 04/19/10, 09/23/11	01/20/05	\$730	\$11,776	\$640	\$13,146	√
2	410	411	04/06/95	06/22/01	05/31/02	01/17/07	06/18/07	11/16/07	09/17/13	07/31/02, 01/31/03, 08/07/03, 05/03/07, 12/30/08, 09/25/09, 04/19/10, 09/23/11	03/30/09	\$730	\$18,250	\$1,130	\$20,110	√
3	410	415	04/10/95			11/29/07	05/29/08	12/01/08	09/17/13	07/31/02, 01/31/03, 08/07/03, 10/05/04, 05/03/07, 12/30/08, 09/25/09, 04/19/10, 09/23/11	08/28/07, 03/30/09	\$730	\$16,706	\$860	\$18,296	√
4	410	416	04/06/95	08/07/97	02/18/98	01/29/07	07/30/07	11/21/07	09/17/13	07/31/02, 01/31/03, 08/07/03, 12/30/08, 09/24/09, 04/19/10, 09/23/11	03/30/09	\$730	\$17,296	\$1,610	\$19,636	√
5	410	420	04/10/95	09/09/97	12/12/97	07/11/06	01/04/07	07/02/07	09/18/13	07/31/02, 01/31/03, 08/07/03, 12/30/08, 09/24/09, 04/19/10, 09/23/11	03/30/09	\$730	\$19,024	\$1,600	\$21,354	√
6	410	422	04/10/95	08/18/97	06/12/02	05/09/06	07/13/07	11/28/07	09/17/13	03/28/03, 09/22/03, 12/30/08, 09/24/09, 04/19/10, 09/23/11	01/19/01, 03/30/09	\$730	\$15,296	\$1,610	\$17,636	√
7	410	423	04/10/95	09/10/97	11/19/97	07/05/06	01/04/07	07/02/07	09/17/13	07/31/02, 01/31/03, 08/07/03, 12/30/08, 09/25/09, 04/19/10, 09/23/11	03/30/09	\$730	\$18,480	\$1,600	\$20,810	√

Case Index	Family	Docket No.	Filing Date	Prior Appeal Brief Filed	Prior Appeal Concluded, reopen prosecution	Last Action Issued	Notice of Appeal Filed	Appeal Brief Filed	Reopen Prosecution (PTO's version)	PTO's Suspensions	Mr. Hyatt's Petitions	Application filing fees	Total Excess Claims Fees	Total Appeal Fees	Sum of PTO Fess Paid	"Bulk Filers" Group 2615
8	410	424	04/10/95	08/12/97	12/04/97	02/02/07	07/30/07	11/16/07	09/17/13	07/31/02, 01/31/03, 08/07/03, 12/30/08, 09/24/09, 04/19/10, 09/23/11	03/30/09	\$730	\$17,826	\$1,610	\$20,166	√
9	410	425	04/12/95	08/11/97	06/05/02	10/23/06	04/23/07	10/22/07	09/17/13	03/17/08, 12/30/08, 09/25/09, 04/19/10, 09/23/11	1/19/01, 3/30/09	\$730	\$15,998	\$1,610	\$18,338	√
10	410	427	04/17/95			12/27/06	05/29/07	10/26/07	09/17/13	08/01/02, 01/31/03, 03/14/03, 09/24/03, 04/24/07, 03/17/08, 12/30/08, 09/25/09, 04/19/10, 09/23/11	03/30/09	\$730	\$18,742	\$1,010	\$20,482	√
11	410	428	04/17/95	08/11/97	10/05/04	05/17/06	11/17/06	05/21/07	09/16/13	07/31/02, 01/31/03, 08/07/03, 07/11/07, 03/17/08, 12/30/08, 09/25/09, 04/19/10, 09/23/11	1/19/01, 3/30/09	\$730	\$15,134	\$1,600	\$17,464	√
12	410	429	04/17/95			02/12/07	08/13/07	11/13/07	09/17/13	07/31/02, 01/31/03, 08/07/03, 12/30/08, 09/25/09, 04/19/10, 09/23/11	03/30/09	\$730	\$15,518	\$1,010	\$17,258	√
13	410	441	06/05/95			08/21/03	01/21/04	07/20/04	10/25/13	04/23/07, 03/17/08, 12/30/08, 09/24/09, 04/19/10, 09/23/11	08/28/07, 03/30/09	\$365	\$7,039	\$330	\$7,734	√
14	450	406	06/05/95			03/01/05	08/31/05	02/28/06	10/24/13	04/25/07, 03/17/08, 12/30/08, 09/25/09, 04/19/10, 09/23/11	08/28/07, 03/30/09	\$365	\$9,014	\$500	\$9,879	√

Case Index	Family	Docket No.	Filing Date	Prior Appeal Brief Filed	Prior Appeal Concluded, reopen prosecution	Last Action Issued	Notice of Appeal Filed	Appeal Brief Filed	Reopen Prosecution (PTO's version)	PTO's Suspensions	Mr. Hyatt's Petitions	Application filing fees	Total Excess Claims Fees	Total Appeal Fees	Sum of PTO Fess Paid	"Bulk Filers" Group 2615
15	450	465	05/03/95			05/21/03	11/21/03	05/13/04	10/24/13	05/11/07, 03/17/08, 12/30/08, 09/25/09, 04/19/10, 09/23/11	12/21/04, 08/28/07, 03/30/09	\$365	\$7,198	\$330	\$7,893	√
16	450	467	05/05/95			07/30/03	12/30/03	06/24/04	10/24/13	04/24/07, 03/17/08, 12/30/08, 09/25/09, 04/19/10, 09/23/11	12/21/04, 08/28/07, 03/30/09	\$365	\$7,318	\$330	\$8,013	√
17	450	490	06/05/95			09/09/04	02/09/05	08/09/05	10/25/13	04/23/07, 03/17/08, 12/30/08, 09/25/09, 04/19/10, 09/23/11	08/28/07, 03/30/09	\$365	\$7,721	\$500	\$8,586	√
18	450	494	06/05/95			04/13/07	10/11/07	04/09/08	10/25/13	12/30/08, 09/25/09, 04/19/10, 09/23/11	03/30/09	\$365	\$4,599	\$510	\$5,474	√
19	450	495	06/05/95			05/16/05	11/14/05	03/16/06	10/24/13	04/23/07, 03/17/08, 12/30/08, 09/25/09, 04/19/10, 09/23/11	08/28/07, 03/30/09	\$365	\$10,446	\$500	\$11,311	√
20	500	547	06/06/95			04/19/01	10/19/01	04/22/02	05/21/04	07/31/02, 01/31/03, 05/02/07, 03/17/08, 12/30/08, 09/24/09, 04/19/10, 09/23/11	01/20/05, 03/28/07, 10/15/07, 03/30/09	\$365	\$5,601	\$320	\$6,286	√

Case Index	Family	Docket No.	Filing Date	Prior Appeal Brief Filed	Prior Appeal Concluded, reopen prosecution	Last Action Issued	Notice of Appeal Filed	Appeal Brief Filed	Reopen Prosecution (PTO's version)	PTO's Suspensions	Mr. Hyatt's Petitions	Application filing fees	Total Excess Claims Fees	Total Appeal Fees	Sum of PTO Fess Paid	"Bulk Filers" Group 2615
21	550	337	06/21/90			05/19/04	11/19/04	04/15/05	10/10/13	12/02/92, 08/18/93, 04/14/94, 03/20/96, 12/31/98, 04/17/07, 07/23/08, 05/01/09, 08/02/10, 05/16/12, 08/12/91, 04/16/92, 03/20/95, 12/24/96, 11/30/07, 01/07/10, 03/29/11	08/28/07, 03/30/09	\$185	\$9,202	\$420	\$9,807	√
22	550	551	06/06/95			06/12/03	11/12/03	05/12/04	03/21/06	04/17/07, 04/14/09, 02/19/10, 07/06/11, 03/02/12, 12/20/07, 09/23/08, 10/07/10	08/28/07, 03/30/09	\$730	\$16,396	\$660	\$17,786	√
23	550	553	06/06/95			11/17/03	01/06/05	10/26/05	10/11/13	04/17/07, 04/14/09, 02/19/10, 07/06/11, 03/02/12, 12/20/07, 09/25/08, 10/07/10	08/28/07, 03/30/09	\$730	\$17,392	\$1,000	\$19,122	√
24	550	559	06/06/95			05/24/04	11/24/04	05/10/05	10/10/13	04/18/07, 04/14/09, 02/19/10, 07/06/11, 03/02/12, 12/20/07, 09/23/08, 10/07/10	08/28/07, 03/30/09	\$730	\$14,748	\$840	\$16,318	√
25	550	560	06/06/95			04/28/05	10/19/06	05/31/07	10/10/13	06/04/96, 05/10/99, 07/23/08, 05/01/09, 08/02/10, 05/16/12, 12/05/07, 01/07/10, 03/29/11, 10/13/11	08/28/07	\$730	\$18,302	\$1,000	\$20,032	√

Case Index	Family	Docket No.	Filing Date	Prior Appeal Brief Filed	Prior Appeal Concluded, reopen prosecution	Last Action Issued	Notice of Appeal Filed	Appeal Brief Filed	Reopen Prosecution (PTO's version)	PTO's Suspensions	Mr. Hyatt's Petitions	Application filing fees	Total Excess Claims Fees	Total Appeal Fees	Sum of PTO Fess Paid	"Bulk Filers" Group 2615
26	550	564	06/06/95			10/02/03	02/02/04	08/02/04	03/21/06	04/17/07, 04/14/09, 08/02/10, 05/16/12, 12/20/07, 09/23/08, 01/07/10, 03/29/11, 10/13/11	08/28/07, 03/30/09	\$730	\$15,424	\$660	\$16,814	√
27	550	568	06/06/95			10/02/03	02/02/04	08/02/04	03/21/06	04/17/07, 04/14/09, 08/02/10, 05/16/12, 12/20/07, 09/23/08, 01/07/10, 03/29/11, 10/13/11	08/28/07, 03/30/09	\$730	\$17,154	\$660	\$18,544	√
28	550	569	06/06/95			01/16/04	06/15/04	12/15/04	04/07/06	04/19/07, 04/14/09, 02/19/10, 07/06/11, 03/02/12, 12/20/07, 09/25/08, 10/07/10	05/09/06, 08/28/07, 03/30/09	\$730	\$14,944	\$830	\$16,504	√
29	600	606	05/08/95			10/21/03	02/23/04	08/23/04	02/13/06	04/19/07, 04/13/09, 02/19/10, 07/06/11, 03/02/12, 12/20/07, 09/23/08, 10/07/10	08/28/07, 03/30/09	\$730	\$16,236	\$660	\$17,626	√
30	600	607	05/05/95			09/23/03	02/23/04	08/23/04	09/18/13	04/17/07, 04/13/09, 02/19/10, 07/06/11, 03/02/12, 12/20/07, 09/25/08, 10/07/10	08/28/07, 03/30/09	\$730	\$13,345	\$660	\$14,735	√
31	600	615	06/05/95			08/15/05	02/15/06	08/15/06	09/18/13	04/17/07, 02/19/10, 07/06/11, 03/02/12, 12/20/07, 09/25/08, 04/13/09, 10/07/10	08/28/07, 03/30/09	\$730	\$15,904	\$1,000	\$17,634	√

Case Index	Family	Docket No.	Filing Date	Prior Appeal Brief Filed	Prior Appeal Concluded, reopen prosecution	Last Action Issued	Notice of Appeal Filed	Appeal Brief Filed	Reopen Prosecution (PTO's version)	PTO's Suspensions	Mr. Hyatt's Petitions	Application filing fees	Total Excess Claims Fees	Total Appeal Fees	Sum of PTO Fess Paid	"Bulk Filers" Group 2615
32	600	619	06/05/95			05/13/05	11/14/05	05/04/06	09/18/13	04/17/07, 04/13/09, 02/19/10, 07/06/11, 03/02/12, 12/20/07, 09/25/08, 10/07/10	08/28/07, 03/30/09	\$730	\$15,530	\$1,000	\$17,260	√
33	700	702	06/01/95			01/13/05	07/13/05	01/13/06	10/28/13	05/30/03, 05/11/07, 03/17/08, 12/30/08, 09/25/09, 04/19/10, 09/23/11	08/28/07, 03/30/09	\$365	\$10,282	\$500	\$11,147	√
34	700	713	06/01/95			07/15/05	01/16/06	06/29/06	10/24/13	07/31/02, 01/31/03, 08/18/03, 04/24/07, 03/17/08, 12/30/08, 09/25/09, 04/19/10, 09/23/11	08/28/07, 03/30/09	\$365	\$8,910	\$500	\$9,775	√
35	700	716	06/01/95			11/05/04	05/05/05	10/21/05	10/24/13	04/24/07, 03/17/08, 12/30/08, 09/25/09, 04/19/10, 08/18/03, 10/24/03, 09/23/11	08/28/07, 03/30/09	\$365	\$8,681	\$500	\$9,546	√
36	700	719	06/01/95			10/18/04	03/18/05	09/19/05	10/24/13	02/13/03, 07/31/03, 04/23/07, 03/17/08, 12/30/08, 09/25/09, 04/19/10, 09/23/11	08/28/07, 03/30/09	\$365	\$8,180	\$500	\$9,045	√
37	700	720	06/01/95			12/30/05	06/29/06	12/22/06	10/28/13	07/31/02, 01/31/03, 08/18/03, 04/24/07, 03/17/08, 12/30/08, 09/25/09, 04/19/10, 09/23/11	08/28/07, 03/30/09	\$365	\$10,428	\$500	\$11,293	√

Case Index	Family	Docket No.	Filing Date	Prior Appeal Brief Filed	Prior Appeal Concluded, reopen prosecution	Last Action Issued	Notice of Appeal Filed	Appeal Brief Filed	Reopen Prosecution (PTO's version)	PTO's Suspensions	Mr. Hyatt's Petitions	Application filing fees	Total Excess Claims Fees	Total Appeal Fees	Sum of PTO Fess Paid	"Bulk Filers" Group 2615
38	700	723	06/01/95			02/22/06	08/21/06	02/20/07	10/28/13	05/11/07, 03/17/08, 12/30/08, 09/25/09, 04/19/10, 09/23/11	08/28/07	\$365	\$9,459	\$500	\$10,324	√
39	700	728	06/02/95			11/03/04	04/04/05	10/04/05	10/24/13	02/07/03, 07/31/03, 05/11/07, 03/17/08, 12/30/08, 09/25/09, 04/19/10, 09/23/11	08/28/07, 03/30/09	\$365	\$8,776	\$500	\$9,641	√
40	700	730	06/02/95			06/26/06	12/26/06	06/19/07	10/24/13	10/23/02, 04/23/03, 12/30/08, 09/25/09, 04/19/10, 09/23/11	03/30/09	\$365	\$10,328	\$500	\$11,193	√
41	700	735	06/02/95			06/19/06	12/19/06	06/11/07	10/24/13	02/13/03, 07/31/03, 06/21/07, 03/17/08, 12/30/08, 09/25/09, 04/19/10, 09/23/11	03/30/09	\$365	\$10,348	\$500	\$11,213	√
42	700	736	06/02/95			04/12/05	10/12/05	03/31/06	10/24/13	07/31/02, 01/31/03, 08/18/03, 04/23/07, 03/17/08, 12/30/08, 09/25/09, 04/19/10, 09/23/11	08/28/07, 03/30/09	\$365	\$8,439	\$500	\$9,304	√
43	700	737	06/02/95			04/11/07	10/11/07	04/10/08	10/28/13	02/13/03, 07/31/03, 12/30/08, 09/25/09, 04/19/10, 09/23/11	08/28/07, 03/30/09	\$365	\$10,277	\$510	\$11,152	√
44	700	739	06/02/95			09/07/04	02/07/05	07/22/05	10/28/13	07/31/02, 01/31/03, 08/18/03, 04/24/07, 03/17/08, 12/30/08, 09/25/09, 04/19/10, 09/23/11	08/28/07, 03/30/09	\$365	\$8,747	\$500	\$9,612	√

Case Index	Family	Docket No.	Filing Date	Prior Appeal Brief Filed	Prior Appeal Concluded, reopen prosecution	Last Action Issued	Notice of Appeal Filed	Appeal Brief Filed	Reopen Prosecution (PTO's version)	PTO's Suspensions	Mr. Hyatt's Petitions	Application filing fees	Total Excess Claims Fees	Total Appeal Fees	Sum of PTO Fess Paid	"Bulk Filers" Group 2615
45	700	740	06/02/95			09/27/04	02/28/05	08/26/05	10/31/13	07/31/02, 01/31/03, 08/18/03, 05/11/07, 03/17/08, 12/30/08, 09/25/09, 04/19/10, 09/23/11	08/28/07, 03/30/09	\$365	\$8,972	\$500	\$9,837	√
46	700	742	06/02/95			06/07/06	12/07/06	06/07/07	10/24/13	10/24/03, 09/25/09, 04/19/10, 03/17/08, 09/19/08, 09/23/11	03/30/09	\$365	\$9,561	\$500	\$10,426	√
47	700	744	06/02/95			05/15/06	11/15/06	05/14/07	10/28/13	07/31/02, 01/31/03, 08/18/03, 04/25/07, 03/17/08, 12/30/08, 09/25/09, 04/19/10, 09/23/11	08/28/07, 03/30/09	\$365	\$8,935	\$500	\$9,800	√
48	700	748	06/05/95			08/09/04	02/09/05	07/11/05	10/28/13	07/31/02, 01/31/03, 08/18/03, 04/23/07, 03/17/08, 12/30/08, 09/24/09, 04/19/10, 09/23/11	08/28/07, 03/30/09	\$365	\$8,275	\$500	\$9,140	√
49	700	750	06/05/95			09/30/04	03/29/05	09/29/05	10/24/13	07/31/02, 01/31/03, 08/18/03, 05/11/07, 03/17/08, 12/30/08, 09/25/09, 04/19/10, 09/23/11	08/28/07, 03/30/09	\$365	\$7,759	\$500	\$8,624	√
50	700	751	06/05/95			03/09/05	09/09/05	03/08/06	10/24/13	02/13/03, 07/31/03, 04/23/07, 03/17/08, 12/30/08, 09/25/09, 04/19/10, 09/23/11	08/28/07, 03/30/09	\$365	\$11,156	\$500	\$12,021	√

Case Index	Family	Docket No.	Filing Date	Prior Appeal Brief Filed	Prior Appeal Concluded, reopen prosecution	Last Action Issued	Notice of Appeal Filed	Appeal Brief Filed	Reopen Prosecution (PTO's version)	PTO's Suspensions	Mr. Hyatt's Petitions	Application filing fees	Total Excess Claims Fees	Total Appeal Fees	Sum of PTO Fess Paid	"Bulk Filers" Group 2615
51	700	755	06/05/95			11/05/04	04/04/05	10/04/05	10/28/13	02/13/03, 07/31/03, 05/11/07, 03/17/08, 12/30/08, 09/24/09, 04/19/10, 09/23/11	08/28/07, 03/30/09	\$365	\$6,562	\$500	\$7,427	√
52	700	756	06/05/95			01/31/07	07/30/07	01/30/08	10/28/13	05/30/03, 12/31/08, 09/25/09, 04/19/10, 09/23/11	03/30/09	\$365	\$10,310	\$505	\$11,180	√
53	700	757	06/05/95			09/07/04	02/07/05	07/22/05	10/28/13	07/31/02, 01/31/03, 08/18/03, 04/24/07, 03/17/08, 12/30/08, 09/24/09, 04/19/10, 09/23/11	08/28/07, 03/30/09	\$365	\$7,951	\$500	\$8,816	√
54	700	764	06/05/95			04/21/06	10/23/06	04/19/07	10/24/13	07/31/02, 01/31/03, 08/18/03, 05/03/07, 03/17/08, 12/30/08, 09/24/09, 04/19/10, 09/23/11	03/30/09	\$365	\$9,028	\$500	\$9,893	√
55	700	766	06/05/95			09/07/04	03/07/05	07/22/05	10/24/13	07/31/02, 01/31/03, 08/18/03, 04/25/07, 03/17/08, 12/30/08, 09/24/09, 04/19/10, 09/23/11	08/28/07, 03/30/09	\$365	\$9,017	\$500	\$9,882	√
56	700	767	06/05/95			07/05/06	01/05/07	06/29/07	10/28/13	02/07/03, 07/31/03, 12/30/08, 09/25/09, 04/19/10, 09/23/11	03/30/09	\$365	\$10,104	\$500	\$10,969	√

Case Index	Family	Docket No.	Filing Date	Prior Appeal Brief Filed	Prior Appeal Concluded, reopen prosecution	Last Action Issued	Notice of Appeal Filed	Appeal Brief Filed	Reopen Prosecution (PTO's version)	PTO's Suspensions	Mr. Hyatt's Petitions	Application filing fees	Total Excess Claims Fees	Total Appeal Fees	Sum of PTO Fess Paid	"Bulk Filers" Group 2615
57	700	768	06/05/95			10/18/04	03/18/05	09/19/05	10/28/13	02/13/03, 07/31/03, 04/23/07, 03/17/08, 12/30/08, 09/25/09, 04/19/10, 09/23/11	08/28/07, 03/30/09	\$365	\$9,836	\$500	\$10,701	√
58	700	769	06/05/95			09/27/04	02/28/05	08/26/05	10/24/13	04/25/07, 03/17/08, 12/30/08, 09/24/09, 04/19/10, 09/23/11	08/28/07, 03/30/09	\$365	\$7,641	\$500	\$8,506	√
59	700	773	06/06/95			01/04/05	07/05/05	01/03/06	10/31/13	10/24/02, 04/23/03, 05/11/07, 03/17/08, 12/30/08, 09/24/09, 04/19/10, 09/23/11	08/28/07, 03/30/09	\$365	\$9,246	\$500	\$10,111	√
60	700	776	06/06/95			03/09/05	09/09/05	03/08/06	10/28/13	10/24/02, 04/23/03, 04/23/07, 03/17/08, 12/30/08, 09/24/09, 04/19/10, 09/23/11	08/28/07, 03/30/09	\$365	\$10,354	\$500	\$11,219	√
61	700	777	06/06/95			02/07/05	08/08/05	02/08/06	10/24/13	07/31/02, 01/31/03, 08/18/03, 04/23/07, 03/17/08, 12/30/08, 09/24/09, 04/19/10, 09/23/11	08/28/07, 03/30/09	\$365	\$9,837	\$500	\$10,702	√
62	700	780	06/06/95			01/10/06	07/10/06	01/09/07	10/28/13	07/31/02, 01/31/03, 08/18/03, 05/11/07, 03/17/08, 12/30/08, 09/24/09, 04/19/10, 09/23/11	03/30/09	\$365	\$8,662	\$500	\$9,527	√

Case Index	Family	Docket No.	Filing Date	Prior Appeal Brief Filed	Prior Appeal Concluded, reopen prosecution	Last Action Issued	Notice of Appeal Filed	Appeal Brief Filed	Reopen Prosecution (PTO's version)	PTO's Suspensions	Mr. Hyatt's Petitions	Application filing fees	Total Excess Claims Fees	Total Appeal Fees	Sum of PTO Fess Paid	"Bulk Filers" Group 2615
63	700	781	06/06/95			10/17/05	04/17/06	10/16/06	10/28/13	07/31/02, 01/31/03, 08/18/03, 04/24/07, 03/17/08, 12/30/08, 09/24/09, 04/19/10, 09/23/11	08/28/07, 03/30/09	\$365	\$9,136	\$500	\$10,001	√
64	700	782	06/06/95			02/02/05	08/02/05	02/01/06	10/24/13	07/31/02, 01/31/03, 08/18/03, 05/11/07, 03/17/08, 12/30/08, 09/24/09, 04/19/10, 09/23/11	08/28/07, 03/30/09	\$365	\$10,893	\$500	\$11,758	√
65	700	783	06/06/95			01/11/06	07/10/06	01/09/07	10/24/13	08/01/02, 01/31/03, 08/18/03, 05/11/07, 03/17/08, 12/30/08, 09/24/09, 04/19/10, 09/23/11	08/28/07, 03/30/09	\$365	\$9,045	\$500	\$9,910	√
66	700	784	06/06/95			04/21/06	10/23/06	03/23/07	10/28/13	02/13/03, 07/31/03, 05/03/07, 03/17/08, 12/30/08, 09/24/09, 04/19/10, 09/23/11	03/30/09	\$365	\$9,552	\$405	\$10,322	√
67	700	786	06/06/95			09/07/05	03/06/06	09/05/06	10/24/13	04/25/07, 03/17/08, 12/30/08, 09/24/09, 04/19/10, 09/23/11	08/28/07, 03/30/09	\$365	\$9,426	\$500	\$10,291	√
68	700	787	06/06/95	02/28/01	11/08/01	09/08/05	03/06/06	09/05/06	10/24/13	07/31/02, 01/31/03, 08/18/03, 04/25/07, 03/17/08, 12/30/08, 09/24/09, 04/19/10, 09/23/11	08/28/07, 03/30/09	\$365	\$9,201	\$805	\$10,371	√

Case Index	Family	Docket No.	Filing Date	Prior Appeal Brief Filed	Prior Appeal Concluded, reopen prosecution	Last Action Issued	Notice of Appeal Filed	Appeal Brief Filed	Reopen Prosecution (PTO's version)	PTO's Suspensions	Mr. Hyatt's Petitions	Application filing fees	Total Excess Claims Fees	Total Appeal Fees	Sum of PTO Fess Paid	"Bulk Filers" Group 2615
69	700	789	06/06/95			09/06/05	03/06/06	09/11/06	10/28/13	07/31/02, 01/31/03, 08/18/03, 05/11/07, 09/25/09, 04/19/10, 09/19/07, 09/23/11	08/28/07, 03/30/09	\$365	\$9,167	\$500	\$10,032	√
70	700	790	06/06/95			02/02/05	08/02/05	02/01/06	10/25/13	10/24/02, 04/23/03, 04/23/07, 03/17/08, 12/30/08, 09/24/09, 04/19/10, 09/23/11	08/28/07, 03/30/09	\$365	\$8,803	\$500	\$9,668	√
71	700	791	06/06/95			10/18/04	03/18/05	09/19/05	10/28/13	02/13/03, 07/31/03, 04/23/07, 03/17/08, 12/30/08, 09/24/09, 04/19/10, 09/23/11	08/28/07, 03/30/09	\$365	\$9,361	\$500	\$10,226	√
72	700	792	06/06/95			01/04/05	07/05/05	01/03/06	10/28/13	07/31/02, 01/31/03, 08/18/03, 04/23/07, 03/17/08, 12/30/08, 09/24/09, 04/19/10, 09/23/11	08/28/07, 03/30/09	\$365	\$10,066	\$500	\$10,931	√
73	700	793	06/06/95			08/26/05	02/27/06	08/28/06	10/28/13	07/31/02, 01/31/03, 08/18/03, 04/24/07, 03/17/08, 12/30/08, 09/24/09, 04/19/10, 09/23/11	08/28/07, 03/30/09	\$365	\$10,046	\$500	\$10,911	√
74	700	794	06/06/95			02/02/05	08/02/05	02/01/06	10/24/13	10/24/02, 04/23/03, 05/11/07, 03/17/08, 12/30/08, 09/24/09, 04/19/10, 09/23/11	08/28/07, 03/30/09	\$365	\$9,984	\$500	\$10,849	√

Case Index	Family	Docket No.	Filing Date	Prior Appeal Brief Filed	Prior Appeal Concluded, reopen prosecution	Last Action Issued	Notice of Appeal Filed	Appeal Brief Filed	Reopen Prosecution (PTO's version)	PTO's Suspensions	Mr. Hyatt's Petitions	Application filing fees	Total Excess Claims Fees	Total Appeal Fees	Sum of PTO Fess Paid	"Bulk Filers" Group 2615
75	700	795	06/06/95			04/29/05	10/30/05	04/24/06	10/24/13	10/24/03, 04/23/07, 03/17/08, 12/30/08, 09/24/09, 04/19/10, 09/23/11	08/28/07, 03/30/09	\$365	\$9,360	\$500	\$10,225	√
76	700	796	06/06/95			10/18/04	03/18/05	09/19/05	10/28/13	07/31/02, 01/31/03, 08/18/03, 04/23/07, 03/17/08, 12/30/08, 09/24/09, 04/19/10, 09/23/11	08/28/07, 03/30/09	\$365	\$8,793	\$500	\$9,658	√
77	700	797	06/06/95			12/29/05	06/29/06	12/22/06	10/28/13	07/31/02, 01/31/03, 08/18/03, 05/03/07, 03/17/08, 12/30/08, 09/24/09, 04/19/10, 09/23/11	08/28/07, 03/30/09	\$365	\$9,758	\$500	\$10,623	√
78	700	798	06/06/95			07/15/05	01/16/06	06/26/06	10/24/13	07/31/02, 01/31/03, 08/18/03, 04/24/07, 03/17/08, 12/30/08, 09/24/09, 04/19/10, 09/23/11	08/28/07, 03/30/09	\$365	\$8,797	\$500	\$9,662	√
79	850	856	06/06/95			05/24/99	11/24/99	05/23/00	10/15/13	04/25/07, 03/17/08, 12/30/08, 09/24/09, 04/19/10, 09/23/11	01/19/01, 01/20/05, 03/28/07, 08/28/07, 03/30/09	\$730	\$7,389	\$450	\$8,569	√
80		865	06/06/95			05/24/99	11/24/99	05/23/00	10/11/13	04/25/07, 03/17/08, 12/30/08, 09/24/09, 04/19/10, 09/23/11	01/19/01, 01/20/05, 03/28/07, 08/28/07, 03/30/09	\$730	\$5,791	\$450	\$6,971	√
Totals:									\$38,145	\$884,188	\$52,725	\$975,058				

Exhibit 11. Timeline of key events in 80 appealed applications

Timeline of activities at the PTO in the 80 Hyatt patent applications by case index

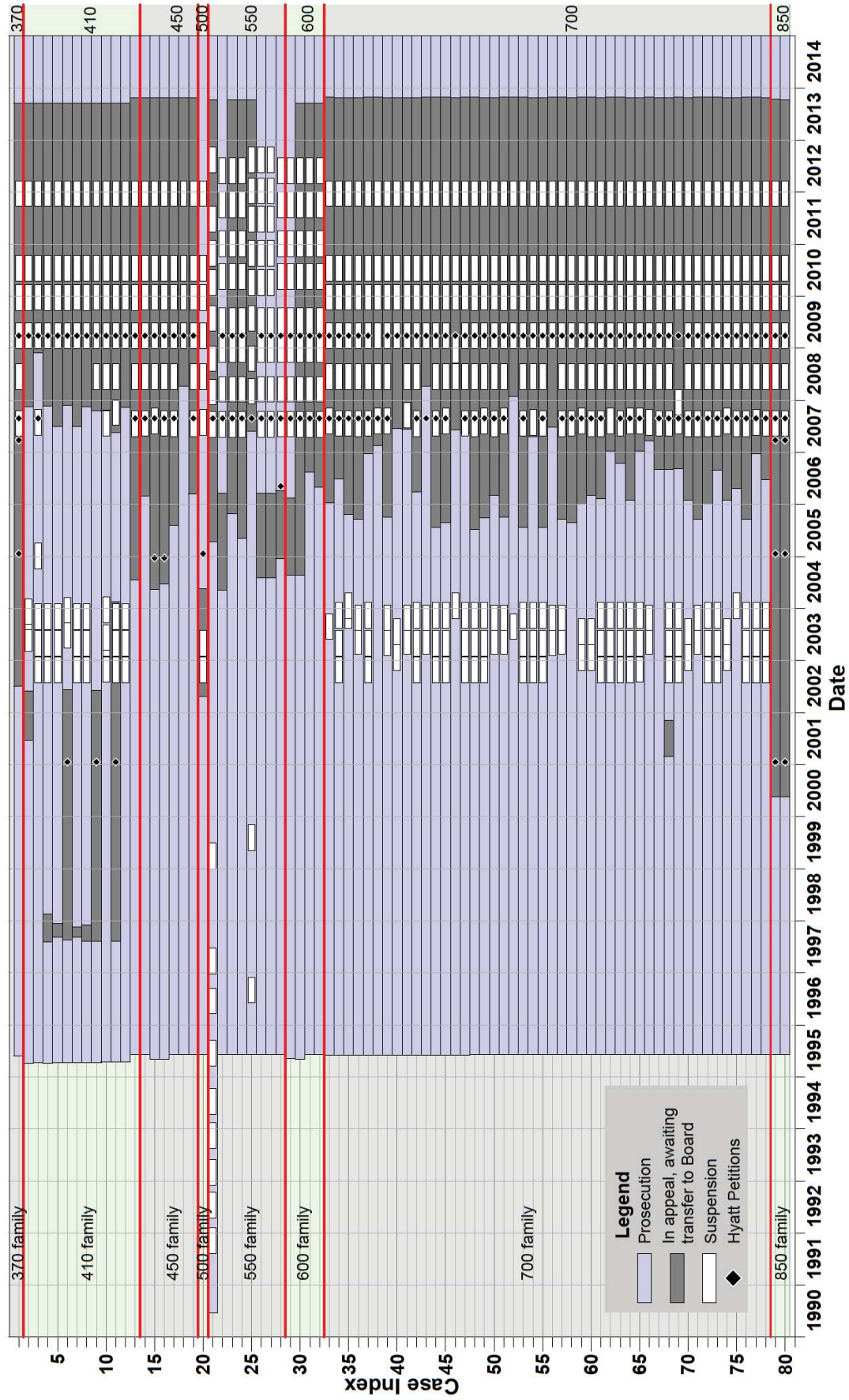


Exhibit 12. Petition for action on the merit

2676
3PW



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)
GILBERT P. HYATT)
Serial No. 08/471,070)
Docket No. 547)
Filed: June 6, 1995)
For: AN IMPROVED ARCHITECTURE FOR)
WRITING DATA INTO A RANDOM)
ACCESS MEMORY)

PETITION FOR AN ACTION ON THE MERITS
UNDER 37 CFR 1.181(A)(3)

Hon. Assistant Commissioner
For Patents
Washington, D.C. 20231
Sir:

The Applicant respectfully petitions the Commissioner for his intervention to direct the Examiner to expeditiously provide the Applicant with an Action on the merits.

The PTO requires an expeditious response to amendments (MPEP 708, last paragraph):

All amendments before final rejection should be responded to within two months of receipt.

Further, the PTO requires that the instant application be advanced out of turn for examination for the following reasons (MPEP 708.01, item I):

Applications pending more than 5 years, including those which, by relation to a prior United States application, have an effective pendency of more than 5 years.

The instant application meets both of these criterion, it has been pending more that 5 years and it has an effective pendency of more than 5 years.

No action has been received in the instant application in more than a year.

The Applicant filed a Request For Status in the instant application dated November 9, 2004 but the Examiner has not responded thereto.

In view of the above, the Commissioner is hereby petitioned to direct the Examiner to immediately prepare an action in the instant application or, alternatively, to pass the instant application to issue.

Because this petition seeks to invoke the Supervisory Authority of the Commissioner under 37 CFR 1.181(a)(3), a petition fee is not required and thus a fee authorization is not needed.

Respectfully submitted,

Dated: January 20, 2005



Gilbert P. Hyatt
Registration No. 27,647
P.O. Box 81230
Las Vegas, NV 89180
Phone (702) 871-9899

Exhibit 13. PTO decision on petition for action



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

MAIL

FEB 24 2005

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

GILBERT P HYATT
PO BOX 81230
LAS VEGAS NV 89180

In re Application of: :
Hyatt :
Application Serial No.: 08/471,070 :
Filed: June 6, 1995 :
For: **MEMORY ARCHITECTURE HAVING A** :
MULTIPLE BUFFER OUTPUT ARRANGEMENT :

DECISION
ON PETITION

This is a decision on the petition, filed on January 21, 2005 under 37 C.F.R. §1.181 requesting an expedited action on the merits. This petition has been considered a request to affirm that this application is under "special" status in accordance with 37 CFR 1.102.

Petitioner provides support for the request for expedited action with reference to MPEP sections 708 and 708.01. The latter section specifically states that applications pending over 5 years should be considered special. Since this application by virtue of its prolonged pendency is already special in accordance with PTO policy, Petitioner's request is moot.

The examiner will be notified that this application should be considered as "special" and appropriate for expedited action.

The petition is **DISMISSED**.

Kenneth A. Wieder
Special Program Examiner
Technology Center 2600
Communications

Exhibit 14. Chronology of petitions and PTO's responses thereto

Docket No.	Application Ser. No.	Date of Hyatt petition for action	Date of PTO decision on petition (a)	PTO decision representation	Petition decision signed by	Dates of subsequent Hyatt petitions for action prior to PTO's subsequent suspension	Subsequent PTO Suspension Date (b)	Period of PTO inaction after promising prompt action and prior to suspension [(b)-(a), years]	Examiner of record as of petition for action	Examiner of record upon suspension
428	08/423,234	1/22/01	5/22/01	<p>"[I]n view of the lengthy prosecution in the instant application, the file is being forwarded to the examiner for immediate action as appropriate. Any delay caused petitioner in the treatment of the petition and the Appeal Brief is regretted."</p> <p>"the application has now been converted into image format" and "the file has been forwarded to the examiner for appropriate action in due course."</p>	Joseph J. Rolla Jr.		7/31/02	1.19 yrs	Anh, Hong Do	Couso, Jose L
465	08/434,449	12/21/04	6/7/05		Boudreau, Leo	3/28/07	5/11/07	1.93 yrs	Nguyen, Phu K	Lillis, Eileen Dunn
467	08/435,938	12/21/04	6/7/05	<p>Because the "application by virtue of its prolonged pendency is already special in accordance with PTO policy, Petitioner's request is moot. ... The examiner will be notified that this application should be considered as 'special' and appropriate for expedited action."</p>	Boudreau, Leo		4/24/07	1.88 yrs	Nguyen, Phu K	Lillis, Eileen Dunn
860	08/472,031	1/21/05	3/4/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.19 yrs	Wong, Allen C	Wong, Allen C
488	08/460,092	1/21/05	2/24/05		Wieder, Kenneth A.	3/28/07	4/25/07	2.16 yrs	Storm, Donald L	Storm, Donald L
483	08/459,877	1/21/05	2/25/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.21 yrs	Smits, Talivaldis Ivars	Smits, Talivaldis Ivars
810	08/501,981	1/21/05	3/2/05		Wieder, Kenneth A.	3/28/07	5/2/07	2.17 yrs	Awad, Amr A	Razavi, Michael
324	07/357,570	1/21/05	2/25/05		Wieder, Kenneth A.	3/28/07; 8/28/07	12/30/08	3.85 yrs	Brier, Jeffery A	Razavi, Michael
344	07/774,159	1/21/05	3/4/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.19 yrs	Brier, Jeffery A	Razavi, Michael
404	08/464,520	1/21/05	2/25/05		Wieder, Kenneth A.	3/28/07; 8/28/07	3/17/08	3.06 yrs	Brier, Jeffery A	Razavi, Michael
476	08/463,791	1/21/05	2/17/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.23 yrs	Brier, Jeffery A	Razavi, Michael
513	08/479,086	1/21/05	2/25/05		Wieder, Kenneth A.	3/28/07	5/2/07	2.18 yrs	Brier, Jeffery A	Razavi, Michael
546	08/483,016	1/21/05	3/9/05		Wieder, Kenneth A.	3/28/07	5/2/07	2.15 yrs	Brier, Jeffery A	Razavi, Michael
801	08/456,270	1/21/05	3/3/05		Wieder, Kenneth A.	3/28/07	5/2/07	2.16 yrs	Brier, Jeffery A	Razavi, Michael
804	08/454,889	1/21/05	3/3/05		Wieder, Kenneth A.	3/28/07	5/2/07	2.16 yrs	Brier, Jeffery A	Razavi, Michael
805	08/455,752	1/21/05	3/3/05		Wieder, Kenneth A.	3/28/07	5/15/07	2.20 yrs	Brier, Jeffery A	Razavi, Michael

Docket No.	Application Ser. No.	Date of Hyatt petition for action	Date of PTO decision on petition (a)	PTO decision representation	Petition decision signed by	Dates of subsequent Hyatt petitions for action prior to PTO's subsequent suspension	Subsequent PTO Suspension Date (b)	Period of PTO inaction after promising prompt action and prior to suspension [(b)-(a), years]	Examiner of record as of petition for action	Examiner of record upon suspension
811	08/501,980	1/21/05	3/3/05	Because the "application by virtue of its prolonged pendency is already special in accordance with PTO policy, Petitioner's request is moot. ... The examiner will be notified that this application should be considered as 'special' and appropriate for expedited action."	Wieder, Kenneth A.	3/28/07; 8/28/07; 3/30/09	7/7/10	5.35 yrs	Brier, Jeffery A	Razavi, Michael
812	08/501,979	1/21/05	3/4/05		Wieder, Kenneth A.	3/28/07	5/3/07	2.16 yrs	Brier, Jeffery A	Razavi, Michael
813	08/457,941	1/21/05	3/2/05		Wieder, Kenneth A.	3/28/07	5/2/07	2.17 yrs	Brier, Jeffery A	Razavi, Michael
814	08/501,978	1/21/05	3/2/05		Wieder, Kenneth A.	3/28/07; 8/28/07	3/17/08	3.04 yrs	Brier, Jeffery A	Razavi, Michael
817	08/456,126	1/21/05	2/24/05		Wieder, Kenneth A.	3/28/07; 8/28/07	12/31/08	3.85 yrs	Brier, Jeffery A	Razavi, Michael
821	08/455,769	1/21/05	2/17/05		Wieder, Kenneth A.	3/28/07	5/2/07	2.20 yrs	Brier, Jeffery A	Razavi, Michael
825	08/457,659	1/21/05	3/4/05		Wieder, Kenneth A.	3/28/07	4/24/07	2.14 yrs	Brier, Jeffery A	Razavi, Michael
360	08/429,272	1/21/05	3/9/05		Wieder, Kenneth A.	3/28/07; 8/28/07	3/17/08	3.02 yrs	Chow, Dennis Doon	Razavi, Michael
379	08/456,130	1/21/05	2/25/05		Wieder, Kenneth A.	3/28/07	4/25/07	2.16 yrs	Chow, Dennis Doon	Razavi, Michael
442	08/464,995	1/21/05	2/17/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.23 yrs	Chow, Dennis Doon	Razavi, Michael
800	08/454,902	1/21/05	2/25/05		Wieder, Kenneth A.	3/28/07	5/2/07	2.18 yrs	Chow, Dennis Doon	Razavi, Michael
802	08/454,901	1/21/05	5/18/05		Wieder, Kenneth A.	3/28/07	5/2/07	1.96 yrs	Chow, Dennis Doon	Razavi, Michael
809	08/455,117	1/21/05	3/2/05		Wieder, Kenneth A.	3/28/07	5/2/07	2.17 yrs	Chow, Dennis Doon	Razavi, Michael
815	08/454,877	1/21/05	3/4/05		Wieder, Kenneth A.	3/28/07; 8/28/07	3/17/08	3.04 yrs	Chow, Dennis Doon	Razavi, Michael
816	08/454,879	1/21/05	3/2/05		Wieder, Kenneth A.	3/29/07	4/24/07	2.15 yrs	Chow, Dennis Doon	Razavi, Michael
824	08/454,884	1/21/05	3/4/05		Wieder, Kenneth A.	3/28/07	5/3/07	2.16 yrs	Chow, Dennis Doon	Razavi, Michael
828	08/455,202	1/21/05	2/25/05		Wieder, Kenneth A.	3/28/07	5/2/07	2.18 yrs	Chow, Dennis Doon	Razavi, Michael
378	08/454,887	1/21/05	3/9/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.17 yrs	Diep, Nhon Thanh	Razavi, Michael

Docket No.	Application Ser. No.	Date of Hyatt petition for action	Date of PTO decision on petition (a)	PTO decision representation	Petition decision signed by	Dates of subsequent Hyatt petitions for action prior to PTO's subsequent suspension	Subsequent PTO Suspension Date (b)	Period of PTO inaction after promising prompt action and prior to suspension [(b)-(a), years]	Examiner of record as of petition for action	Examiner of record upon suspension
365	08/436,552	1/21/05	3/7/05	Because the "application by virtue of its prolonged pendency is already special in accordance with PTO policy, Petitioner's request is moot. ... The examiner will be notified that this application should be considered as 'special' and appropriate for expedited action."	Wieder, Kenneth A.	3/28/07	5/11/07	2.18 yrs	Dinh, P	Razavi, Michael
361	08/428,737	1/21/05	3/9/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.17 yrs	Dinh, Son T	Razavi, Michael
470	08/437,527	1/21/05	2/17/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.23 yrs	Dorvil, Richmond	Razavi, Michael
363	08/433,307	1/21/05	3/7/05		Wieder, Kenneth A.	3/28/07; 8/28/07	3/17/08	3.03 yrs	Fears, Terrell W	Razavi, Michael
381	08/455,309	1/21/05	2/24/05		Wieder, Kenneth A.	3/28/07; 8/28/07	12/30/08	3.85 yrs	Flynn, Nathan J	Razavi, Michael
384	08/454,875	1/21/05	3/4/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.19 yrs	Flynn, Nathan J	Razavi, Michael
356	08/599,450	1/21/05	3/9/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.17 yrs	Jankus, Almis R	Razavi, Michael
450	08/417,530	1/21/05	2/17/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.23 yrs	Jankus, Almis R	Razavi, Michael
452	08/419,590	1/21/05	2/25/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.21 yrs	Jankus, Almis R	Razavi, Michael
460	08/432,384	1/21/05	2/17/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.23 yrs	Jankus, Almis R	Razavi, Michael
464	08/435,513	1/21/05	2/17/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.23 yrs	Jankus, Almis R	Razavi, Michael
474	08/460,800	1/21/05	2/17/05		Wieder, Kenneth A.	3/28/07	4/25/07	2.18 yrs	Jankus, Almis R	Razavi, Michael
475	08/460,768	1/21/05	2/17/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.23 yrs	Jankus, Almis R	Razavi, Michael
385	08/445,458	1/21/05	3/9/05		Wieder, Kenneth A.	3/28/07	4/24/07	2.13 yrs	Kianni, Kaveh C	Razavi, Michael
850	08/479,097	1/21/05	3/4/05		Wieder, Kenneth A.	3/28/07	4/25/07	2.14 yrs	Knepper, David D	Razavi, Michael
858	08/470,666	1/21/05	3/4/05		Wieder, Kenneth A.	3/28/07; 8/28/07	12/31/08	3.83 yrs	Knepper, David D	Razavi, Michael
863	08/471,932	1/21/05	2/25/05		Wieder, Kenneth A.	3/28/07	4/25/07	2.16 yrs	Knepper, David D	Razavi, Michael
489	08/461,572	1/21/05	2/17/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.23 yrs	Laneau, Ronald	Razavi, Michael
864	08/470,665	1/21/05	3/4/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.19 yrs	Laneau, Ronald	Razavi, Michael

Docket No.	Application Ser. No.	Date of Hyatt petition for action	Date of PTO decision on petition (a)	PTO decision representation	Petition decision signed by	Dates of subsequent Hyatt petitions for action prior to PTO's subsequent suspension	Subsequent PTO Suspension Date (b)	Period of PTO inaction after promising prompt action and prior to suspension [(b)-(a), years]	Examiner of record as of petition for action	Examiner of record upon suspension
493	08/464,980	1/21/05	2/24/05	Because the "application by virtue of its prolonged pendency is already special in accordance with PTO policy, Petitioner's request is moot. ... The examiner will be notified that this application should be considered as 'special' and appropriate for expedited action."	Wieder, Kenneth A.	3/28/07; 8/28/07	12/30/08	3.85 yrs	Lao, Lun Yi	Razavi, Michael
455	08/429,391	1/21/05	2/17/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.23 yrs	Lao, Lun Yi	Razavi, Michael
469	08/436,853	1/21/05	2/17/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.23 yrs	Lao, Lun Yi	Razavi, Michael
471	08/438,598	1/21/05	2/17/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.23 yrs	Lao, Lun Yi	Razavi, Michael
803	08/454,896	1/21/05	3/2/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.19 yrs	Lao, Lun Yi	Razavi, Michael
808	08/455,750	1/21/05	2/28/05		Wieder, Kenneth A.	3/28/07; 8/28/07	12/31/08	3.84 yrs	Lao, Lun Yi	Razavi, Michael
819	08/455,435	1/21/05	2/17/05		Wieder, Kenneth A.	3/28/07	5/3/07	2.21 yrs	Lao, Lun Yi	Razavi, Michael
823	08/454,780	1/21/05	3/4/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.19 yrs	Lao, Lun Yi	Razavi, Michael
826	08/455,648	1/21/05	3/4/05		Wieder, Kenneth A.	3/28/07	5/2/07	2.16 yrs	Lao, Lun Yi	Razavi, Michael
383	08/454,878	1/21/05	3/4/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.19 yrs	Le, Vu	Razavi, Michael
372	08/455,297	1/21/05	3/7/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.18 yrs	Lee, Y Young	Razavi, Michael
380	08/455,320	1/21/05	2/25/05		Wieder, Kenneth A.	3/28/07; 8/10/07	3/17/08	3.06 yrs	Lee, Y Young	Razavi, Michael
405	08/464,032	1/21/05	2/24/05		Wieder, Kenneth A.	3/28/07; 8/10/07	3/17/08	3.06 yrs	Legree, Tracy Michelle	Razavi, Michael
613	08/465,482	1/21/05	3/4/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.19 yrs	Liang, Regina	Razavi, Michael
655	08/457,609	1/21/05	3/9/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.17 yrs	Liang, Regina	Razavi, Michael
666	08/458,102	1/21/05	2/25/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.21 yrs	Liang, Regina	Razavi, Michael
675	08/457,717	1/21/05	3/4/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.19 yrs	Liang, Regina	Razavi, Michael
485	08/459,508	1/21/05	2/25/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.21 yrs	Liang, Regina	Razavi, Michael
497	08/466,994	1/21/05	3/9/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.17 yrs	Liang, Regina	Razavi, Michael

Docket No.	Application Ser. No.	Date of Hyatt petition for action	Date of PTO decision on petition (a)	PTO decision representation	Petition decision signed by	Dates of subsequent Hyatt petitions for action prior to PTO's subsequent suspension	Subsequent PTO Suspension Date (b)	Period of PTO inaction after promising prompt action and prior to suspension [(b)-(a), years]	Examiner of record as of petition for action	Examiner of record upon suspension
654	08/640,727	1/21/05	2/24/05	Because the "application by virtue of its prolonged pendency is already special in accordance with PTO policy, Petitioner's request is moot. ... The examiner will be notified that this application should be considered as 'special' and appropriate for expedited action."	Wieder, Kenneth A.	3/28/07; 8/28/07	12/31/08	3.85 yrs	Liang, Regina	Razavi, Michael
654	08/640,727	1/21/05	3/4/05		Wieder, Kenneth A.	3/28/07; 8/28/07	12/31/08	3.83 yrs	Liang, Regina	Razavi, Michael
656	08/456,399	1/21/05	3/4/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.19 yrs	Liang, Regina	Razavi, Michael
658	08/457,963	1/21/05	2/24/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.21 yrs	Liang, Regina	Razavi, Michael
660	08/456,332	1/21/05	2/25/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.21 yrs	Liang, Regina	Razavi, Michael
661	08/456,327	1/21/05	3/7/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.18 yrs	Liang, Regina	Razavi, Michael
662	08/456,338	1/21/05	2/25/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.21 yrs	Liang, Regina	Razavi, Michael
668	08/459,090	1/21/05	3/4/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.19 yrs	Liang, Regina	Razavi, Michael
669	08/457,195	1/21/05	2/25/05		Wieder, Kenneth A.	3/28/07; 8/28/07	3/17/08	3.06 yrs	Liang, Regina	Razavi, Michael
472	08/460,550	1/21/05	2/24/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.21 yrs	Mengistu, Amare	Razavi, Michael
657	08/457,361	1/21/05	2/24/05		Wieder, Kenneth A.	3/28/07; 8/28/07	3/17/08	3.06 yrs	Mengistu, Amare	Razavi, Michael
806	08/455,164	1/21/05	3/4/05		Wieder, Kenneth A.		5/2/07	2.16 yrs	Mengistu, Amare	Razavi, Michael
807	08/455,779	1/21/05	3/4/05		Wieder, Kenneth A.	3/28/07	5/2/07	2.16 yrs	Mengistu, Amare	Razavi, Michael
818	08/455,738	1/21/05	2/24/05		Wieder, Kenneth A.	3/28/07	5/2/07	2.18 yrs	Mengistu, Amare	Razavi, Michael
822	08/455,505	1/21/05	3/4/05		Wieder, Kenneth A.	3/28/07	5/3/07	2.16 yrs	Mengistu, Amare	Razavi, Michael
407	08/465,923	1/21/05	2/25/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.21 yrs	Nguyen, Chanh Duy	Razavi, Michael
670	08/457,344	1/21/05	2/25/05		Wieder, Kenneth A.	3/28/07; 8/28/07	12/31/08	3.85 yrs	Nguyen, Chanh Duy	Razavi, Michael
671	08/457,355	1/21/05	2/25/05		Wieder, Kenneth A.	3/28/07; 8/28/07	12/31/08	3.85 yrs	Nguyen, Chanh Duy	Razavi, Michael
403	08/465,152	1/21/05	3/7/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.18 yrs	Nguyen, Chanh Duy	Razavi, Michael

Docket No.	Application Ser. No.	Date of Hyatt petition for action	Date of PTO decision on petition (a)	PTO decision representation	Petition decision signed by	Dates of subsequent Hyatt petitions for action prior to PTO's subsequent suspension	Subsequent PTO Suspension Date (b)	Period of PTO inaction after promising prompt action and prior to suspension [(b)-(a), years]	Examiner of record as of petition for action	Examiner of record upon suspension
650	08/439,032	1/21/05	3/4/05	Because the "application by virtue of its prolonged pendency is already special in accordance with PTO policy, Petitioner's request is moot. ... The examiner will be notified that this application should be considered as 'special' and appropriate for expedited action."	Wieder, Kenneth A.	3/28/07	5/11/07	2.19 yrs	Nguyen, Chanh Duy	Razavi, Michael
659	08/458,144	1/21/05	2/25/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.21 yrs	Nguyen, Chanh Duy	Razavi, Michael
663	08/456,397	1/21/05	3/4/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.19 yrs	Nguyen, Chanh Duy	Razavi, Michael
667	08/457,446	1/21/05	2/25/05		Wieder, Kenneth A.	3/28/07; 8/28/07	12/31/08	3.85 yrs	Nguyen, Chanh Duy	Razavi, Michael
672	08/471,810	1/21/05	2/25/05		Wieder, Kenneth A.	3/28/07; 8/28/07	12/31/08	3.85 yrs	Nguyen, Chanh Duy	Razavi, Michael
676	08/457,210	1/21/05	3/2/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.19 yrs	Nguyen, Chanh Duy	Razavi, Michael
479	08/459,244	1/21/05	2/24/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.21 yrs	Nguyen, Phu K	Razavi, Michael
369	08/472,025	1/21/05	3/9/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.17 yrs	Nguyen, V	Razavi, Michael
364	08/435,502	1/21/05	3/7/05		Wieder, Kenneth A.	3/28/07; 8/28/07	5/9/07	2.17 yrs	Rao, Anand Shashikant	Razavi, Michael
371	08/455,924	1/21/05	3/4/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.19 yrs	Rao, Anand Shashikant	Razavi, Michael
386	08/454,810	1/21/05	3/4/05		Wieder, Kenneth A.	3/28/07; 8/10/07	3/17/08	3.04 yrs	Rao, Anand Shashikant	Razavi, Michael
389	08/455,310	1/21/05	3/4/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.19 yrs	Rao, Anand Shashikant	Razavi, Michael
454	08/420,942	1/21/05	2/17/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.23 yrs	Shankar, Vuay	Razavi, Michael
463	08/431,638	1/21/05	2/17/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.23 yrs	Shankar, Vuay	Razavi, Michael
466	08/438,012	1/21/05	2/17/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.23 yrs	Shankar, Vuay	Razavi, Michael
496	08/464,996	1/21/05	2/17/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.23 yrs	Shankar, Vuay	Razavi, Michael
857	08/457,086	1/21/05	2/25/05		Wieder, Kenneth A.	3/28/07	4/24/07	2.16 yrs	Tran, Thung V	Razavi, Michael
500	08/435,894	1/21/05	3/4/05		Wieder, Kenneth A.	3/28/07; 8/28/07	3/17/08	3.04 yrs	Tung, Kee M	Razavi, Michael
501	08/432,478	1/21/05	3/9/05		Wieder, Kenneth A.	3/28/07; 8/28/07	3/17/08	3.02 yrs	Tung, Kee M	Razavi, Michael

Docket No.	Application Ser. No.	Date of Hyatt petition for action	Date of PTO decision on petition (a)	PTO decision representation	Petition decision signed by	Dates of subsequent Hyatt petitions for action prior to PTO's subsequent suspension	Subsequent PTO Suspension Date (b)	Period of PTO inaction after promising prompt action and prior to suspension [(b)-(a), years]	Examiner of record as of petition for action	Examiner of record upon suspension
502	08/435,901	1/21/05	3/4/05	Because the "application by virtue of its prolonged pendency is already special in accordance with PTO policy, Petitioner's request is moot. ... The examiner will be notified that this application should be considered as 'special' and appropriate for expedited action."	Wieder, Kenneth A.	3/28/07; 8/28/07	3/17/08	3.04 yrs	Tung, Kee M	Razavi, Michael
503	08/435,033	1/21/05	2/24/05		Wieder, Kenneth A.	3/28/07; 8/28/07	3/17/08	3.06 yrs	Tung, Kee M	Razavi, Michael
504	08/470,079	1/21/05	3/4/05		Wieder, Kenneth A.	3/28/07	5/2/07	2.16 yrs	Tung, Kee M	Razavi, Michael
507	08/471,707	1/21/05	3/7/05		Wieder, Kenneth A.	3/28/07	5/2/07	2.15 yrs	Tung, Kee M	Razavi, Michael
508	08/471,138	1/21/05	3/7/05		Wieder, Kenneth A.	3/28/07	5/2/07	2.15 yrs	Tung, Kee M	Razavi, Michael
520	08/470,082	1/21/05	3/9/05		Wieder, Kenneth A.	3/28/07	5/2/07	2.15 yrs	Tung, Kee M	Razavi, Michael
530	08/471,708	1/21/05	3/9/05		Wieder, Kenneth A.	3/28/07	5/2/07	2.15 yrs	Tung, Kee M	Razavi, Michael
538	08/466,953	1/21/05	3/9/05		Wieder, Kenneth A.	3/28/07	5/2/07	2.15 yrs	Tung, Kee M	Razavi, Michael
543	08/466,164	1/21/05	3/9/05		Wieder, Kenneth A.	3/28/07	5/2/07	2.15 yrs	Tung, Kee M	Razavi, Michael
547	08/471,070	1/21/05	2/24/05		Wieder, Kenneth A.	3/28/07	5/2/07	2.18 yrs	Tung, Kee M	Razavi, Michael
326	07/419,911	1/21/05	3/9/05		Wieder, Kenneth A.	3/28/07	4/24/07	2.13 yrs	Wil, X	Razavi, Michael
391	08/454,886	1/21/05	3/4/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.19 yrs	Wong, Allen C	Razavi, Michael
453	08/419,681	1/21/05	2/25/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.21 yrs	Wu, Xiao Min	Razavi, Michael
610	08/465,627	1/21/05	3/9/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.17 yrs	Wu, Xiao Min	Razavi, Michael
652	08/457,369	1/21/05	3/9/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.17 yrs	Wu, Xiao Min	Razavi, Michael
653	08/640,726	1/21/05	2/24/05		Wieder, Kenneth A.	3/28/07; 8/28/07	12/31/08	3.85 yrs	Wu, Xiao Min	Razavi, Michael
664	08/458,003	1/21/05	2/25/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.21 yrs	Wu, Xiao Min	Razavi, Michael
674	08/457,716	1/21/05	3/4/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.19 yrs	Wu, Xiao Min	Razavi, Michael
677	08/458,579	1/21/05	2/25/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.21 yrs	Wu, Xiao Min	Razavi, Michael

Docket No.	Application Ser. No.	Date of Hyatt petition for action	Date of PTO decision on petition (a)	PTO decision representation	Petition decision signed by	Dates of subsequent Hyatt petitions for action prior to PTO's subsequent suspension	Subsequent PTO Suspension Date (b)	Period of PTO inaction after promising prompt action and prior to suspension [(b)-(a), years]	Examiner of record as of petition for action	Examiner of record upon suspension
486	08/458,548	1/21/05	2/25/05	Because the "application by virtue of its prolonged pendency is already special in accordance with PTO policy, Petitioner's request is moot. ... The examiner will be notified that this application should be considered as 'special' and appropriate for expedited action."	Wieder, Kenneth A.	3/28/07	5/11/07	2.21 yrs	Wu, Xiao Min	Razavi, Michael
651	08/439,033	1/21/05	3/9/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.17 yrs	Wu, Xiao Min	Razavi, Michael
665	08/457,663	1/21/05	2/25/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.21 yrs	Wu, Xiao Min	Razavi, Michael
673	08/456,599	1/21/05	3/2/05		Wieder, Kenneth A.	3/28/07; 8/28/07	3/17/08	3.04 yrs	Wu, Xiao Min	Razavi, Michael
678	08/457,939	1/21/05	3/2/05		Wieder, Kenneth A.	3/28/07	4/24/07	2.15 yrs	Wu, Xiao Min	Razavi, Michael
505	08/470,888	1/21/05	3/9/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.17 yrs	Psitos, Aristotelis M	Psitos, Aristotelis M
535	08/470,899	1/21/05	2/24/05		Wieder, Kenneth A.	3/28/07	5/2/07	2.18 yrs	Psitos, Aristotelis M	Psitos, Aristotelis M
852	08/483,011	1/21/05	3/3/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.19 yrs	Opsasnick, Michael N	Opsasnick, Michael N
859	08/470,856	1/21/05	3/4/05		Wieder, Kenneth A.	3/28/07; 8/28/07	3/17/08	3.04 yrs	Opsasnick, Michael N	Opsasnick, Michael N
541	08/470,177	1/21/05	3/9/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.17 yrs	Neyzari, Ali	Neyzari, Ali
548	08/470,882	1/21/05	3/9/05		Wieder, Kenneth A.	3/28/07; 8/28/07	12/31/08	3.82 yrs	Neyzari, Ali	Neyzari, Ali
506	08/471,714	1/21/05	3/7/05		Wieder, Kenneth A.	3/28/07	5/2/07	2.15 yrs	Miller, Brian E	Miller, Brian E
534	08/471,845	1/21/05	2/24/05		Wieder, Kenneth A.	3/28/07	5/15/07	2.22 yrs	Miller, Brian E	Miller, Brian E
492	08/469,019	1/21/05	2/17/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.23 yrs	Maung, Nay Aung	Maung, Nay Aung
761	08/463,111	1/21/05	2/28/05		Wieder, Kenneth A.	3/28/07	4/24/07	2.15 yrs	Del Rosso, Gerard D	Lillis, Eileen Dunn
752	08/463,583	1/21/05	3/2/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.19 yrs	Mancuso, Joseph	Lillis, Eileen Dunn
754	08/465,198	1/21/05	2/28/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.20 yrs	Mancuso, Joseph	Lillis, Eileen Dunn
762	08/464,497	1/21/05	3/4/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.19 yrs	Mengistu, Amare	Lillis, Eileen Dunn
765	08/463,821	1/21/05	2/25/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.21 yrs	Nguyen, Chanh Duy	Lillis, Eileen Dunn
775	08/469,263	1/21/05	3/4/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.19 yrs	Nguyen, Chanh Duy	Lillis, Eileen Dunn

Docket No.	Application Ser. No.	Date of Hyatt petition for action	Date of PTO decision on petition (a)	PTO decision representation	Petition decision signed by	Dates of subsequent Hyatt petitions for action prior to PTO's subsequent suspension	Subsequent PTO Suspension Date (b)	Period of PTO inaction after promising prompt action and prior to suspension [(b)-(a), years]	Examiner of record as of petition for action	Examiner of record upon suspension
799	08/471,252	1/21/05	3/4/05	Because the "application by virtue of its prolonged pendency is already special in accordance with PTO policy, Petitioner's request is moot. ... The examiner will be notified that this application should be considered as 'special' and appropriate for expedited action."	Wieder, Kenneth A.	3/28/07	4/24/07	2.14 yrs	Wu, Xiao Min	Lillis, Eileen Dunn
487	08/458,197	1/21/05	2/24/05		Wieder, Kenneth A.	3/28/07; 8/28/07	3/17/08	3.06 yrs	Lerner, Martin	Lerner, Martin
480	08/459,220	1/21/05	2/24/05		Wieder, Kenneth A.	3/28/07	5/9/07	2.20 yrs	Lerner, Martin	Lerner, Martin
390	08/456,129	1/21/05	3/7/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.18 yrs	Lee, Y Young	Lee, Y Young
514	08/471,704	1/21/05	3/7/05		Wieder, Kenneth A.	3/28/07	5/2/07	2.15 yrs	Letscher, George J	Korzuch, William R
853	08/470,859	1/21/05	2/25/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.21 yrs	Knepper, David D	Knepper, David D
856	08/472,041	1/21/05	3/3/05		Wieder, Kenneth A.	3/28/07	4/25/07	2.15 yrs	Knepper, David D	Knepper, David D
862	08/469,528	1/21/05	3/3/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.19 yrs	Knepper, David D	Knepper, David D
867	08/471,062	1/21/05	2/25/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.21 yrs	Knepper, David D	Knepper, David D
855	08/486,151	1/21/05	3/4/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.19 yrs	Opsasnick, Michael N	Knepper, David D
861	08/470,898	1/21/05	3/3/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.19 yrs	Opsasnick, Michael N	Knepper, David D
865	08/472,032	1/21/05	2/24/05		Wieder, Kenneth A.	3/28/07	4/25/07	2.16 yrs	Opsasnick, Michael N	Knepper, David D
868	08/471,434	1/21/05	2/24/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.21 yrs	Opsasnick, Michael N	Knepper, David D
367	08/471,214	1/21/05	3/9/05		Wieder, Kenneth A.	3/28/07; 8/28/07	3/17/08	3.02 yrs	Fears, Terrell W	Kelley, Christopher S
315	07/128,659	1/21/05	3/4/05		Wieder, Kenneth A.	3/28/07; 8/28/07	12/29/08	3.82 yrs	Flynn, Nathan J	Kelley, Christopher S
866	08/471,795	1/21/05	2/25/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.21 yrs	Le, Vu	Kelley, Christopher S
382	08/456,138	1/21/05	3/4/05		Wieder, Kenneth A.	3/28/07; 8/28/07	3/17/08	3.04 yrs	Miller, J	Kelley, Christopher S
482	08/458,582	1/21/05	2/24/05		Wieder, Kenneth A.	3/28/07	5/11/07	2.21 yrs	Nguyen, Chanh Duy	Kazavi, Michael
519	08/470,084	1/21/05	3/9/05		Wieder, Kenneth A.	3/28/07; 8/28/07	12/31/08	3.82 yrs	Huber, Paul W	Huber, Paul W

Docket No.	Application Ser. No.	Date of Hyatt petition for action	Date of PTO decision on petition (a)	PTO decision representation	Petition decision signed by	Dates of subsequent Hyatt petitions for action prior to PTO's subsequent suspension	Subsequent PTO Suspension Date (b)	Period of PTO inaction after promising prompt action and prior to suspension [(b)-(a), years]	Examiner of record as of petition for action	Examiner of record upon suspension
529	08/470,080	1/21/05	3/9/05	PTO decision representation 						

Exhibit 15. Petition for examiner's answer in Docket No. 428

26X

26

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)	
)	
GILBERT P. HYATT)	Group Art Unit 2724
)	
Serial No. 08/423,234)	Examiner: Anh Hong Do
)	
Docket No. 428)	
)	
Filed: April 17, 1995)	
)	
For: IMAGE PROCESSING SYSTEM)	
HAVING A SAMPLED FILTER)	

PETITION FOR AN EXAMINER'S ANSWER
UNDER 37 CFR 1.181(A)(3)

Hon. Assistant Commissioner
 For Patents
 Washington, D.C. 20231
 Sir:

RECEIVED**JAN 22 2001**

DIRECTOR OFFICE
 TECHNOLOGY CENTER 2600

The Applicant respectfully petitions the Commissioner for his intervention to direct the Examiner to expeditiously provide the Applicant with an Examiner's Answer in response to the Applicant's Appeal Brief.

Examination in the instant application proceeded to the taking of an appeal and the timely filing of an Appeal Brief on August 11, 1997. An Examiner's Answer was due within two months.

The examiner should furnish the appellant with a written statement in answer to the appellant's brief within 2 months after the receipt of the brief by the examiner.

See MPEP 1208 (emphasis added). The importance of an examiner expeditiously furnishing an Examiner's Answer is even more compellingly illustrated by the fact that an Examiner's Answer takes "precedence" and "priority" over special applications.

Certain procedures by the examiners [examiner's answers] take precedence over actions even on special cases....

Applications in which practice requires that the examiner act within a set period, such as 2 months after

appellants brief to furnish the examiner's answers (MPEP § 1208) necessarily takes priority over special cases without specific time limits.

See MPEP 708.01 (emphasis added). Nevertheless, it has been over forty-one (41) months and the Applicant has not received an Examiner's Answer. This is a blatant violation of the plain requirements of the PTO and of the right's of the Applicant.

Even the United States Congress discourages delays by the PTO. The United States Congress, in the term extension provision of the American Inventors Protection Act of 1999, sent the clear message that undue delay by the PTO is unacceptable.


In view of the above, the Commissioner is hereby petitioned to direct the Examiner to immediately prepare an Examiner's Answer in the instant application or, alternatively, to pass the instant application to issue.

Because this petition seeks to invoke the Supervisory Authority of the Commissioner, a petition fee is not required.

Please charge any fees associated with the papers transmitted herewith to Deposit Account No. 08-3626, including any fees that may be required but are not set forth above.

Respectfully submitted,

Dated: January 19, 2001



Gilbert P. Hyatt
Registration No. 27,647
P.O. Box 81230
Las Vegas, NV 89180
Phone (702) 871-9899

Exhibit 16. PTO decision on petition in Docket No. 428



Paper No. 27

MAIL

MAY 22 2001

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

Gilbert P. Hyatt
P.O. Box 81230
Las Vegas, NV 89180

In re Application of
Gilbert P. Hyatt
Application No.: 08/423,234
Filed: 4/17/95

DECISION ON PETITION

This is a decision on the petition for an Examiner's Answer Under 37 CFR 1.181 (A)(3) filed January 22, 2001.

Petitioner urges that the Commissioner exercise his supervisor authority to direct the examiner to immediately prepare an Examiner's Answer in the instant application or, alternatively, to pass the application to issue.

37 CFR 1.193(a)(1) states in part:

"The primary examiner *may*, within such time as may be directed by the Commissioner, furnish a written statement in answer to appellant's brief..." (Emphasis added.)

MPEP 1208 States in part:

"The examiner *should* furnish the appellant with a written statement in answer to the appellant's brief within two months after the receipt of the brief by the examiner." (Emphasis added.)

There is no requirement under statute or rule compelling the examiner to issue an Examiner's Answer in response to an Appeal Brief. Alternatively, the examiner may dismiss the appeal and process the application for issuance or reopen prosecution if other more appropriate grounds of rejection/objection are contemplated. See MPEP 1208.02.

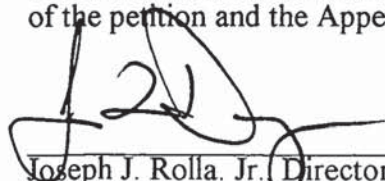
Therefore, the petition is without merit.

The petition is **DENIED**.

Decision on Petition

Page 2

However, in view of the lengthy prosecution in the instant application, the file is being forwarded to the examiner for immediate action as appropriate. Any delay caused petitioner in the treatment of the petition and the Appeal Brief is regretted.

 for Joe Rolla

Joseph J. Rolla, Jr. Director
Technology Center 2600
Communications

Exhibit 17. Chronology of selected petitions in appealed cases and PTO's responses thereto

Case Index	Family	Docket No.	Application Ser. No.	Application filing date	Appeal Brief filing date	Mr. Hyatt's relevant petition date	Decision on Petition and PTO representation Date	PTO Representation	Subsequent Suspension Date	Period A: Time Between Appeal Brief and Suspension (Years)	Period B: Time Between PTO Representation and Suspension (Years)	Examiner Name; Art Unit	Number of patents issued by this Examiner (Note 1)		
													Total in Period A	In Period A with app. date post Hyatt's app. date	In Period B with app. date post Hyatt's app. date
1	370	379	08/456,130	05/31/95	07/05/02	01/21/05	02/25/05	Petition dismissed. Because the "application by virtue of its prolonged pendency is already special in accordance with PTO policy, Petitioner's request is <i>moot</i> The examiner will be notified that this application should be considered as 'special' and appropriate for expedited action."	4/25/07	4.8 yrs	2.2 yrs	Dennis D. Chow; AU2675	295	291	129
11	410	428	08/423,234	04/17/95	08/11/97	01/19/01	05/22/01	Petition Denied. "However, in view of the lengthy prosecution in the instant application, the file is being forwarded to the examiner for immediate action as appropriate. Any delay caused petitioner in the treatment of the petition and the Appeal Brief is regretted."	7/31/02	5.0 yrs	1.2 yrs	Anh H. Do; AU2606	241	211	55
15	450	465	08/434,449	05/03/95	05/13/04	12/21/04	06/07/05	SPE stated that "the application file was located in IFW processing and that an Answer would be generated immediately upon its availability." 08/434,449 at A1991; "[T]he application has now been converted into image format" and petition "is <i>Dismissed as Moot</i> inasmuch as the file has been forwarded to the examiner for appropriate action in due course."	5/11/07	3.0 yrs	1.9 yrs	Phu Nguyen; AU2671	227	227	161
16		467	08/435,938	05/05/95	06/24/04	12/21/04	06/07/05	SPE stated that "the application file was located in IFW processing and that an Answer would be generated immediately upon its availability." 08/435,938 at A1697; "[T]he application has now been converted into image format" and petition "is <i>Dismissed as Moot</i> inasmuch as the file has been forwarded to the examiner for appropriate action in due course."	4/24/07	2.8 yrs	1.9 yrs	Phu Nguyen; AU2671	215	215	156
79		856	08/472,041	06/06/95	05/23/00	01/20/05	03/03/05	Petition dismissed. Because the "application by virtue of its prolonged pendency is already special in accordance with PTO policy, Petitioner's request is <i>moot</i> The examiner will be notified that this application should be considered as 'special' and appropriate for expedited action."	4/25/07	6.9 yrs	2.1 yrs	David D. Knepper; AU2741	268	264	98
80	850	865	08/472,032	06/06/95	05/23/00	01/20/05	02/24/05	Petition dismissed. Because the "application by virtue of its prolonged pendency is already special in accordance with PTO policy, Petitioner's request is <i>moot</i> The examiner will be notified that this application should be considered as 'special' and appropriate for expedited action."	4/25/07	6.9 yrs	2.2 yrs	Michael Opsasnick; AU2741	285	282	98

1. Public record on PTO website at <http://patft.uspto.gov/netahtml/PTO/search-adv.htm>, with specific parameters entered. An example of query entry yielding the 291 issued patents in Period A for the examiner listed in first row is (EXP/"Chow; Dennis" OR EXA/"Chow; Dennis") AND ISD/Jul-5-2002->Apr-25-2007 AND APD/May-31-1995->Apr-25-2007

Exhibit 18. PTO “Recycling” applications



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)	
)	
GILBERT P. HYATT)	Group Art Unit: 3621
)	
Serial No.: 07/289,355)	Examiner: Brian Werner
)	
Filed: December 22, 1988)	
)	
Docket No.: 321)	
)	
For: IMPROVED IMAGE PROCESSING)	
ARCHITECTURE)	
)	

MEETING CONFERENCE RECORD

Hon. Commissioner For Patents
 P.O. Box 1450, Alexandria, VA 22313-1450

The Applicant had a conference on November 16, 2006 with the Director of T.C. 2600, Andrew Christensen, who had responsibility for some of his applications. The Applicant described the issue of the PTO "recycling" of his patent applications that have rejections reversed by the Board and particularly described the history of two patent applications that were in T.C. 2600; including the instant application. The Applicant pointed out "the scenario of applications going round and round from the examining groups to the Board and then back to the examining groups and then back to the Board." The Director confirmed that this was the policy that the PTO was following.

CERTIFICATION OF MAILING: I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on October 11, 2007.

Dated: October 11, 2007

Respectfully submitted,

A handwritten signature in cursive script that reads "Gilbert P. Hyatt". The signature is written in dark ink and is positioned above the printed name.

Gilbert P. Hyatt
Registration No. 27,647
P.O. Box 81230
Las Vegas, NV 89180
Phone (702) 871-9899

Exhibit 19. The 40-year-long saga of Case Docket No.146

DEC 19 2012

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of)
)
 GILBERT P. HYATT)
)
 Serial No.: 05/860,277)
)
 Appeal No.: 2012-011643)
)
 Filed: December 13, 1977)
)
 Docket No.: 146)
)
 For: HIGH INTENSITY ILLUMINATION)
 CONTROL SYSTEM)

CONFIRMATION OF ORAL HEARING AND
PETITION FOR DECISIONS ON THREE PENDING PETITIONS
PRIOR TO THE ORAL HEARING

Hon. Commissioner For Patents
 P.O. Box 1450, Alexandria, VA 22313-1450
ATTENTION: Board of Patent Appeals and Interferences

May It Please The Honorable Board:

Introduction.

The Oral Hearing in the above application is currently set for February 4, 2013. The appellant provisionally confirms this date of oral hearing but respectfully petitions for decisions on three pending petitions¹ prior to the oral hearing. A copy of the Notice of Hearing is transmitted herewith. Furthermore, the appellant requests extra time for the hearing -- the

¹ The three outstanding petitions include (1) the Petition to Reopen Prosecution dated December 12, 1990, (2) the Supplemental Petition to Expunge dated December 17, 1990, and (3) the Petition to enter an amendment dated October 6, 1994.

appellant requests 45 minutes for the hearing. Good and sufficient reasons for granting of the petition is set forth below.

First, the appellant provisionally confirms the February 4, 2013, date of oral hearing. The appellant confirms his request to have an oral hearing in this appeal. This provisional confirmation is related to the instant petition for decisions on three pending petitions prior to the oral hearing as set forth below.

Second, the appellant hereby petitions the Board to obtain decisions on the three pending petitions prior to holding the oral hearing. In particular, the appellant desires to have a hearing in the instant case but the appellant submits that the instant appeal is not yet ready for oral hearing because three important petitions² have not yet been decided.

Third, the hearing on this appeal is premature

1. because the appellant had a right to amend the claims in response to explicit new grounds of rejection in the Examiner's Answer,
2. because the examiner did not consider the amendment on the merits,
3. because a petition directed to this amendment has not yet been decided, and
4. because two other petitions in this case have not yet been decided.³

Fourth, the examiner confirmed that, "if a responding paper was filed, the case would have to be remanded by the Board to the Examiner for consideration of the responding paper."⁴ This action is respectfully requested for the three undecided petitions.⁵

² The three outstanding petitions include (1) the Petition to Reopen Prosecution dated December 12, 1990, (2) the Supplemental Petition to Expunge dated December 17, 1990, and (3) the Petition to enter an amendment dated October 6, 1994.

³ The three outstanding petitions include (1) the Petition to Reopen Prosecution dated December 12, 1990, (2) the Supplemental Petition to Expunge dated December 17, 1990, and (3) the Petition to enter an amendment dated October 6, 1994.

⁴ Examiner Interview Record dated November 20, 1994.

The Chronology In-Part In The Appealed Patent Application.

In order to assist the Board in understanding the tortured record created by the PTO in the instant appeal, a chronology is provided in tabular form in this section and a text description thereof is provided in the section below entitled "The Tortured Record In The Appealed Patent Application".

DATE OF EVENT	MEMORIALIZED IN DOCUMENT	DESCRIPTION OF DOCUMENT OR EVENT
August 1, 1989	August 1, 1989 Notice of appeal	Notice of appeal
December 4, 1989	December 4, 1989 Appeal Brief	Appeal Brief
March 12, 1990	April 3, 1990 Telephone Conference Record	The examiner informed the appellant that he was trying to locate the file.
April 3, 1990	April 3, 1990 Telephone Conference Record	The examiner informed the appellant that the file had been lost and that an official search for the file had been initiated. The examiner said that this is the second time that this file had been lost and that it took six years to find the file the first time.
April 3, 1990	April 3, 1990 Request for Status	Request for Status.
August 10, 1990	August 10, 1990 Examiner's Answer	Examiner's Answer having express new grounds of rejection.
August 16, 1990	August 16, 1990 Request	The appellant requested the examiner to reopen prosecution because of the new grounds of rejection.
September 10, 1990	September 10, 1990 Response to the request to reopen prosecution	The examiner denied the appellant's request to reopen prosecution
September 24, 1990	September 24, 1990 Petition to Reopen Prosecution	The appellant petitioned to reopen prosecution because of the new grounds of rejection.

⁵ The three outstanding petitions include (1) the Petition to Reopen Prosecution dated December 12, 1990, (2) the Supplemental Petition to Expunge dated December 17, 1990, and (3) the Petition to enter an amendment dated October 6, 1994.

September 24, 1990	September 24, 1990 Petition to Expunge	The appellant petitioned to expunge the record because of improper remarks made by the examiner.
October 23, 1990	October 23, 1990 Request for Relief	The appellant pointed out the PTO delays and the expense of extensions of time and requested relieve relative there to.
October 23, 1990	October 23, 1990 Telephone Conference Record	The PTO lost the Examiner's Answer and the supervisor requested that the applicant provide a copy of it.
October 24, 1990	PTO Request October 24, 1990	The PTO lost the Examiner's Answer and the supervisor requested that the applicant provide a copy of it.
November 27, 1990	November 27, 1990 Decision on Petition to Reopen Prosecution	The director denied the Petition to Reopen Prosecution, but the Director stated that "any amendment or argument in response to the new grounds of rejection would be considered upon filing a Reply Brief."
November 27, 1990	November 27, 1990 Decision on Petition to Expunge	The Director elaborated on the denial and dismissed the Petition To Expunge and gave the appellant leave to submit additional evidence because "[t]here appears to be merit in applicant [sic] arguments that the examiner's statements were in error."
December 12, 1990	December 12, 1990 Petition to the Commissioner	The appellant petitioned to invoke the supervisory authority of the Commissioner regarding the decision on Petition to Reopen Prosecution. <u>The PTO has not yet decided this petition.</u>
December 17, 1990	December 17, 1990 Supplemental Petition to Expunge	The Supplemental Petition to Expunge addressed the Director's comments in the Decision on Petition to Expunge dated November 27, 1990.
January 31, 1991	January 31, 1991 Decision on Petition	The Administrator expressly postponed the decision on the Supplemental Petition to Expunge ("The supplemental petition to expunge filed December 20, 1990 will be decided in due course.") <u>The PTO has not yet decided this petition.</u>
February 11, 1991	February 11, 1991 Amendment [filed with Reply Brief]	The appellant filed an amendment directed to the new ground of rejection with the Reply Brief in response to the statement in the decision on petition that "any amendment or argument in response to the new grounds of rejection would be considered upon filing a Reply Brief".
October 21, 1991	October 21, 1991 Office Action	The examiner refused to consider the amendment, claiming that it was non-responsive.
November 25, 1992	November 25, 1992	The appellant filed a second amendment in

1992	Amendment	response to the examiner's comments.
August 25, 1992	August 25, 1992 Office Action	The Examiner refused to consider this second amendment claiming that it was non-responsive.
May 16, 1994	May 16, 1994 Telephone Conference Record	The appellant telephoned the examiner regarding status. The examiner said that the file history was at the Board of Appeals and that he would get it back and generate a Supplemental Examiner's Answer.
September 6, 1994	September 6, 1994 Supplemental Examiner's Answer	The examiner filed a Supplemental Examiner's Answer again refusing to consider the amendment as non-responsive
October 6, 1994	October 6, 1994 Petition to Enter the Amendment	The appellant filed a petition to enter the two amendments. <u>The PTO has not yet decided this petition.</u>
About early November 1994	November 20, 1994 Examiner Interview Record	The appellant telephoned the examiner about the status of the petition and the examiner told the appellant that the application file had been sent to the Board and that, "if a responding paper was filed, the case would have to be remanded by the Board to the Examiner for consideration of the responding paper.
November 17, 1994	November 20, 1994 Examiner Interview Record	The appellant checked with the Board, but the clerk at the Board said that the application was in the abandoned files and that the applicant should check with the examiner.
On or about November 16, 1994	November 20, 1994 Examiner Interview Record	The appellant met with the examiner and the examiner told the appellant that the application was not abandoned and that he would order the application from the abandoned files.
February 14, 1995	March 7, 1995 Telephone Conference Record	The appellant telephoned the examiner concerning status and was told to telephone the petitions examiner in the Commissioner's office concerning status.
On or about February 15, 1995	March 7, 1995 Telephone Conference Record	The appellant telephoned the Commissioner's office and was told by the Commissioner's office that they would check into the matter.
March 1, 1995	March 7, 1995 Telephone Conference Record	The appellant telephoned the Commissioner's office and was told by the Commissioner's office that the case was lost and that he would check into it.
March 1, 1995	March 7, 1995 Telephone Conference Record	The appellant telephoned the Commissioner's office and was told by the Commissioner's office that the case was lost and that it was being searched for.
March 7, 1995	March 7, 1995 Telephone	The appellant telephoned the examiner who stated that he thought that the case may have been

	Conference Record	sent to the abandoned files the same as the last time that it had been lost and that he would coordinate the search for it
August 31, 1995	August 31, 1995	The appellant again telephoned the examiner for status and was again told that the application was in the Commissioner's office.
August 31, 1995	August 31, 1995 Telephone Conference Record	The appellant again telephoned the Commissioner's office and was told that the application had been found and was sent back to the Director's office.
August 31, 1995	August 31, 1995 Telephone Conference Record	The appellant telephoned the Director's office and was told that the Director's office did not have the application file and that the applicant should telephone the examiner to initiate another search.
August 31, 1995	August 31, 1995 Telephone Conference Record	The appellant telephoned the examiner and was told that the examiner would initiate another search.
November 9, 2004	November 9, 2004 Request for Status	The appellant then again requested status
January 20, 2005	January 20, 2005 Petition for Action on the Merits	The appellant petitioned for an action on the merits.
March 28, 2007	March 28, 2007 Petition for Action on the Merits	After receiving no decisions on the various outstanding petitions, he appellant again petitioned for an action on the merits.
January 9, 2009	Suspension of Action	The PTO did not respond to the two petitions for actions on the merits, but instead suspended action for six months.
March 30, 2009	March 30, 2009 Petition for Status	The appellant Petitioned for Status
September 24, 2009	September 24, 2009 Suspension of Action	The PTO dismissed the two petitions for actions on the merits and again suspended action for six months.
August 2, 2010	August 2, 2010 Suspension of Action	After another delay of almost a year, the PTO again dismissed the two petitions for actions on the merits that had previously been dismissed and again suspended action for six months.
March 23, 2011	March 23, 2011	The PTO then acknowledged that the file history was permanently lost, so the PTO requested that the appellant reconstruct the file for the PTO.
June 23, 2011	June 23, 2011 Reconstruction of the record	The appellant reconstructed the record with a complete and accurate copy of the applicant's record.
November 28, 2012	November 28, 2012 Notice of hearing	The Board scheduled an oral hearing for February 4, 2013, but with three outstanding petitions. The three outstanding petitions include (1) the Petition

		to Reopen Prosecution dated December 12, 1990, (2) the Supplemental Petition to Expunge dated December 17, 1990, and (3) the Petition to enter an amendment dated October 6, 1994.
--	--	--

The Tortured Record In The Appealed Patent Application.

The record of this patent application has been tortured by the PTO examining group by losing and finding the file numerous times, permanently losing the file and requiring the appellant to reconstruct it, entering significant new grounds of rejection in the Examiner's Answer and then denying the appellant his right to amend the claims in the Reply Brief, and failing to decide petitions so that this case can be heard by the Board. The most prominent issues are summarized below, but the Board needs to review the record from the notice of appeal in 1989 to the present to get the full impact of what has happened during this appeal.

The appellant filed a notice of appeal⁶ and an Appeal Brief.⁷ more than 23 years ago. The examiner then generated an Examiner's Answer which expressly stated significant new grounds of rejection.⁸ The file was then lost and eventually found by the examining group.⁹ The examiner told the applicant that this is the second time that the file has been lost and that the first time the file was lost it took six years to find it.¹⁰ The appellant requested the examiner to reopen prosecution because of the new grounds of rejection,¹¹ but the examiner denied the request to reopen prosecution.¹² The appellant petitioned to reopen prosecution and to expunge

⁶ Notice of Appeal dated August 1, 1989.

⁷ Appeal Brief dated December 4, 1989.

⁸ Examiner's Answer dated August 10, 1990 (Paper No. 54).

⁹ Telephone Conference Record dated April 3, 1990.

¹⁰ Telephone Conference Record dated April 3, 1990.

¹¹ Request to Reopen Prosecution dated August 16, 1990.

¹² Response to the request to reopen prosecution dated September 10, 1990 (Paper No. 57).

the record¹³ but the Director denied the Petition To Reopen Prosecution and the Director elaborated on the denial and dismissed the Petition To Expunge.¹⁴ The appellant petitioned to invoke the supervisory authority of the Commissioner regarding the decision on Petition to Reopen Prosecution¹⁵ but the PTO has not yet decided this Petition to Reopen Prosecution. The appellant filed a Supplemental Petition to Expunge addressing the Director's comments.¹⁶ The Administrator expressly postponed the decision on the Supplemental Petition to Expunge¹⁷ and the PTO has not yet decided this Supplemental Petition to Expunge.

The decision on petition stated "any amendment or argument in response to the new grounds of rejection would be considered upon filing a Reply Brief."¹⁸ In response thereto, the appellant filed an amendment directed to the new ground of rejection with the Reply Brief.¹⁹ The amendment was presumably entered, but the examiner refused to consider the amendment, claiming that it was non-responsive.²⁰ The appellant filed a second amendment in response to the examiner's comments²¹ and the examiner filed a Supplemental Examiner's Answer again refusing to consider the amendment as non-responsive.²²

The Examiner refused to consider this second amendment claiming that it was non-responsive.²³ The appellant filed a petition to enter the first and second amendments²⁴ but the PTO has not yet decided this petition to enter these amendments. The appellant telephoned

¹³ Petition To Reopen Prosecution and Petition to Expunge dated September 24, 1990.

¹⁴ Decision on petitions dated November 27, 1990 (Paper No. 60).

¹⁵ Petition to Reopen Prosecution dated December 12, 1990.

¹⁶ Supplemental Petition To Expunge dated December 17, 1990.

¹⁷ Postponed decision on the Supplemental Petition To Expunge dated January 31, 1991.

¹⁸ Decision on Petition dated January 31, 1991 (Paper No. 61).

¹⁹ Amendment filed with the Reply Brief dated February 11, 1991.

²⁰ Paper No. 69 dated October 21, 1991.

²¹ Amendment dated November 25, 1992.

²² Supplemental Examiner's Answer dated September 6, 1994 (Paper No. 75).

²³ Paper No. 71 dated August 25, 1992.

the examiner about the status of the petition and the examiner told the appellant that the application file had been sent to the Board and that, "if a responding paper was filed, the case would have to be remanded by the Board to the Examiner for consideration of the responding paper."²⁵ The appellant checked with the Board, but the clerk at the Board said that the application was in the abandoned files.²⁶ The appellant met with the examiner and the examiner told the appellant that the application was not abandoned and that he would order the application from the abandoned files.²⁷ The appellant telephoned the examiner concerning status and was told to telephone the petitions examiner in the Commissioner's office concerning status.²⁸ The appellant telephoned the Commissioner's office and was told by the Commissioner's office that the case was lost and that it was being searched for.²⁹ The examiner stated that he thought that the case may have been sent to the abandoned files the same as the last time that it had been lost and that he would coordinate the search for it.³⁰

The appellant again telephoned the examiner for status and was again told that the application was in the Commissioner's office.³¹ The appellant again telephoned the Commissioner's office and was told that the application had been found and was sent to the Director's office, but the Director's office told the applicant that it did not have the application file and that the applicant should telephone the examiner.³² The appellant again telephoned the

²⁴ Petition dated October 6, 1994.

²⁵ Examiner Interview Record dated November 20, 1994.

²⁶ Examiner Interview Record dated November 20, 1994.

²⁷ Examiner Interview Record dated November 20, 1994.

²⁸ Telephone Conference Record dated March 7, 1995.

²⁹ Telephone Conference Record dated March 7, 1995.

³⁰ Telephone Conference Record dated March 7, 1995.

³¹ Telephone Conference Record dated August 31, 1995.

³² Telephone Conference Record dated August 31, 1995.

examiner who told the appellant that he would initiate another search.³³ The appellant then again requested status,³⁴ petitioned for an action on the merits,³⁵ and, after waiting two more years, again petitioned for an action on the merits.³⁶ The PTO did not respond to the two petitions for actions on the merits, nor did it decide the other three outstanding petitions, but instead the PTO suspended action for six months.³⁷ The appellant Petitioned for Status³⁸ and, after another delay by the PTO of almost six months from the Petition for Status, the PTO dismissed the two petitions for actions on the merits and again suspended action for six months..³⁹ After another delay of almost a year, the PTO again dismissed the two petitions for actions on the merits and again suspended action for six months.⁴⁰ The PTO then acknowledged that the file history was permanently lost, so the PTO requested that the appellant reconstruct the file for the PTO.⁴¹ The appellant reconstructed the record with a complete and accurate copy of the applicant's record.⁴² The Board then scheduled an oral hearing for February 4, 2013,⁴³ but with three outstanding petitions.⁴⁴

The long tortured scenario of the file history includes being lost by the PTO, being abandoned by the PTO, the examiner significantly changing his position on appeal with new grounds of rejection in the Examiner's Answer, the Examiner attempting to deprive the applicant

³³ Telephone Conference Record dated August 31, 1995.

³⁴ Request for Status dated November 9, 2004.

³⁵ Petition for an Action on the Merits dated January 20, 2005.

³⁶ Petition for an Action on the Merits dated March 28, 2007.

³⁷ Suspension of Action dated January 9, 2009.

³⁸ Petition for Status dated March 30, 2009.

³⁹ Suspension of Action dated September 24, 2009.

⁴⁰ Suspension of Action dated August 2, 2010.

⁴¹ Request to reconstruct the record dated March 23, 2011 .

⁴² Reconstruction of the record dated June 23, 2011 .

⁴³ Notice of hearing dated November 28, 2012.

of his right to respond to the new grounds of rejection in the Examiner's Answer, the examining group loosing the file history time and again, and then after a permanent loss requesting reconstruction of the file history by the appellant.

The hearing on this appeal is premature because the appellant had a right to amend the claims in response to explicit new grounds of rejection in the Examiner's Answer, because the examiner did not consider this amendment on the merits, because a petition directed to this amendment has not yet been decided, and because two other petitions have not yet been decided.⁴⁵

As stated by the examiner, because the application file was at the Board, "if a responding paper was filed, the case would have to be remanded by the Board to the Examiner for consideration of the responding paper."⁴⁶ This action is respectfully requested for the three undecided petitions.⁴⁷

As an alternative to a decision on petition challenging the refusal of the examiner to reopen prosecution or to consider the amendments in response to new grounds of rejection in the Examiner's Answer, the appellant requests that the Board remand the application to the examiner to expeditiously address the amendments on the merits.

⁴⁴ The three outstanding petitions include (1) the Petition to Reopen Prosecution dated December 12, 1990, (2) the Supplemental Petition to Expunge dated December 17, 1990, and (3) the Petition to enter an amendment dated October 6, 1994.

⁴⁵ The three outstanding petitions include (1) the Petition to Reopen Prosecution dated December 12, 1990, (2) the Supplemental Petition to Expunge dated December 17, 1990, and (3) the Petition to enter an amendment dated October 6, 1994.

⁴⁶ Examiner Interview Record dated November 20, 1994.

⁴⁷ The three outstanding petitions include (1) the Petition to Reopen Prosecution dated December 12, 1990, (2) the Supplemental Petition to Expunge dated December 17, 1990, and (3) the Petition to enter an amendment dated October 6, 1994.

Please charge any fees associated with the papers transmitted herewith to Deposit Account No. 08-3626. A Declaration claiming small entity status has been filed herein.

CERTIFICATION OF TRANSMISSION:: I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (FAX NO. 571-273-0299 and FAX NO. 571-273-8300) on December 19, 2012.

Respectfully submitted,

Dated: December 19, 2012



Gilbert P. Hyatt
Registration No. 27,647
P.O. Box 81230
Las Vegas, NV 89180
Phone (702) 871-9899

Exhibit 20. Issue Notice of Pat. No. 5,625,761



UW-MADISON
WENDT LIBRARY

AUG 28 1997

U.S. DEPOSITORY COPY
DO NOT DISCARD

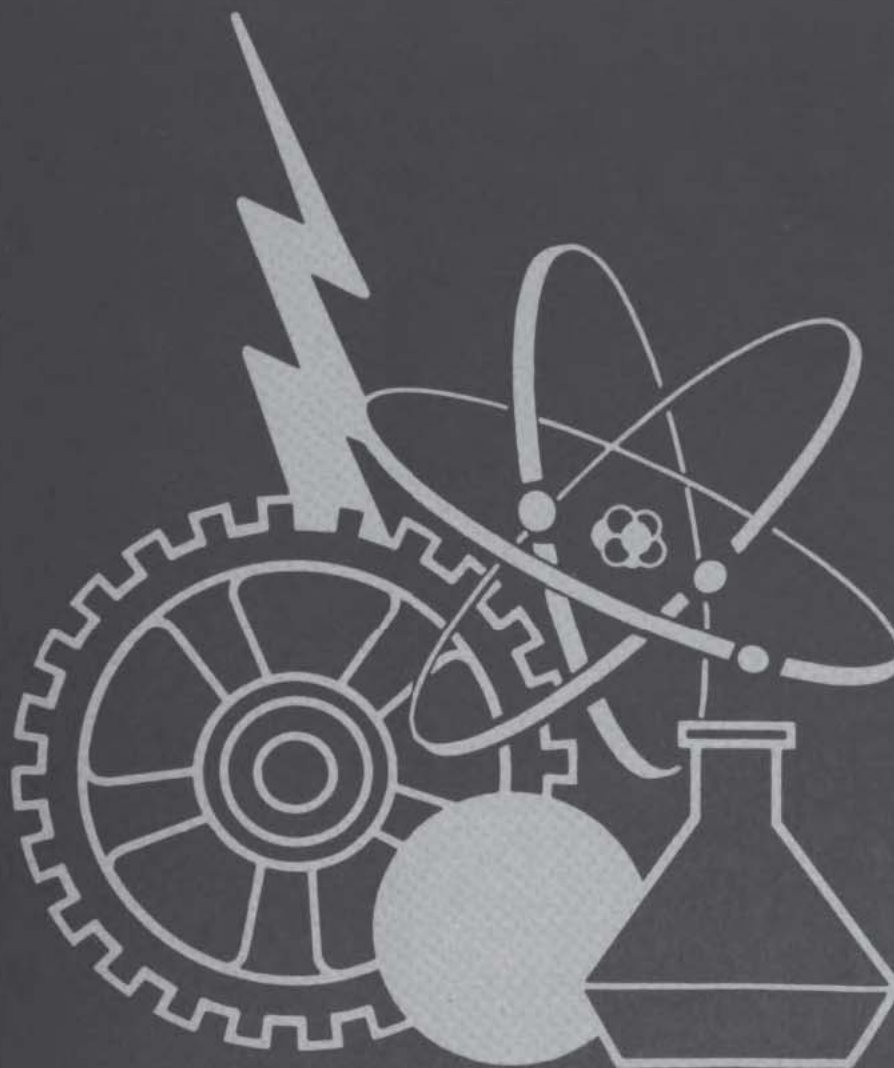
OFFICIAL GAZETTE

of the
UNITED STATES PATENT AND TRADEMARK OFFICE

ite to:

PATENTS

April 29, 1997



U.S.
DEPARTMENT
OF COMMERCE

Patent
and
Trademark
Office

Digitized by

Google

PUBLISHED WEEKLY BY AUTHORITY OF CONGRESS

Original from

UNIVERSITY OF WISCONSIN

OFFICIAL GAZETTE of the UNITED STATES PATENT AND TRADEMARK OFFICE

April 29, 1997

Volume 1197

Number 5

CONTENTS

	Page
Patent and Trademark Office Notices	
Patent Cooperation Treaty (PCT) Information	1197 OG 95
Notice of Maintenance Fees Payable	1197 OG 95
Notice of Expiration of Patents Due to Failure to Pay Maintenance Fee	1197 OG 96
Patents Reinstated Due to the Acceptance of a Late Maintenance Fee From 2/07/97	1197 OG 103
Patents Reinstated Due to the Acceptance of a Late Maintenance Fee From 2/14/97	1197 OG 103
Reissue Applications Filed	1197 OG 103
Requests for Reexamination Filed	1197 OG 104
Notice of Expiration of Trademark Registrations Due to Failure to Renew	1197 OG 104
Service by Publication	1197 OG 105
Errata	1197 OG 106
Disclaimers	1197 OG 106
Certificates of Correction	1197 OG 106
Meeting of the Public Advisory Committee for Trademark Affairs	1197 OG 107
Summary of Final Decisions Issued by the Trademark Trial and Appeal Board	1197 OG 109
Special Boxes for Mail	1197 OG 112
Reference Collections of U.S. Patents Available for Public Use in	
Patent Depository Libraries	1197 OG 114
Patent Examining Corps	1197 OG 116
Condition of Trademark Applications	1197 OG 117
Reexaminations	2879
Reissue Patents Granted (35,495)	2881
Plant Patents Granted (9,871)	2883
Patents Granted	
General and Mechanical (5,623,728)	2885
Chemical (5,624,465)	3139
Electrical (5,625,137)	3329
Design Patents Granted (378,947)	3595
Index of Patentees	PI 1
Indices of Reissue, Reexaminations, Design and Plant Patents	PI 105
Classification of	
Patents (Including Reissues and Reexaminations)	PI 109
Designs and Plants Applications	PI 113
Geographical Index of Residence of Inventors	
Patents (Including Reissues and Reexaminations)	PI 115
Designs and Plant Applications	PI 117
Change of Address Form	PI 119
Subscription Order Form	PI 121

The following are mailed under direction of the Superintendent of Documents, Government Printing Office, Washington, D.C., 20402, to whom all subscriptions should be made payable and all communications addressed.

VISA or MasterCard may be used for telephone orders, (202)-512-1800.

THE OFFICIAL GAZETTE (PATENT SECTION), issued weekly. Stock No. 703-033-00000-8

THE OFFICIAL GAZETTE (TRADEMARK SECTION), issued weekly. Stock No. 703-034-00000-4

PATENT AND TRADEMARK OFFICE NOTICES, issued weekly. Stock No. 703-035-00000-1

GENERAL INFORMATION concerning PATENTS. Stock No. 003-004-00661-7

COPIES OF PATENTS are furnished by the Patent and Trademark Office at \$3.00 each; PLANT PATENTS in color, \$12.00 each; copies of TRADEMARKS at \$3.00 each. Address orders to the Commissioner of Patents and Trademarks, Washington, D.C. 20231.

Printing authorized by Section 11(a)3 of Title 35, U.S.P.T.O.

For sale by the U.S. Government Printing Office
Superintendent of Documents, Mail Stop: SSOP, Washington, DC 20402-9328

APRIL 29, 1997

ELECTRICAL

3543

a plurality of three-dimensional address generators for generating addresses to read out the data from said three-dimensional memory; and

a plurality of pixel calculators for processing the read-out data from said three-dimensional memory by the depth queuing method.

5,625,761

TRANSFORM PROCESSOR SYSTEM HAVING A LOWER RESOLUTION HIGHER SPEED TRANSFORM PROCESSOR IN COMBINATION WITH A HIGHER RESOLUTION LOWER SPEED TRANSFORM PROCESSOR

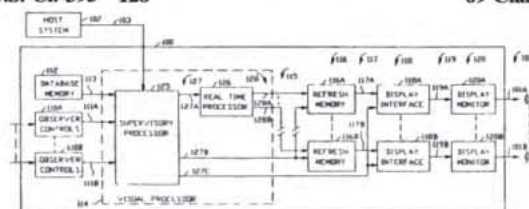
Gilbert P. Hyatt, P.O. Box 81230, Las Vegas, Nev. 89180

Continuation of Ser. No. 504,691, Jun. 15, 1983, Pat. No. 5,487,172, which is a continuation-in-part of Ser. No. 879,293, Nov. 24, 1969, abandoned, Ser. No. 101,881, Dec. 28, 1970, abandoned, Ser. No. 134,958, Apr. 19, 1971, abandoned, Ser. No. 135,040, Apr. 19, 1971, Ser. No. 230,872, Mar. 1, 1972, Pat. No. 4,531,182, Ser. No. 232,459, Mar. 7, 1972, Pat. No. 4,370,720, Ser. No. 246,867, Apr. 24, 1972, Pat. No. 4,310,878, Ser. No. 288,247, Sep. 11, 1972, Pat. No. 4,121,284, Ser. No. 291,394, Sep. 22, 1972, Pat. No. 4,396,976, Ser. No. 302,771, Nov. 1, 1972, Ser. No. 325,941, Jan. 22, 1973, Pat. No. 4,060,848, Ser. No. 366,714, Jun. 4, 1973, Pat. No. 3,986,022, Ser. No. 339,817, Mar. 9, 1973, Pat. No. 4,034,276, Ser. No. 490,816, Jul. 22, 1974, Pat. No. 4,209,853, Ser. No. 476,743, Jun. 5, 1974, Pat. No. 4,364,110, Ser. No. 522,559, Nov. 11, 1974, Pat. No. 4,209,852, Ser. No. 550,231, Feb. 14, 1975, Pat. No. 4,209,843, Ser. No. 727,330, Sep. 27, 1976, abandoned, Ser. No. 730,756, Oct. 7, 1976, abandoned, Ser. No. 752,240, Dec. 20, 1976, abandoned, Ser. No. 754,660, Dec. 27, 1976, Pat. No. 4,486,850, Ser. No. 801,879, May 31, 1977, Pat. No. 4,144,583, Ser. No. 812,285, Jul. 1, 1977, Pat. No. 4,371,953, Ser. No. 844,765, Oct. 25, 1977, Pat. No. 4,523,290, Ser. No. 849,733, Nov. 9, 1977, abandoned, Ser. No. 849,812, Nov. 9, 1977, Ser. No. 860,277, Dec. 13, 1977, Ser. No. 860,278, Dec. 13, 1977, Pat. No. 4,471,385, Ser. No. 860,253, Dec. 14, 1977, abandoned, Ser. No. 860,252, Dec. 14, 1977, abandoned, Ser. No. 860,257, Dec. 14, 1977, Pat. No. 4,371,923, Ser. No. 874,446, Feb. 2, 1978, Pat. No. 4,342,906, Ser. No. 889,301, Mar. 23, 1978, Pat. No. 4,322,819, Ser. No. 948,378, Oct. 4, 1978, abandoned, Ser. No. 160,871, Jun. 19, 1980, Pat. No. 4,445,189, Ser. No. 160,872, Jun. 19, 1980, Pat. No. 4,491,930, Ser. No. 169,257, Jul. 16, 1980, Pat. No. 4,435,732, Ser. No. 223,959, Jan. 12, 1981, abandoned, Ser. No. 332,501, Jan. 22, 1981, abandoned, Ser. No. 425,136, Sep. 27, 1982, Pat. No. 4,739,396, Ser. No. 425,135, Sep. 27, 1982, Pat. No. 4,551,816, and Ser. No. 425,131, Sep. 27, 1982, Pat. No. 4,686,655. This application Sep. 20, 1991, Ser. No. 763,395

Int. Cl. G06F 15/00

U.S. Cl. 395—128

69 Claims



1. A transform processor system comprising:

- a first transform processor generating first transforms having a first resolution;
- a second transform processor generating second transforms having a second resolution that is better than the first resolution; and
- a third processor coupled to the first transform processor and to the second transform processor and improving the resolution of the first transforms in response to the second transforms.

5,625,762

METHOD FOR EXTRACTING THREE-DIMENSIONAL COLOR VECTOR

Yuri Takizawa, Machida; Shinichiro Miyaoka, Kawasaki; Makoto Kato, Yokohama, and Makoto Nohmi, Kawasaki, all of Japan, assignors to Hitachi, Ltd., Tokyo, Japan

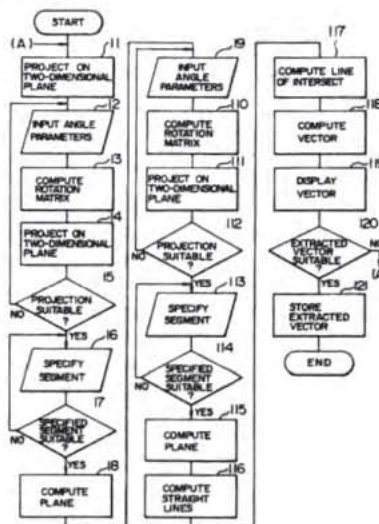
Filed May 10, 1991, Ser. No. 698,122

Claims priority, application Japan, May 11, 1990, 2-119827

Int. Cl. G06T 7/00

U.S. Cl. 395—131

9 Claims



1. A method for extracting a three-dimensional color vector approximately representing a cluster of plotted points in a three-dimensional RGB primary color space, said plotted points indicating the distribution of the R, G, B components of color pixels of a specific object in a color image, the method comprising the steps of:

- designating a direction of a first projection plane;
- in response to said step of designating the direction of said first projection plane, projecting said plotted points in said three-dimensional RGB color space on said first projection plane;
- displaying a first projection image of said first projection plane on a display;
- designating a first line segment on said display, said first line segment expressing the feature of a distribution of said plotted points projected on said first projection image;
- in response to said step of designating a first line segment on said display, determining a first equation expressing a first designated plane in said three-dimensional RGB primary color space, said first designated plane being perpendicular to said first projection plane, wherein the projection of said first designated plane on said first projection plane is said first line segment;
- designating the direction of a second projection plane;
- in response to said step of designating the direction of a second projection plane, projecting said plotted points in said three-dimensional RGB primary color space onto said second projection plane;
- displaying a second projection image of said second projection plane on said display;
- designating a second line segment on said display, said second line segment expressing the feature of the distribution of said plotted points projected on said second projection image;
- in response to said step of designating a second line segment on said display, calculating a second equation expressing a second designated plane in said three-dimensional RGB primary color space, said second designated plane being perpendicular to said second projection plane, wherein the projection of said second designated plane on said second projection plane is said second line segment; and
- extracting said three-dimensional color vector by extracting a line of intersection of said first designated plane and said second designated plane from said first equation and said

APPLICANT

12 26 76

3

5

12 14 77 — A.W.

4/29/97

PTO UTILITY GRANT

Paper Number

43

The Commissioner of Patents and Trademarks

Has received an application for a patent for a new and useful invention. The title and description of the invention are enclosed. The requirements of law have been complied with, and it has been determined that a patent on the invention shall be granted under the law.

Therefore, this

United States Patent

Grants to the person(s) having title to this patent the right to exclude others from making, using, offering for sale, or selling the invention throughout the United States of America or importing the invention into the United States of America for the term set forth below, subject to the payment of maintenance fees as provided by law.

If this application was filed prior to June 8, 1995, the term of this patent is the longer of seventeen years from the date of grant of this patent or twenty years from the earliest effective U.S. filing date of the application, subject to any statutory extension.

If this application was filed on or after June 8, 1995, the term of this patent is twenty years from the earliest effective U.S. filing date of the application, subject to any statutory extension.

The United States of America



Bence Lehman

Commissioner of Patents and Trademarks

Melvinia Gary

Attest

Exhibit 21. Withdrawal from issue



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Paper No. ~~34~~ 44

COPY MAILED

APR 22 1997

**OFFICE OF
PATENT PUBLICATION**

GILBERT P. HYATT
P.O. BOX 81230
LAS VEGAS, NV. 89180

In re Application of
Gilbert P. Hyatt
Application No. 07/763,395
Filed: Sept 20, 1991
Attorney Docket No. 342

NOTICE

The purpose of this communication is to inform you that the above - identified application, which has received a patent number or an issue date, is being withdrawn from issue pursuant to 37 CFR 1.313.

The application is being withdrawn for the following purpose: to reopen prosecution. This withdrawal was requested by the Group Director. Any questions concerning this withdrawal should be addressed to the Group Director at (703) 305-9700..

This application is being returned to the Office of the Director of Group 2300.

Telephone inquiries concerning this matter may be directed to the undersigned at (703) 305-8594.

A handwritten signature in cursive script, appearing to read "Karna Cooper".

Karna Cooper
Paralegal Specialist
Office of the Director
Office Patent Publication

Exhibit 22. Petitions for action in the Docket No. 342 application



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)

GILBERT P. HYATT)

Serial No. 07/763,395)

Docket No. 342)

Filed: September 20, 1991)

For: A TRANSFORM PROCESSOR SYSTEM HAVING A)
LOWER RESOLUTION HIGHER SPEED TRANSFORM)
PROCESSOR IN COMBINATION WITH A HIGHER)
RESOLUTION LOWER SPEED TRANSFORM PROCESSOR)

PETITION FOR AN ACTION ON THE MERITS
UNDER 37 CFR 1.181(A) (3)

Hon. Assistant Commissioner
For Patents
Washington, D.C. 20231

Sir:

The Applicant respectfully petitions the Commissioner for his intervention to direct the Examiner to expeditiously provide the Applicant with an Action on the merits.

The PTO requires an expeditious response to amendments (MPEP 708, last paragraph):

All amendments before final rejection should be responded to within two months of receipt.

Further, the PTO requires that the instant application be advanced out of turn for examination for the following reasons (MPEP 708.01, item I):

Applications pending more than 5 years, including those which, by relation to a prior United States application, have an effective pendency of more than 5 years.

The instant application meets both of these criterion, it has been pending more that 5 years and it has an effective pendency of more than 5 years.

No action has been received in the instant application in more than a year.

The Applicant filed a Request For Status in the instant application dated November 9, 2004 but the Examiner has not responded thereto.

In view of the above, the Commissioner is hereby petitioned to direct the Examiner to immediately prepare an action in the instant application or, alternatively, to pass the instant application to issue.

Because this petition seeks to invoke the Supervisory Authority of the Commissioner under 37 CFR 1.181(a)(3), a petition fee is not required and thus a fee authorization is not needed.

Respectfully submitted,

Dated: January 20, 2005



Gilbert P. Hyatt
Registration No. 27,647
P.O. Box 81230
Las Vegas, NV 89180
Phone (702) 871-9899



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)
 GILBERT P. HYATT)
 Serial No. 07/763,395)
 Docket No. 342)
 Filed: September 20, 1991)
 For: A TRANSFORM PROCESSOR SYSTEM HAVING A)
 LOWER RESOLUTION HIGHER SPEED TRANSFORM)
 PROCESSOR IN COMBINATION WITH A HIGHER)
 RESOLUTION LOWER SPEED TRANSFORM PROCESSOR)

RECEIVED

SEP 05 2007

Technology Center 2100

PETITION FOR AN ACTION ON THE MERITS
UNDER 37 CFR 1.181(A)(3)

Hon. Commissioner For Patents
 P.O. Box 1450, Alexandria, VA 22313-1450
 Sir:

The Applicant respectfully petitions the Commissioner for his intervention to direct the Examiner to expeditiously provide the Applicant with an Action on the merits.

The PTO requires an expeditious response to amendments (MPEP 708, last paragraph):

All amendments before final rejection should be responded to within two months of receipt.

Further, the PTO requires that the instant application be advanced out of turn for examination for the following reasons (MPEP 708.01, item I):

Applications pending more than 5 years, including those which, by relation to a prior United States application, have an effective pendency of more than 5 years.

The instant application meets both of these criteria, it has been pending more than 5 years and it has an effective pendency of more than 5 years.

In view of the above, the Commissioner is hereby petitioned to direct the Examiner to immediately prepare an action in the instant application or, alternatively, to pass the instant application to issue.

The Applicant makes note that a decision has been rendered by the Federal Circuit in *Hyatt v. Dudas*, Appeal No. 2006-1171, on June 28, 2007 reversing the decision of the District Court.

Because this petition seeks to invoke the Supervisory authority of the Commissioner under 37 CFR 1.181(a)(3), a petition fee is not required and thus a fee authorization is not needed.

CERTIFICATION OF MAILING BY EXPRESS MAIL: I hereby certify that this correspondence is being deposited with the United States Postal Service with Express Mail post office to addressee service under 37 CFR 1.10, postage prepaid, in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 with the express mail label number EV 339845925 on August 28, 2007.

Dated: August 28, 2007

Respectfully submitted,



Gilbert P. Hyatt

Registration No. 27,647

P.O. Box 81230

Las Vegas, NV 89180

Phone (702) 871-9899



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

GILBERT P. HYATT

Serial No. 07/763,395

Docket No. 342

Filed: September 20, 1991

For: A TRANSFORM PROCESSOR SYSTEM HAVING A
LOWER RESOLUTION HIGHER SPEED TRANSFORM
PROCESSOR IN COMBINATION WITH A HIGHER
RESOLUTION LOWER SPEED TRANSFORM PROCESSOR

RECEIVED

JUN 01 2009

Technology Center 2800

RECEIVED

APR 07 2009

OFFICE OF PETITIONS

PETITION FOR AN ACTION ON THE MERITS
UNDER 37 CFR 1.181(A)(3)

Mail Stop Petition

Hon. Commissioner For Patents

P.O. Box 1450, Alexandria, VA 22313-1450

Sir:

The Applicant respectfully petitions the Commissioner for his intervention to direct the Examiner to expeditiously provide the Applicant with an Action on the merits.

The PTO requires an expeditious response to amendments (MPEP 708, last paragraph):

All amendments before final rejection should be responded to within two months of receipt.

Further, the PTO requires that the instant application be advanced out of turn for examination for the following reasons (MPEP 708.01, item I):

Applications pending more than 5 years, including those which, by relation to a prior United States application, have an effective pendency of more than 5 years.

The instant application meets both of these criteria, it has been pending more than 5 years and it has an effective pendency of more than 5 years.

In view of the above, the Commissioner is hereby petitioned to direct the Examiner to immediately prepare an action on the merits in the instant application or, alternatively, to pass the instant application to issue.

The Applicant makes note that the Federal Circuit has affirmed the district court with a decision dated December 23, 2008 in appeals 2007-1050, -1051, -1052, -1053.

The Applicant further requests status of the instant application.

Because this petition seeks to invoke the Supervisory authority of the Commissioner under 37 CFR 1.181(a)(3), a petition fee is not required and thus a fee authorization is not needed.

CERTIFICATION OF MAILING BY EXPRESS MAIL: I hereby certify that this correspondence is being deposited with the United States Postal Service with Express Mail post office to addressee service under 37 CFR 1.10, postage prepaid, in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 with the express mail label number EV 323877664 on March 30, 2009.

Dated: March 30, 2009

Respectfully submitted,



Gilbert P. Hyatt
Registration No. 27,647
P.O. Box 81230
Las Vegas, NV 89180
Phone (702) 871-9899

Exhibit B

Exhibit C

- 1
- 2
- 3
- 4
- 5
- 6
- 7
- 8
- 9
- 0
- 1
- 2
- 3
- 4
- 5
- 6
- 7
- 8
- 9
- 0
- 1
- 2
- 3
- 4
- 5

TRANSCRIPT OF BENCH TRIAL - DAY 4

BEFORE THE HONORABLE SENIOR JUDGE ROYCE C. LAMBERTH

UNITED STATES DISTRICT JUDGE

For the Plaintiff: Andrew M. Grossman, Esquire
Paul M. Levine, Esquire
Mark W. DeLaquil, Esquire
BAKER HOSTETLER
Washington Square
1050 Connecticut Avenue NW, Suite 1100
Washington, DC 20036-5304

146

1 Court Reporter: Cathryn J. Jones, RPR
2 Official Court Reporter
3 Room 6521, U.S. District Court
4 333 Constitution Avenue, N.W.
5 Washington, D.C. 20001

6 Proceedings recorded by machine shorthand, transcript
7 produced by computer-aided transcription.
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25

TABLE OF CONTENTS**WITNESSES****On behalf of the Defendant:**

	<u>Direct</u>	<u>Cross</u>	<u>Redirect</u>
--	----------------------	---------------------	------------------------

GREGORY MORSE

(By Mr. Levine)	4		
(By Mr. McBride)			34

STEPHEN G. KUNIN

(By Mr. Warrick)	62		
-------------------	----	--	--

E X H I B I T S

<u>Plaintiff's Exhibit Number</u>	<u>Marked</u>	<u>Admitted</u>
--	----------------------	------------------------

Nos. 9A, 310, 311		21
-------------------	--	----

Nos. 433, 442		25
---------------	--	----

Nos. 2, 491		34
-------------	--	----

* * *

P R O C E E D I N G S

THE DEPUTY CLERK: We're resuming bench trial, day four in the Gilbert Hyatt v. Matal, et al matter.

THE COURT: Be seated. The witness may resume the stand.

MR. GROSSMAN: Your Honor, if I may, I have one brief housekeeping measure at the outset?

THE COURT: Sure.

MR. GROSSMAN: Under the existing scheduling order the pretrial statements for the merits at trial are due tomorrow. We had noted at the pretrial conference that given that we are in trial at this point, it is a little bit inconvenient for the parties to file those tomorrow. And we were hoping that that date could be postponed.

THE COURT: It will be postponed. We'll set a new date at a later point.

MR. GROSSMAN: Thank you, your Honor.

CROSS-EXAMINATION [Cont'd]

BY MR. LEVINE:

Q Good morning, Mr. Morse. How are you?

A Good morning.

Q All right. Yesterday you walked us through three court litigations. You recall that testimony?

A I do.

Q And that was the Kappos v. Hyatt decision and what we

1 Q Now Mr. Levine said that Mr. Hyatt has spent over
2 \$7 million dollars in fees to PTO. Do you know
3 approximately how much the PTO has paid just to your group
4 of examiners while you've been there for the past four, five
5 years?

6 A Well the fees are not -- it's not -- the fees are
7 designed to recover in the aggregate costs, the costs of the
8 system. So it's not a fee for servicing and we're not
9 sending bills based on the number of hours that the examiner
10 spent. But I have since 2012, I've had 12 GS15 examiners.
11 Their pay starts at at least \$120,000. I think just in
12 salary costs it's about \$2 million dollars a year, so this
13 is an expensive process all around.

14 Q So over the past five years approximately how much has
15 PTX expended in just the examiners' salaries?

16 A It's about \$10 million.

17 Q Ten million. That doesn't include any of the examiner
18 time before your group got started?

19 A No, no it doesn't. But the fees are designed to
20 recover the aggregate costs of everyone's behavior and it's
21 mostly driven by average behavior.

22 Q Okay. Understand. But the PTO has expended a lot of
23 people and resources and money in department salaries trying
24 to examine Mr. Hyatt's applications?

25 A Yes.

Exhibit CC



UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE OF THE GENERAL COUNSEL

May 25, 2018

VIA E-MAIL

Mr. Andrew Grossman
Baker Hostetler
Washington Square
1050 Connecticut Ave, N.W, Suite 1100
Washington, DC 20036-5304
agrossman@bakerlaw.com

RE: *Freedom of Information Act (FOIA) Request No. FP-18-00014 (Modification and Fee Waiver Request)*

Dear Mr. Grossman:

This is in response to your correspondence dated, April 27, 2018, pursuant to the Freedom of Information Act (5 U.S.C. § 552), requesting a copy of:

All records concerning Mr. Hyatt or his patent applications created by, sent by, or received by (a) Diego Gutierrez during 2012 and 2013 or (b) Gregory Morse from and including 2013 through 2018, excluding (1) email attachments, (2) documents contained in the file histories of Mr. Hyatt's applications, and (3) drafts of documents contained in the file histories of Mr. Hyatt's applications.

In this letter you requested a fee waiver and, in the event that this fee waiver request is not granted, that this request not be considered a commercial use request. For the reasons set forth below, the request for a fee waiver and for this request not to be considered a commercial use request are denied.

Multitrack Processing

As a preliminary matter, we wanted to inform you that the USPTO uses multitrack processing, as described in 37 C.F.R. §102.6 (d), and assigns FOIA requests to simple or complex tracks. As discussed via telephone and in our correspondence, your request, even as modified and narrowed in your communication of April 27th, asks for a voluminous amount of records. Given the amount of anticipated records involved in this request and the amount of work and time needed to search for and review these records, this request has been assigned to the complex track.

Fee Waiver Request

The request for a fee waiver is denied. In order for fees to be waived or reduced, a requester must demonstrate that disclosure of the requested information: (1) is in the public interest because it is likely to contribute significantly to public understanding of the operations or activities of the Government (“public understanding requirement”), and (2) not primarily in the commercial interest of the requester (“noncommercial interest requirement”). *See* 5 U.S.C. § 552(a)(4)(A)(iii) and 37 C.F.R. § 102.11(k)(1).

1. Public Interest Requirement

To determine whether the public understanding requirement is met, the FOIA Officer considers four factors: (1) the subject of the request, (2) the informative value of the information to be disclosed, (3) the contribution to an understanding of the subject by the public likely to result from disclosure, and (4) the significance of the contribution to public understanding. *See* 37 C.F.R. § 102.11(k)(2). In this case, the fee waiver request fails to satisfy factors (2), (3), and (4).

With respect to factor (2), a requester needs to demonstrate that disclosure of the requested records are “likely to contribute” to an understanding of Government operations or activities. The disclosable portions of the requested records must be meaningfully informative about Government operations or activities in order to “likely to contribute” to an increased public understanding of those operations or activities. 37 C.F.R. § 102.11(k)(2)(ii). However, Mr. Hyatt’s request, on its face, only concerns (a) Mr. Hyatt and (b) Mr. Hyatt’s patent applications.

While Mr. Hyatt claims that this disclosure will contribute to the public’s understanding, given the “extremely limited understanding of these operations or activities as a result of the PTO’s lack of public disclosure,” it is difficult to ascertain how records concerning Mr. Hyatt and his applications would actually contribute to an increased public understanding of Government operations and activities. This request is so narrowly tailored and focused on Mr. Hyatt, it is unlikely disclosure of this information would be meaningfully informative about government operations and activities. Simply because Mr. Hyatt asserts that the disclosure of the requested records would “likely contribute” to an understanding of Government operations or activities, does not make it true, especially here where the evidence presented is solely focused on Mr. Hyatt and Mr. Hyatt’s applications.

Pursuant to factor (3), a requester must show that:

[D]isclosure of the requested information will contribute to the understanding of a reasonably broad audience of persons interested in the subject, as opposed to the individual understanding of the requester. A requester’s expertise in the subject area and ability and intention to effectively convey information to the public shall be considered. It shall be presumed that a requester who merely provides information to media sources does not satisfy this consideration.

Mr. Hyatt claims that he intends to disseminate the information concerning (a) Mr. Hyatt and (b) Mr. Hyatt’s patent applications through internet publication. Specifically, he cites to the American

Center for Equitable Treatment (ACET) website (<http://acet-usa.org>) as his intended means of distribution. However, The ACET website appears to be a single issue website and the sole subject of its content is Mr. Hyatt.

The evidence presented in Mr. Hyatt's fee waiver request claims that the information he seeks in these records would be disseminated to a broad audience of persons interested in the subject – other than himself – also fails. For instance, while some FOIA requests are posted on the ACET website, there is no information about how many people have viewed materials on the website. Additionally, the ACET blog only has four entries which suggests interest on this matter is quite limited. Also, the ACET website appears to be a single issue website and that subject is Mr. Hyatt. Moreover, the fact that Mr. Hyatt's litigation against the USPTO and his FOIA request are either directly or indirectly related to the prosecution of only his patent applications suggests that Mr. Hyatt's fee waiver request fails to demonstrate that the requested records would be disseminated to a broad audience of persons interested in the subject.

The words from Mr. Hyatt's own declaration suggest that many if not all of the "300 patents pending" are unpublished, but Mr. Hyatt has made no indication that he would disclose information about these unpublished patent applications to the public. Thus, again making it unlikely that Mr. Hyatt will ever disseminate the records he seeks to the public. Much of the information he has requested would logically concern unpublished patent applications, but there doesn't appear to be anything on the ACET website about unpublished patent application information. Nor is there anything in Mr. Hyatt's fee waiver request that suggests he would publically post information about unpublished patent applications.

The few waiver request states that Mr. Hyatt's "commercial interests are all but non-existent," but he has failed to demonstrate this. While his request states that "Mr. Hyatt's principal interest is identifying and exposing the PTO's unusual treatment of him, its secret policies and procedures, and the likely violation of his constitutional and statutory rights by the PTO, which is not at all a commercial interest." Again merely stating this argument does not make it so, but it would be potentially more persuasive if Mr. Hyatt actually had posted or disseminated information about his unpublished patent applications, but to date, according to what has been presented in this request, he has not provided such information and there is no actual evidence that he intends to do so in the future. Arguably, Mr. Hyatt has not disseminated this information because of the "commercial interest" he has in protecting any potential unpublished patent applications, and there is no evidence to suggest this position would change. Mr. Hyatt's continued pursuit of patent prosecution is directed towards securing patents and he has failed to present any other reason for obtaining these patents other than for commercial interest.

Last but not least, Mr. Hyatt's claim that he would publically disseminate the requested information to a broad audience is more than questionable, because the <http://www.ptomisconduct.com> website cited in Mr. Hyatt's fee waiver request as an intended place of distribution contains only what appears to be a black and white picture of a drunk and falling cat. There is no proof that information about the records requested will actually be posted on this website. Additionally, nothing in the content of this URL supports the notion that disclosure of the requested information will contribute to the understanding of a reasonably

broad audience of persons interested in the subject, as opposed to the individual understanding of the requester.

Finally, to satisfy factor (4), a requester must show that disclosure of the requested records “is likely to contribute ‘significantly’ to public understanding of Government operations or activities. The public’s understanding of the subject in question must be significantly enhanced by the disclosure.”

Mr. Hyatt’s request fails this factor as well. While he states that through the requested records he will “ensure that information shedding light on the activities are extracted, synthesized, and effectively conveyed to the public through publication...” and that “[a]lthough, the FOIA request concerns records pertaining to me, those records are, viewed objectively, of significant interest to the public,” his assertions are still problematic. Merely focusing on issues that directly affect oneself is not indicative of information that that would necessarily contribute significantly to the public understanding of Government operations or activities. Based on the arguments presented in this request, there may be information distributed about Mr. Hyatt’s specific interactions with the USPTO, but these arguments fail to illustrate exactly how Mr. Hyatt’s specific interactions shed light on Government operations and activities and in turn how these individual interactions would significantly contribute to the public’s understanding thereof.

2. Disclosure of the Information Is Primarily in the Commercial Interest of Mr. Hyatt

To determine whether the second fee waiver requirement is met, the FOIA Officer considers two factors: (1) the existence and magnitude of a commercial interest and (2) the primary interest in disclosure. *See* 37 C.F.R. § 102.11(k)(3). Neither of these factors has been satisfied with this fee waiver request.

Under the first factor, a FOIA Officer considers “whether a requester has a commercial interest that would be furthered by the requested disclosure.” Mr. Hyatt’s interest is purely commercial, as Mr. Hyatt currently has several pending lawsuits against the USPTO. *See Rozet v. Dep’t of Housing and Urb. Development*, 59 F. Supp. 2d 55, 57 (D. D.C. 1999) (holding that the timing of plaintiff’s lawsuit demonstrated the FOIA request sought to advance his commercial, rather than public, interest).

Commercial Requester Status – Mr. Hyatt is a Commercial Requester

Under 37 C.F.R. § 102.11(b)(1), commercial use request “means a request from or on behalf of a person who seeks information for a use or purpose that furthers his or her commercial, trade, or profit interests, which can include furthering those interests through litigation.” The USPTO regulation continues, mandating that the “FOIA Officer shall determine, whenever reasonably possible, the use to which a requester will put the requested records. When it appears that the requester will put the records to a commercial use, either because of the nature of the request itself or because the FOIA Officer has reasonable cause to doubt the requester’s stated use, the FOIA Officer shall provide the requester a reasonable opportunity to submit further clarification.” *Id.*

It is highly unlikely and unreasonable to conclude that this request for records “lacks a commercial use.” Merely because the author suggests that the requested records intended use is not for commercial use does not make it so. Rather, as previously explained, the complete set of facts suggests that the commercial interest at stake far outweighs any persuasive public interest argument.

As previously mentioned, Mr. Hyatt has been and is currently engaged in litigation with the USPTO for years. The fact that Mr. Hyatt is a commercial requester is substantiated by the notion that if the requester is engaged in litigation with the USPTO, then “the FOIA Officer shall determine, whenever reasonably possible, the use to which a requester will put the requested records.” 37 C.F.R. § 102.11(b)(1). Accordingly, based on his litigation alone, Mr. Hyatt has a commercial interests in the records sought.

In this request, Mr. Hyatt claims that he seeks to “ascertain the extent and details of the violation of his constitutional and statutory rights by the PTO and PTO personnel and to inform the public, through publication, about PTO important operations that have not been meaningfully disclosed to date and about potentially serious misconduct by a government agency and its personnel.” Mr. Hyatt claims that his intended use is to understand the PTO’s unusual actions on his applications, among other uses. He also spends a considerable amount of time discussing the Sensitive Application Warning System (SAWS) program in his declaration. Of note, this program was terminated over three years ago; thus, it is hard to fathom how information about the program today would really inform the public about “important operations that have not been meaningfully disclosed.”

In short, Mr. Hyatt’s litigation against the USPTO almost completely focuses on getting patents issued. At the most basic level, one pursues a patent for one major reason: to protect his or her rights to an invention -- *a commercial interest*. Therefore, his statement is given little weight, and there is reasonable cause to doubt his stated use. Furthermore, it is difficult to envision a non-commercial purpose for pursuing patent rights. Hence, the evidence supports the determination that Mr. Hyatt is a commercial requester.

This denial is firmly based on the fact that the commercial interest in this matter far exceeds any public interest use as asserted in this specific request for fee waiver.

Summary of Denial of Requests for Fee Waiver and Noncommercial Status

While your request asserts many things, it lacks the sufficient proof of warranting a fee waiver and being deemed a non-commercial requester. Accordingly, your request for a public interest fee waiver and to be deemed a non-commercial requester is denied for the aforementioned reasons above.

This denial of the requests for a fee waiver request and status as a noncommercial use requester constitutes an adverse initial determination under the FOIA. The undersigned is the denying official. You have the right to appeal this initial decision to the General Counsel, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. An appeal must be received within 90 calendar days from the date of this letter. See 37 C.F.R. § 102.10(a). The

appeal must be in writing. You must include a copy of your original request, this letter, and a statement of the reasons why the information should be made available and why this initial denial is in error. Both the letter and the envelope must be clearly marked "Freedom of Information Appeal."

Fee Estimate

Commercial Use Request: As an initial matter, the USPTO has designated your request a commercial use request, which includes, for example, requests intended to further interests through litigation. 37 C.F.R. § 102.11(b)(1). This means you are responsible for all search, review, and duplication fees. 37 C.F.R. § 102.11(c)(1)(i).

Amount: Preliminary estimates indicate that the approximate processing cost for paragraph one of your FOIA request is **\$131, 019.00**. This estimate includes estimated search and review time based on a preliminary assessment of the volume of records potentially responsive to paragraph one of your request and the expected review of these records.

This estimate does not necessarily represent the final cost. Estimates are inherently imprecise, and the final cost could be higher or lower than the amount provided here. However, the estimate provided herein is reasonably calculated to represent search and review costs required to adequately respond to your request. As the search, review, and potential release(s) continue, the USPTO will reassess accurate fees.

Please note that fees are chargeable even when no responsive records are found, or when the records requested are determined to be partially or totally exempt from disclosure. 37 C.F.R. § 102.11(c)(3)(i).

If you are interested in reducing your fees and targeting the USPTO search, we welcome additional discussions about narrowing the scope of your request within the next 30 calendar days.

Payment: Because your estimate exceeds \$250.00, you must pay the entire anticipated fee before the Agency begins processing your request. 37 C.F.R. § 102.11(i)(2).

Please remit, within 30 calendar days of the date of this letter, a check made payable to the "Department of Treasury" in the amount of **\$131, 019.00**. The payment must be sent to:

United States Patent and Trademark Office
Freedom of Information Act Officer
Office of the General Counsel
P.O. Box 1450
Alexandria, VA 22313-1450

If payment in the full amount of the initial estimate is not received by **June 25, 2018**, this request will be considered withdrawn and closed. Please contact us before that date, however, if you would like to discuss your request in order to reformulate it to meet your needs at a reduced cost.

Right to Appeal

You may contact the FOIA Public Liaison at (571) 272-0512 for any further assistance and to discuss any aspect of your request. Additionally, you may contact the Office of Government Information Services (OGIS) at the National Archives and Records Administration to inquire about the FOIA mediation services they offer. The contact information for OGIS is as follows: Office of Government Information Services, National Archives and Records Administration, 8601 Adelphi Road-OGIS, College Park, Maryland 20740-6001, e-mail at ogis@nara.gov; telephone at 202-741-5770; toll free at 1-877-684-6448; or facsimile at 202-741-5769.

As stated above, you have the right to appeal this decision to the Deputy General Counsel, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. An appeal must be received within 90 calendar days from the date of this letter. See 37 C.F.R. § 102.10(a). The appeal must be in writing. You must include a copy of your original request, this letter, and a statement of the reasons why the information should be made available and why this initial denial is in error. Both the letter and the envelope must be clearly marked "Freedom of Information Appeal."

Sincerely,

A handwritten signature in cursive script that reads "Louis J. Boston Jr.".

Louis J. Boston, Jr.
USPTO FOIA Officer
Office of General Law

Exhibit DD

GILBERT P. HYATT,	:	
	:	
Plaintiff,	:	
	:	Civil Action No. 05-2310(RCL)
v.	:	Civil Action No. 09-1864(RCL)
	:	Civil Action No. 09-1869(RCL)
JOSEPH MATAL,	:	Civil Action No. 09-1872(RCL)
	:	ECF
Defendant.	:	

Washington, D.C.

Job 19734

Page 2

Videotaped Deposition of:
 WALTER FREDERICK BRINEY, III,
 called for oral examination by counsel for
 Plaintiff, pursuant to notice, at the office of
 Baker & Hostetler, LLP, Washington Square, Suite
 1100, 1050 Connecticut Avenue, Washington, D.C.,
 before ANN MEDIS, RPR, a Notary Public in and for
 the District of Columbia, beginning at 9:17 a.m.,
 when were present on behalf of the respective
 parties:

Page 3

APPEARANCES
 On behalf of Plaintiff
 BAKER & HOSTETLER, LLP
 BY: MARK A. DELAQUIL, ESQUIRE
 AND PAUL LEVINE, ESQUIRE
 AND RANDAL MEYER, ESQUIRE
 Washington Square
 Suite 1100
 1050 Connecticut Avenue, N.W.
 Washington, D.C. 20003-5304
 202.868.1697
 mdelaquil@bakerlaw.com
 plevine@bakerlaw.com
 rmeyer@bakerlaw.com
 On behalf of Defendant
 UNITED STATES PATENT & TRADEMARK OFFICE
 BY: COKE MORGAN STEWART, ESQUIRE
 600 Dulany Avenue
 Madison West Building 8C43A
 Mail Stop 8
 PO Box 1450
 Alexandria, Virginia 22313-1450
 571.272.7153
 coke.stewart@uspto.gov
 Also present
 Gilbert Hyatt (via conference call)
 Greg Morse, USPTO
 Charlie Widner, Videographer

Page 4

* INDEX *
 WALTER FREDERICK BRINEY, III PAGE
 EXAMINATION BY MR. DELAQUIL 7, 152, 159
 EXAMINATION BY MS. STEWART 139, 158

* INDEX OF BRINEY EXHIBITS *
 NO. DESCRIPTION PAGE
 Exhibit 1 Amended Notice of Deposition 39
 Exhibit 2 Defendant USPTO's Amended 39
 Pretrial Statement
 Exhibit 3 Best Practices in Compact 55
 Resolution
 Exhibit 4 Office Action 61
 PTO4-0041105 - 0041163
 Exhibit 5 Office Action 63
 PTO04-00046363 - 0046441
 Exhibit 6 Email, 5/15/15, from G. Morse to 73
 J. Atala, et al., subject: general
 comments
 PTO16-0001365
 Exhibit 7 Office Action 88
 PTO4-0029527 - 0029782
 Exhibit 8 Email, 9/22/14, from G. Morse to 107
 J. Atala, et al., subject: Case
 tangentially related to your
 applications
 PTO16-0000778
 Exhibit 9 Email chain, 5/6/16, from G. Morse 112
 to J. Atala, et al., subject: FW:
 Activity in Case 1:15-cv-00960
 Hyatt v USPTO

Page 5

* INDEX OF BRINEY EXHIBITS (Continued) *
 NO. DESCRIPTION PAGE
 Exhibit 10 LA Times article, 6/2/93, 119
 "Inventor's Divorce Won't Be
 Renegotiated: Courts: Judge
 Dismisses motion by former La Palma
 man's ex'wife, who wanted to redo
 settlement to give her part of his
 royalties from microprocessor patent"
 Exhibit 11 Email, 3/10/16, from W. Briney to 120
 G. Morse, et al., subject: Hyatt
 Articles from the LA Times
 PTO16-0000740

- - - -

2 (Pages 2 to 5)

Page 6

1 THE VIDEOGRAPHER: This is Tape Number 1
2 of the videotaped deposition of Walter Briney in
3 the matter of Gilbert Hyatt versus Joseph Matal.

4 This deposition is being held at Baker
5 Hostetler located at 1050 Connecticut Avenue
6 Northwest, Suite 1100, Washington D.C. 20036 on
7 September 28, 2017 at approximately 9:17 a.m.

8 My name is Charlie Widner from the firm
9 of TransPerfect Legal Solutions, and I'm the legal
10 specialist. The court reporter today is Ann Medis
11 in association with TransPerfect Legal Solutions.

12 Will counsel please introduce
13 themselves.

14 MR. DELAQUIL: On behalf of plaintiff,
15 Gilbert Hyatt, Mark D. DeLaquil from the law firm
16 of Baker & Hostetler. And Randal Meyer,
17 R-A-N-D-A-L, M-E-Y-E-R, is also sitting in on the
18 deposition but is not participating in it.

19 MS. STEWART: Coke Morgan Stewart on
20 behalf of the defendant, USPTO. And here as our
21 corporate designee is Greg Morse.
22

Page 7

1 WALTER FREDERICK BRINEY, III,
2 having been first duly sworn, was examined
3 and testified as follows:

4 EXAMINATION

5 BY MR. DELAQUIL:

6 Q. Good morning, Mr. Briney.

7 A. Good morning.

8 Q. Would you please state your full name
9 for the record.

10 A. Yes. Walter Frederick Briney, III.

11 Q. Have you ever been deposed before?

12 A. This is my first.

13 Q. Are you aware that the oath that you
14 just took is the same oath that you would take if
15 you were testifying in court today?

16 A. Yes, I know that.

17 Q. Is there any reason you're not capable
18 of giving complete and accurate testimony today?

19 A. No.

20 Q. I'm going to be asking you a series of
21 questions. Some of these questions may involve
22 specific terminology in the context of patent

Page 8

1 prosecution, patent examination, potentially, the
2 underlying technologies.

3 I want to make sure that you understand
4 the questions that I'm asking so that you can give
5 a full and complete answer to those questions.

6 If you don't understand a question,
7 would you please let me know?

8 A. Yes, I will.

9 Q. Thank you.

10 What did you do to prepare for this
11 deposition, if anything?

12 A. Well, I reviewed some emails over the
13 last five-year period, and I talked with Coke, the
14 attorney, and I talked with Greg mostly to get
15 basics on what the procedure will be today.

16 Q. What emails did you review?

17 A. I reviewed emails regarding my work over
18 the last five years handling applications related
19 to the litigation. So I guess you could say Hyatt
20 applications that have been on my docket for the
21 last five years.

22 Q. Do you remember which emails those were?

Page 9

1 A. Yeah. I breezed through all of them, I
2 guess you could say. I looked at the ones that
3 talked about -- let's see. I'm trying to
4 summarize in my head in a cogent way.

5 Basically, all the emails about what to
6 do in a particular situation, questions I had to
7 my supervisors, that kind of thing.

8 Q. Do you know if those emails were
9 produced in discovery in this matter?

10 A. I think some of them were, yes. I'm not
11 exactly sure of what emails were produced. I
12 turned some over. Whether those were produced, I
13 don't know.

14 Q. So you don't know if all the emails that
15 you reviewed in preparation for this deposition
16 were produced?

17 A. No, I do not know.

18 Q. Approximately how many emails did you
19 review?

20 A. Yesterday, I reviewed probably 50
21 emails.

22 Q. Did you review emails to prepare for

3 (Pages 6 to 9)

Page 10	Page 12
<p>1 this deposition before yesterday?</p> <p>2 A. No.</p> <p>3 Q. Without discussing the contents of your</p> <p>4 conversation with Ms. Stewart, when did you meet</p> <p>5 with Ms. Stewart to prepare for this deposition?</p> <p>6 A. At about 8:20 this morning downstairs.</p> <p>7 Q. Had you met Ms. Stewart before 8:20 this</p> <p>8 morning?</p> <p>9 A. I believe I met her once one or two</p> <p>10 years ago at a social gathering.</p> <p>11 Q. When did you meet with Mr. Morse to</p> <p>12 prepare for this deposition?</p> <p>13 A. At the same time that I met with Coke</p> <p>14 this morning.</p> <p>15 Q. Had you discussed your deposition today</p> <p>16 with Mr. Morse?</p> <p>17 A. Yes. I did speak with him earlier this</p> <p>18 week when they first approached me about the</p> <p>19 possibility of testifying and giving a deposition.</p> <p>20 They said, you know, you'll be basically</p> <p>21 asked to --</p> <p>22 MS. STEWART: Okay. I'm just going to</p>	<p>1 information to the witness.</p> <p>2 And to the extent he was communicating</p> <p>3 on my behalf, I would probably assert privilege</p> <p>4 over that, but it depends on the question.</p> <p>5 MR. DELAQUIL: That's fine. We'll take</p> <p>6 it question by question then.</p> <p>7 BY MR. DELAQUIL:</p> <p>8 Q. Are you aware that Mr. Morse was</p> <p>9 previously deposed in this matter?</p> <p>10 A. Yes.</p> <p>11 Q. Did you discuss Mr. Morse's deposition</p> <p>12 with him?</p> <p>13 A. No, I did not.</p> <p>14 Q. Did you have any conversations with</p> <p>15 Mr. Morse in anticipation of this deposition that</p> <p>16 were outside the presence of Ms. Stewart?</p> <p>17 A. Yes. As I mentioned, he called me about</p> <p>18 the possibility of testifying, and then he</p> <p>19 called -- I don't remember exactly if he called me</p> <p>20 the next day or whatever, but we did talk about</p> <p>21 that I was going to be deposed.</p> <p>22 Q. How long did that conversation last?</p>
Page 11	Page 13
<p>1 object here and caution the witness not to discuss</p> <p>2 the details of the communication.</p> <p>3 But when we spoke and those kinds of</p> <p>4 high-level questions, you can answer.</p> <p>5 MR. DELAQUIL: To clarify, Ms. Stewart,</p> <p>6 is it your position that those conversations are</p> <p>7 work product or attorney/client privileged?</p> <p>8 MS. STEWART: My communications with the</p> <p>9 witness -- I think he was going to get into some</p> <p>10 of our discussions.</p> <p>11 MR. DELAQUIL: Okay.</p> <p>12 MS. STEWART: So portions of them may</p> <p>13 be; portions may not.</p> <p>14 MR. DELAQUIL: I just want to be clear.</p> <p>15 Certainly, I don't want to ask about the</p> <p>16 conversations -- the content of conversations that</p> <p>17 you had with Mr. Briney, but I want to know</p> <p>18 whether you're asserting any privilege as to</p> <p>19 communications that Mr. Briney had with</p> <p>20 nonattorney personnel with PTO.</p> <p>21 MS. STEWART: I guess it depends on the</p> <p>22 question. I mean, I did ask Greg to convey</p>	<p>1 A. I don't know. 10, 20 minutes, somewhere</p> <p>2 in that timeframe.</p> <p>3 Q. Did you discuss the substance of the</p> <p>4 PTO's examination of Mr. Hyatt's applications in</p> <p>5 that conversation?</p> <p>6 A. Did I discuss the substance of their --</p> <p>7 can you repeat it?</p> <p>8 Q. I'll ask a different question.</p> <p>9 During the conversation you just</p> <p>10 referenced, the 10- to 20-minute conversation with</p> <p>11 Mr. Morse over the phone, did you discuss</p> <p>12 Mr. Hyatt's patent applications with Mr. Morse?</p> <p>13 A. Yes, because that's the matter that I'm</p> <p>14 being deposed about.</p> <p>15 Q. What did Mr. Morse tell you?</p> <p>16 MS. STEWART: Okay. I'm going to object</p> <p>17 to the question because I had asked Mr. Morse to</p> <p>18 speak to the witness to give him some background</p> <p>19 information to prepare for the deposition.</p> <p>20 So to the extent I am asking Greg to</p> <p>21 advise the witness and give him some information</p> <p>22 to understand what the subject matter is of the</p>

4 (Pages 10 to 13)

<p style="text-align: right;">Page 14</p> <p>1 deposition and that kind of thing, that's 2 objectionable.</p> <p>3 And to the extent Mr. Morse supervises 4 Mr. Briney on the examination of individual 5 applications, that is potentially privileged 6 material.</p> <p>7 So the substance of the communications 8 between those two, I'm going to instruct the 9 witness not to answer.</p> <p>10 MR. DELAQUIL: So to clarify, are you 11 instructing the witness not to answer my question 12 about the substance of conversations that he had 13 with Mr. Morse to prepare for this deposition 14 today?</p> <p>15 MS. STEWART: To the extent I instructed 16 Mr. Morse, the information to share with the 17 witness so he understood the subject matter of the 18 litigation and what the issues were in the 19 litigation, Greg was acting on my behalf, and I am 20 objecting to that.</p> <p>21 Moreover, to the extent as a supervisor, 22 Mr. Morse supervises Mr. Briney in the examination</p>	<p style="text-align: right;">Page 16</p> <p>1 it's handled, it's not subject to discovery, 2 that's potentially predecisional, so...</p> <p>3 MR. DELAQUIL: I think my question was 4 broader than that.</p> <p>5 And I'll ask the court reporter to 6 restate it for the record, and then you can 7 determine whether you want to make that objection 8 again.</p> <p>9 MS. STEWART: Well, it was broad and 10 that's why I couldn't have the witness answer, 11 because it was so broad. It basically asks 12 anything Greg had talked about with Mr. Briney 13 so -- to prepare for the deposition.</p> <p>14 MR. DELAQUIL: It was actually to do 15 with patent applications.</p> <p>16 MS. STEWART: Right.</p> <p>17 MR. DELAQUIL: Are you instructing the 18 witness not to answer that question? I just want 19 to confirm.</p> <p>20 MS. STEWART: Okay. That very broad 21 open-ended question about everything discussed, 22 yes, I'm objecting to that.</p>
<p style="text-align: right;">Page 15</p> <p>1 of these applications, that's -- that's an area 2 that doesn't have very bright lines and I don't 3 want to have any kind of waiver situation about 4 specific discussions of specific applications.</p> <p>5 MR. DELAQUIL: I understand.</p> <p>6 Well, to clarify, I understand the basis 7 of an attorney/client privileged and/or attorney 8 work product objection regarding the information 9 you that directed Mr. Morse to convey to 10 Mr. Briney. I'm unclear as to what specific 11 privilege you are asserting as to the latter 12 material. Would you please state it on the 13 record.</p> <p>14 MS. STEWART: I think it sounded like 15 you were asking about very specific information on 16 a specific application that Mr. Morse and 17 Mr. Briney had discussed.</p> <p>18 And, I mean, we could go off the record, 19 and I could get a little bit more information from 20 the witness. But if it's information I asked Greg 21 to convey, then it would be privileged. And if 22 it's information about a specific application, how</p>	<p style="text-align: right;">Page 17</p> <p>1 If you have a more narrow question, that 2 might not be objectionable.</p> <p>3 BY MR. DELAQUIL:</p> <p>4 Q. Will you follow your counsel's 5 instruction?</p> <p>6 A. Yes, I will.</p> <p>7 Q. Did you discuss any specific patent 8 applications of Mr. Hyatt's with Mr. Morse during 9 the 10- to 20-minute call in preparation for this 10 deposition?</p> <p>11 A. No, I did not.</p> <p>12 Q. Did you discuss Mr. Hyatt's patent 13 applications generally with Mr. Morse during that 14 call?</p> <p>15 A. I don't remember everything discussed. 16 So I -- I can't answer that question.</p> <p>17 Q. Is that answer that you don't recall 18 what you discussed with Mr. Morse?</p> <p>19 A. Well, I don't recall if we -- I mean, I 20 guess to the extent that this is all about Hyatt's 21 applications, we talked about them generally. But 22 I don't remember the details of what we talked</p>

Page 18

1 about.

2 Q. What did Mr. Morse say generally about
3 Mr. Hyatt's applications on that call?

4 MS. STEWART: I'm objecting because I
5 specifically, as I stated on the record,
6 instructed Mr. Morse to convey some background
7 information about the litigation to the witness
8 about the case and, therefore, he's communicating
9 on my behalf to the witness.

10 So the substance of the specific
11 conversation that Mr. Morse had at my direction
12 with the witness to prepare for -- this limited
13 preparation for this last-minute deposition would
14 be privileged.

15 MR. DELAQUIL: You're claiming
16 privileges to the entire substance of that
17 conversation? Is that your position?

18 MS. STEWART: Well, Mr. Morse was
19 communicating on my behalf. So I instructed him
20 to convey certain information to the witness. And
21 that simply because I wasn't on the phone doesn't
22 mean that information that I asked Mr. Morse to

Page 19

1 convey is discoverable.

2 Why don't we move on and you can ask the
3 witness some questions and not --

4 MR. DELAQUIL: Let's go off the record
5 for a minute, please.

6 MS. STEWART: Okay.

7 THE VIDEOGRAPHER: We're going off the
8 record at 9:39 a.m.

9 (There was a discussion off the record.)

10 THE VIDEOGRAPHER: We're going back on
11 the record at 9:23 a.m.

12 BY MR. DELAQUIL:

13 Q. Mr. Briney, I previously asked you about
14 the substance of a conversation you had with
15 Mr. Morse in preparation for this deposition.

16 We just went off the record, and
17 Ms. Stewart informed me that the PTO would be
18 asserting privilege as to the entire substance of
19 that conversation, if my understanding of our
20 off-the-record conversation is correct.

21 MR. DELAQUIL: Ms. Stewart; is that
22 correct?

Page 20

1 MS. STEWART: I don't think it's
2 correct. I think the witness has already provided
3 ample responses to your question about the
4 deposition prep and who he talked to and when and
5 the subject matter that was discussed and the
6 logistics and the applications generally and that
7 no specific applications were discussed. So I
8 think the witness has given an answer.

9 To the extent you want to continue
10 probing, then, yes, I'm going to object because
11 the very brief conversation was had at my
12 direction. I gave Mr. Morse specific information
13 to convey to the witness to facilitate the
14 scheduling of the deposition.

15 So I -- I am not aware of any further
16 discoverable information that could be obtained
17 from this line of questioning.

18 So I instruct the witness not to answer.

19 BY MR. DELAQUIL:

20 Q. Will you follow your counsel's
21 instructions?

22 A. I will.

Page 21

1 Q. Thank you.

2 Please state your educational
3 background --

4 A. Okay.

5 Q. -- starting with college.

6 A. Well, I attended the University of
7 Wisconsin in Madison. I obtained a bachelor of
8 science degree in computer engineering, and I also
9 have a law degree from the George Mason University
10 and I'm a member of the Virginia state bar.

11 Q. When did you graduate with your BA in
12 computer engineering from the University of
13 Wisconsin?

14 A. Bachelor of science, if I misspoke.

15 I graduated in 2003.

16 Q. When did you receive your law degree
17 from George Mason University?

18 A. 2011.

19 Q. When were you admitted to the Virginia
20 state bar?

21 A. Forgive me if I don't remember the exact
22 detail. I believe it was 2011, toward the -- I

6 (Pages 18 to 21)

Page 22	Page 24
<p>1 don't remember what month. It was towards the end 2 of the year.</p> <p>3 Q. When were you first employed by the 4 Patent and Trademark Office?</p> <p>5 A. I began work right after undergrad. So 6 I started June 30, 2003.</p> <p>7 Q. Have you been employed by the Patent and 8 Trademark Office since then?</p> <p>9 A. I have.</p> <p>10 Q. Any breaks in your employment with the 11 Patent and Trademark Office?</p> <p>12 A. No.</p> <p>13 Q. What was your first position with the 14 Patent and Trademark Office?</p> <p>15 A. I began as a patent examiner, what they 16 called a junior patent examiner. That's what most 17 people enter as.</p> <p>18 Q. That was on June 30, 2003?</p> <p>19 A. Correct.</p> <p>20 Q. Have you subsequently had any positions 21 with the Patent and Trademark Office?</p> <p>22 A. I have been promoted to primary patent</p>	<p>1 prior art searches. They follow all the governing 2 laws and regulations.</p> <p>3 The big limit on being a junior examiner 4 is you are not authorized to sign your own work. 5 So if you want to send it out the door, it has to 6 be reviewed by a primary patent examiner.</p> <p>7 Q. How do the responsibilities of a primary 8 patent examiner differ from those of a junior 9 patent examiner?</p> <p>10 A. They differ because there is more 11 authority. You are free to sign your own work. 12 If you want to send out a nonfinal rejection, a 13 final rejection, an allowance, these kinds of 14 things, or a notice of abandonment, all these 15 things can be signed without any level of direct 16 review by another primary or a supervisor.</p> <p>17 Q. Are those the only way that the 18 responsibilities of a primary examiner differ from 19 those of a junior examiner?</p> <p>20 A. No. There's more -- there's 21 responsibilities that comes with that authority. 22 You are expected to check your own work, and it</p>
Page 23	Page 25
<p>1 examiner.</p> <p>2 Q. When was that?</p> <p>3 A. That was -- I'm going to have to 4 ballpark. I think it was around 2008.</p> <p>5 Q. Did you hold any positions in between 6 junior patent examiner and primary patent 7 examiner?</p> <p>8 A. No. That was continuous.</p> <p>9 Q. Are you currently a primary patent 10 examiner?</p> <p>11 A. I am currently a primary patent 12 examiner.</p> <p>13 Q. What are the responsibilities of a 14 junior patent examiner?</p> <p>15 A. Of a junior patent examiner?</p> <p>16 Q. Yes.</p> <p>17 A. Basically, they perform the patent 18 examining function. They take in new 19 applications. They review their substance and 20 their form to ensure they are -- the application 21 is in condition for becoming a patent. 22 They write office actions. They do</p>	<p>1 can be reviewed as part of your performance 2 appraisal plan.</p> <p>3 Q. Are you assigned more patents as a 4 primary examiner than a junior examiner to 5 examine?</p> <p>6 A. Well, there's usually a commensurate 7 step up in your -- your GS level. So you're a 8 higher level and with that there's usually a 9 higher expectation, your performance factor 10 changes.</p> <p>11 So yes, you are expected in a certain 12 amount of time to do more units of work.</p> <p>13 Q. You've been a primary patent examiner 14 since 2008; correct?</p> <p>15 A. That is correct.</p> <p>16 Q. In the time before you joined Art Unit 17 2615, approximately how many patent applications 18 were assigned to you at an individual time, at a 19 single time?</p> <p>20 A. My docket -- it's been a while so my 21 memory is a little fuzzy about that detail. I 22 would say it is about a hundred. I probably had</p>

7 (Pages 22 to 25)

Page 26

1 about hundred live applications that I would
2 juggle and some of those would be things that
3 were -- but it depends because it depends on your
4 supervisor, how many new cases they like to put on
5 your docket at any one moment in time.

6 So you would have new applications and
7 amended or -- or -- yeah, amended applications and
8 then applications that you're waiting for a
9 response to come in.

10 So you could have anywhere as low as 50
11 to as high as a hundred applications that you're
12 juggling at a given time.

13 Q. Do you work at the US Patent and
14 Trademark Office physically?

15 A. I'm a hoteling employee.

16 Q. What's a hoteling employee?

17 A. I'm a hoteling employee, which means
18 that my official duty station is not at the Patent
19 Office headquarters. I work from my house.

20 Q. Do you live in the Washington D.C.
21 metropolitan area?

22 A. Yes, I do.

Page 27

1 Q. Approximately how often do you work at
2 Patent and Trademark Office?

3 A. Since the new rules have come in, I
4 never have to go into work only for special
5 occasions like today or if there is all-hands
6 meeting, but that's once a year.

7 Q. How does the Patent and Trademark Office
8 know when you are working if you're not physically
9 present in the office?

10 A. Well, they have a number of tools. They
11 have -- well, first of all, there's email and
12 phone. You have to be present at your desk to
13 receive a phone call, obviously, respond to
14 instant messages.

15 We also have a messenger protocol and
16 email, and there are time limits on when you're
17 expected to turn around that information.

18 The instant message program also has a
19 presence indicator saying whether you're sitting
20 at your desk working or not.

21 And there's also a new system that looks
22 at log in/log off timings.

Page 28

1 Q. Do you specifically sign in and sign out
2 to work?

3 A. Yes.

4 Q. What program do you use?

5 A. I'm not familiar with the name of the
6 program. As far as I understand it, it's when I
7 log into the computer itself.

8 Q. So your understanding is when you log
9 into the computer itself that the computer
10 transmits that information to the PTO for its
11 records?

12 A. That's my understanding.

13 Q. Do you record the time that you were
14 working on each individual patent application?

15 A. No.

16 Q. Do you receive a biweekly docket
17 examination report?

18 A. I do.

19 Q. What information is on that report?

20 A. It tracks every transaction particularly
21 my outgoing office actions and communications.

22 Q. Does that report tell you which

Page 29

1 applications you're expected to work on?

2 A. I do get a report of when things are
3 expected to be done.

4 Q. What's that report called?

5 A. I don't know that it has a name. I
6 guess my biweekly production report.

7 Q. Who sends you that report?

8 A. It's an automated report.

9 Q. Do you remember the email address it
10 comes from?

11 A. It's in a program.

12 Q. A program?

13 A. It's a program called DAV, D-A-V,
14 Docket & Application Viewer.

15 Q. How long have you received reports from
16 DAV?

17 A. DAV is a relatively new program. Before
18 that, we had eDAN. Before that, I'm sure we had
19 something, but I don't remember all those
20 programs.

21 Q. Since 2012, has it been DAV?

22 A. Mostly DAV. We also used eDAN for a

8 (Pages 26 to 29)

<p style="text-align: right;">Page 30</p> <p>1 time. There was a transition.</p> <p>2 Q. Are you assigned as an examiner to a</p> <p>3 specific area of art?</p> <p>4 A. Well, currently -- I -- I assume you're</p> <p>5 asking me currently?</p> <p>6 Q. Let's do currently.</p> <p>7 A. Currently, my docket is assigned to</p> <p>8 these Hyatt cases, and I work particularly on a</p> <p>9 subset that shares the same spec -- specification.</p> <p>10 Q. What specification is that?</p> <p>11 A. I believe the parent specification is</p> <p>12 Application 05/849,812.</p> <p>13 Q. That's Docket No. 145?</p> <p>14 A. Is that the docket Hyatt?</p> <p>15 Q. Yes.</p> <p>16 A. Okay.</p> <p>17 Q. Do you know that?</p> <p>18 A. We use our own internal numbering</p> <p>19 system. So I'm not always comfortable with the --</p> <p>20 the attorney docket number.</p> <p>21 Q. Do you use the serial number as your own</p> <p>22 internal numbering system?</p>	<p style="text-align: right;">Page 32</p> <p>1 A. No.</p> <p>2 Q. Are you currently assigned to Art Unit</p> <p>3 2615?</p> <p>4 A. I am.</p> <p>5 Q. Have you ever heard it referred to as</p> <p>6 the Hyatt unit?</p> <p>7 A. Yes.</p> <p>8 Q. Have you ever heard it referred to as</p> <p>9 the bulk filers unit?</p> <p>10 A. No.</p> <p>11 Q. Does the unit examine patents other than</p> <p>12 Mr. Hyatt's patent applications?</p> <p>13 A. Yes.</p> <p>14 Q. To the best of your knowledge,</p> <p>15 approximately how many by percentage of the</p> <p>16 applications assigned to Art Units 2615 are</p> <p>17 Mr. Hyatt's patent applications?</p> <p>18 A. How many by percentage?</p> <p>19 Q. To the best of your knowledge.</p> <p>20 A. 90 percent.</p> <p>21 Q. During your time at Art Unit 2615, have</p> <p>22 you been assigned to a patent application by</p>
<p style="text-align: right;">Page 31</p> <p>1 A. Yes.</p> <p>2 Q. Does what you call the 8112 [sic]</p> <p>3 specification -- what is the 8112 specification,</p> <p>4 as you understand it?</p> <p>5 A. I believe you mean the 812?</p> <p>6 Q. Yeah, 812.</p> <p>7 A. Or 812.</p> <p>8 Q. 812, yeah.</p> <p>9 A. The 812 specification -- are you asking</p> <p>10 what I believe the subject matter is?</p> <p>11 Q. Yes.</p> <p>12 A. I believe the subject matter is digital</p> <p>13 audio processing.</p> <p>14 Q. Before being assigned to the 812</p> <p>15 specification, had you ever been assigned to</p> <p>16 digital audio processing before?</p> <p>17 A. Yes. I worked in Class 700, Sub Class</p> <p>18 94, and that was a unit specifically designed to</p> <p>19 examine digital audio processing patent</p> <p>20 applications.</p> <p>21 Q. Was that unit specifically designed to</p> <p>22 examine Mr. Hyatt's patent applications?</p>	<p style="text-align: right;">Page 33</p> <p>1 anyone other than Mr. Hyatt?</p> <p>2 A. Can you repeat that? Sorry.</p> <p>3 Q. During your time at Art Unit 2615, have</p> <p>4 you been assigned as the examiner to a patent</p> <p>5 application whose applicant was someone other than</p> <p>6 Mr. Hyatt?</p> <p>7 A. I have.</p> <p>8 Q. Approximately how many of such</p> <p>9 applications have you been assigned to during your</p> <p>10 time at Art Unit 2615?</p> <p>11 A. Four.</p> <p>12 Q. Are you currently examining any patent</p> <p>13 applications by an applicant other than Mr. Hyatt?</p> <p>14 A. I am.</p> <p>15 Q. How many?</p> <p>16 A. Four.</p> <p>17 Q. Do you recall the serial number of the</p> <p>18 applications that you are assigned to that</p> <p>19 Mr. Hyatt has submitted?</p> <p>20 A. I remember a good number of them.</p> <p>21 Q. Why don't I read them off and you can</p> <p>22 confirm whether you're assigned to that</p>

Page 34	Page 36
<p>1 application.</p> <p>2 Application Serial No. 05/302,771?</p> <p>3 A. Yes, I am assigned to that.</p> <p>4 Q. Application Serial No. 08/479,097?</p> <p>5 A. That sounds familiar.</p> <p>6 Q. Do you know if you're assigned as the</p> <p>7 examiner on that application?</p> <p>8 A. Yes, I believe I am.</p> <p>9 Q. Application Serial No. 08/483,011?</p> <p>10 A. Yes.</p> <p>11 Q. Application Serial No. 08/470,859?</p> <p>12 A. Yes.</p> <p>13 Q. Application Serial No. 08/486,151?</p> <p>14 A. Yes.</p> <p>15 Q. Application Serial No. 08/472,041?</p> <p>16 A. Yes.</p> <p>17 Q. Application Serial No. 08/471,810?</p> <p>18 A. Yes.</p> <p>19 Q. Application Serial No. 08/470,666?</p> <p>20 A. Yes.</p> <p>21 Q. Application Serial No. 08/470,856?</p> <p>22 A. Yes.</p>	<p>1 Q. Application Serial No. 08/471,795?</p> <p>2 A. Put a question next to that one, please.</p> <p>3 Q. Application Serial No. 08/471,062?</p> <p>4 A. That one as well.</p> <p>5 Q. Application Serial No. 08/471,434?</p> <p>6 A. I think that's a yes.</p> <p>7 Q. So of the application serial numbers</p> <p>8 you've testified you're the examiner on, are you</p> <p>9 familiar with the file histories?</p> <p>10 A. Yes. But maybe not from the very</p> <p>11 beginning. I'd have to look at the file histories</p> <p>12 to refresh my memory.</p> <p>13 Q. At some point, have you read the</p> <p>14 complete file histories of each of the</p> <p>15 applications that's been assigned to you of</p> <p>16 Mr. Hyatt's?</p> <p>17 A. Yes. When I take it up for action, I</p> <p>18 read it.</p> <p>19 Q. Have you reviewed any of your Hyatt's</p> <p>20 patent applications where you have not been</p> <p>21 assigned as the examiner?</p> <p>22 A. Can you repeat that?</p>
Page 35	Page 37
<p>1 Q. Application Serial No. 08/472,031?</p> <p>2 A. Yes.</p> <p>3 Q. Application Serial No. 08/470,898?</p> <p>4 A. Yes.</p> <p>5 Q. Application Serial No. 08/469,528?</p> <p>6 A. Yes.</p> <p>7 Q. Application Serial No. 08/470,898?</p> <p>8 A. Yes.</p> <p>9 Q. Application Serial No. 08/469,528?</p> <p>10 A. Yes.</p> <p>11 Q. Application Serial No. 08/471,932?</p> <p>12 A. That one doesn't sound familiar.</p> <p>13 MS. STEWART: If it helps, and it's a</p> <p>14 matter of public record, we can probably stipulate</p> <p>15 as to which ones he was and wasn't working on.</p> <p>16 MR. DELAQUIL: We're almost done.</p> <p>17 MS. STEWART: Okay.</p> <p>18 BY MR. DELAQUIL:</p> <p>19 Q. Application Serial No. 08/470,665?</p> <p>20 A. Yes.</p> <p>21 Q. Application Serial No. 08/472,032?</p> <p>22 A. Yes.</p>	<p>1 Q. Have you reviewed any of Mr. Hyatt's</p> <p>2 patent applications where you have not been</p> <p>3 assigned as the examiner?</p> <p>4 A. Yes.</p> <p>5 Q. Which ones?</p> <p>6 A. I don't know any specific application</p> <p>7 numbers.</p> <p>8 Q. Do you remember specific subject matter?</p> <p>9 A. Well, maybe I can get at it this way. I</p> <p>10 do review applications from my peers.</p> <p>11 Q. Do you discuss those applications with</p> <p>12 your peers?</p> <p>13 A. Yes. It's part my function as a</p> <p>14 primary.</p> <p>15 Q. Are there junior examiners assigned to</p> <p>16 Art Unit 2615?</p> <p>17 A. No.</p> <p>18 Q. Do primary patent examiners typically</p> <p>19 review the work of other primary patent examiners?</p> <p>20 A. Yes.</p> <p>21 Q. In group 2615?</p> <p>22 A. Yes.</p>

10 (Pages 34 to 37)

<p style="text-align: right;">Page 38</p> <p>1 Q. In other art units that you've been a</p> <p>2 part of?</p> <p>3 A. Any time someone asks me for help, I'm</p> <p>4 available.</p> <p>5 Q. Do you review the work of other primary</p> <p>6 examiners in group 2615 in instances other where</p> <p>7 they ask you for help?</p> <p>8 A. In 2615?</p> <p>9 Q. Yes.</p> <p>10 A. Yes.</p> <p>11 Q. What about in other art units you've</p> <p>12 been a part of?</p> <p>13 A. No.</p> <p>14 Q. Do you have any employees who report to</p> <p>15 you as part of your job responsibilities?</p> <p>16 A. No.</p> <p>17 Q. How many direct supervisors do you have?</p> <p>18 A. Just one.</p> <p>19 Q. Who is that?</p> <p>20 A. Greg Morse.</p> <p>21 Q. Sitting in this room today?</p> <p>22 A. Yes.</p>	<p style="text-align: right;">Page 40</p> <p>1 BY MR. DELAQUIL:</p> <p>2 Q. Mr. Briney, are you familiar with this</p> <p>3 document.</p> <p>4 (Witness reviewed the exhibit.)</p> <p>5 THE WITNESS: No, I am not.</p> <p>6 BY MR. DELAQUIL:</p> <p>7 Q. Your answer was no, I am not?</p> <p>8 Will you please turn to page 5 of</p> <p>9 Exhibit Briney 2. Is your name located on page 5?</p> <p>10 A. Yes.</p> <p>11 Q. Do you see next to it where it says:</p> <p>12 Mr. Briney will testify about examination, policy</p> <p>13 and guidance regarding Mr. Hyatt's applications?</p> <p>14 A. Yes.</p> <p>15 Q. What's your understanding of the term</p> <p>16 "examination policies and guidance"?</p> <p>17 A. Well, just that phrase, "examination</p> <p>18 policy and guidance"?</p> <p>19 Q. Yes.</p> <p>20 A. To me, examination policy and guidance</p> <p>21 is any official statement about what the office</p> <p>22 should do in a situation or suggested procedure.</p>
<p style="text-align: right;">Page 39</p> <p>1 MR. DELAQUIL: Would you please mark</p> <p>2 this as Exhibit Briney 1.</p> <p>3 (Briney Exhibit 1 was marked.)</p> <p>4 BY MR. DELAQUIL:</p> <p>5 Q. Mr. Briney, the court reporter has just</p> <p>6 handed you an exhibit marked Briney 1.</p> <p>7 Have you ever seen this document before?</p> <p>8 (Witness reviewed the exhibit.)</p> <p>9 THE WITNESS: No, I have not.</p> <p>10 BY MR. DELAQUIL:</p> <p>11 Q. I'll represent to you that this is an</p> <p>12 Amended Notice of Deposition for your</p> <p>13 participation today at this deposition.</p> <p>14 Do you understand the PTO has designated</p> <p>15 you on its amended witness list for trial in this</p> <p>16 matter?</p> <p>17 A. Yes, I believe so.</p> <p>18 MR. DELAQUIL: Could you give me the PTO</p> <p>19 amended witness list, please.</p> <p>20 Would you please mark this as Briney</p> <p>21 Exhibit 2.</p> <p>22 (Briney Exhibit 2 was marked.)</p>	<p style="text-align: right;">Page 41</p> <p>1 It might not be the best in all cases, but a</p> <p>2 general procedure to follow.</p> <p>3 Q. What's your understanding of an official</p> <p>4 statement?</p> <p>5 A. An official statement, to me, the</p> <p>6 most -- best example is something in the MPEP or</p> <p>7 something in the -- the Federal Register.</p> <p>8 Q. Do you consider any directions given to</p> <p>9 you by Mr. Morse regarding the examination</p> <p>10 policies and guidance to be official statements?</p> <p>11 A. I mean, it depends on how much of a</p> <p>12 decree it is. If he says, you must do this, then</p> <p>13 I would say that's an official policy and</p> <p>14 statement him being my supervisor.</p> <p>15 But usually there would have to be some</p> <p>16 back and forth there. I would say, Greg, I need</p> <p>17 to know what to do in this situation and he would</p> <p>18 say, this is what you need to do in this</p> <p>19 situation.</p> <p>20 Q. Do you know what Mr. Morse's technical</p> <p>21 background is?</p> <p>22 A. I have a little familiarity with it.</p>

11 (Pages 38 to 41)

Page 42

1 We've talked about it.

2 Q. What is it, to the best of your
3 knowledge?

4 A. I believe he has a bachelor of science
5 in mechanical engineering and a master's in
6 computer science. I'm not sure of his work
7 experience.

8 But I do know he's been at the Patent
9 Office a long time and working at the Patent
10 Office is a form of technical experience. You're
11 exposed to a lot of technology.

12 Q. I believe you testified your area of art
13 is digital audio processing?

14 A. That's one area of my expertise, yes.

15 Q. That's the expertise that you are
16 bringing to bear on Mr. Hyatt's patent
17 applications and examination?

18 A. That's part of it, yes.

19 Q. Do you know if Mr. Morse has that
20 expertise?

21 A. In digital audio processing?

22 Q. Yes.

Page 43

1 A. I'm unfamiliar with his background in
2 digital audio processing. But computer science is
3 related general terms.

4 Q. Could anyone with a computer science
5 background work in the area of art of digital
6 audio processing?

7 MS. STEWART: Objection. Calls for
8 speculation.

9 THE WITNESS: Do you mean -- when you
10 say work in that area, do you mean as an examiner?
11 BY MR. DELAQUIL:

12 Q. Yes.

13 A. As an examiner, I think if you have --
14 if you take the time to learn it, you need that
15 background. The computer science background, I
16 have a computer engineering background.

17 I didn't go to school to study digital
18 audio processing, but you learn the basic skills.
19 The basic skill set allows to you gain entry into
20 that world. You immerse yourself in the prior art
21 and learn quite a bit about it.

22 Q. So you had to take the time to learn.

Page 44

1 If you're a lawyer, the same way a lawyer might
2 need to take the time to learn patent law?

3 MS. STEWART: Objection. Compound.
4 Misstates the witness's testimony.

5 BY MR. DELAQUIL:

6 Q. I'm just trying to gain an understanding
7 how you view someone with a computer science
8 background would learn digital audio processing.

9 How did you learn digital audio
10 processing?

11 A. I learned it from -- well, personal
12 interest, playing around with computers my whole
13 life, but also working at the Patent Office and
14 reading prior art, reading applications, thinking
15 about the subject matter.

16 Q. The term I previously asked you about
17 "examination policy and guidance," do you
18 understand there to be a difference between
19 examination policy and guidance or do you
20 understand that to be one term?

21 MS. STEWART: Objection. Asked and
22 answered.

Page 45

1 BY MR. DELAQUIL:

2 Q. You can answer.

3 A. So I think you're saying is it like one
4 umbrella term or can it be split up into parts?

5 Q. Do you understand it as one umbrella
6 term?

7 A. No. I parse it as policy guidance.

8 Q. Sure.

9 How do you understand the difference
10 between "policy" and "guidance"?

11 MS. STEWART: Objection. Asked and
12 answered.

13 BY MR. DELAQUIL:

14 Q. You can answer.

15 A. I understand I'll start with guidance.
16 That's, to me, the easier one. Guidance is more,
17 hey, we started to see something develop.

18 I'll give by way of example, it might
19 help. Recently, there have been developments in
20 the area of 101 law, the Alice case. And so the
21 Patent Office has guidance on that. They say,
22 here's examination guidance. They use the term.

12 (Pages 42 to 45)

Page 46	Page 48
<p>1 And this is what we think the case stands for.</p> <p>2 Here's some best practices to comply with it.</p> <p>3 Policy, I think, has a more</p> <p>4 definitive -- there's something more -- it's more</p> <p>5 of a decree, less of, hey, this is where we're</p> <p>6 thinking and more like, we've given it more</p> <p>7 considered thought, and we think absent</p> <p>8 extenuating circumstances, you should go about</p> <p>9 doing things this way. But that had been passed</p> <p>10 through a more formal -- there's also a</p> <p>11 procedure -- probably more formal procedure</p> <p>12 involved that goes behind policy than guidance.</p> <p>13 Q. You mentioned Alice. You're talking</p> <p>14 patentable subject matter?</p> <p>15 A. Yes. That was just an example of like</p> <p>16 one area where I know there's been guidance.</p> <p>17 Q. Sure.</p> <p>18 And so to your understanding, guidance</p> <p>19 are written guidance provided by the Patent and</p> <p>20 Trademark Office?</p> <p>21 A. Yes.</p> <p>22 Q. Do you understand any other type of</p>	<p>1 A. Again, I would say maybe more on the</p> <p>2 advice side of the column.</p> <p>3 Q. Advice is not on Exhibit Briney 2 next</p> <p>4 to your name?</p> <p>5 MS. STEWART: I'm just going to object</p> <p>6 to your line of questioning because the witness</p> <p>7 isn't familiar with the document. Stated he</p> <p>8 didn't write it. He's never seen it before.</p> <p>9 And to the extent you're trying to make</p> <p>10 a connection between the witness's viewpoint of</p> <p>11 certain terminology that's used by the lawyers to</p> <p>12 cabin his testimony, I object to the line of</p> <p>13 questioning.</p> <p>14 MR. DELAQUIL: No speaking objections,</p> <p>15 Counsel.</p> <p>16 BY MR. DELAQUIL:</p> <p>17 Q. What examination policies apply in the</p> <p>18 examination of Mr. Hyatt's patent applications?</p> <p>19 A. All the general policies that we apply</p> <p>20 to every application.</p> <p>21 Q. What do you mean by "the general</p> <p>22 policies that we apply to every patent</p>
Page 47	Page 49
<p>1 material to be guidance within the term or as that</p> <p>2 term is used in Exhibit Briney 2?</p> <p>3 A. Well, I mean, guidance is a very broad</p> <p>4 term. So it could be understood simply as, hey,</p> <p>5 what do you think I should do here.</p> <p>6 And the answer that comes from that</p> <p>7 could be considered guidance.</p> <p>8 Q. So you would consider guidance to be</p> <p>9 direction that Mr. Morse has provided to you in</p> <p>10 the context of an individual patent application?</p> <p>11 A. You know, it depends. Again, it depends</p> <p>12 on the question, how I phrased it to him. If I'm</p> <p>13 saying, hey, I'm ping-ponging back and forth</p> <p>14 between this and this.</p> <p>15 If he says, consider -- have you</p> <p>16 considered all these factors, I don't consider</p> <p>17 that guidance. That's more just friendly advice.</p> <p>18 Guidance would be more like -- well, I</p> <p>19 guess I answered your question.</p> <p>20 Q. Have you received guidance from</p> <p>21 Mr. Morse in the context of individual patent</p> <p>22 applications?</p>	<p>1 application"?</p> <p>2 A. The MPEP is a good example.</p> <p>3 Q. Anything other than the MPEP?</p> <p>4 A. Statutes, MPEP. That's all I'm aware</p> <p>5 of.</p> <p>6 Q. Are you aware of any examination</p> <p>7 policies that apply to Mr. Hyatt's patent</p> <p>8 applications that do not apply to the applications</p> <p>9 from other patent applicants?</p> <p>10 MS. STEWART: Objection. Calls for</p> <p>11 speculation.</p> <p>12 THE WITNESS: I don't -- I don't know.</p> <p>13 BY MR. DELAQUIL:</p> <p>14 Q. Is your answer -- I want to make sure I</p> <p>15 understand what "I don't know" means.</p> <p>16 Are you saying you don't know whether</p> <p>17 there are examination policies that apply to</p> <p>18 Mr. Hyatt's patent applications that do not apply</p> <p>19 to other patents applicant's applications?</p> <p>20 A. That's correct, yes. I don't know.</p> <p>21 Q. Do you know what examination policies</p> <p>22 other patent examiners assigned to Mr. Hyatt's</p>

13 (Pages 46 to 49)

<p style="text-align: right;">Page 50</p> <p>1 applications apply in their examination of those</p> <p>2 applications?</p> <p>3 A. Can you repeat that? I didn't follow</p> <p>4 it.</p> <p>5 Q. Sure.</p> <p>6 Do you know what examination policies</p> <p>7 other examiners in group 2615 are applying in</p> <p>8 their examination of Mr. Hyatt's patent</p> <p>9 applications?</p> <p>10 A. No. I don't know. I assume they're</p> <p>11 doing what's in the MPEP like I'm doing. If</p> <p>12 there's something beyond that that they're doing,</p> <p>13 I'm unaware of it.</p> <p>14 Q. So you don't know; correct?</p> <p>15 A. I would say I don't know.</p> <p>16 Q. Thank you.</p> <p>17 Are you aware of any policies regarding</p> <p>18 the examination of Mr. Hyatt's patent applications</p> <p>19 that do not exist in writing?</p> <p>20 A. No.</p> <p>21 Q. Are you aware of any guidance concerning</p> <p>22 the examination of Mr. Hyatt's patent applications</p>	<p style="text-align: right;">Page 52</p> <p>1 might disagree on this one, but my understanding</p> <p>2 is compact prosecution is the idea that you want</p> <p>3 to take an application, and you want to finally</p> <p>4 dispose of it in an efficient manner.</p> <p>5 When I say "dispose," I mean either pass</p> <p>6 it to allowance or ultimately determine that the</p> <p>7 case should be abandoned or -- well, that's</p> <p>8 usually the applicant's decision. As an examiner,</p> <p>9 I don't say it's abandoned, but basically, push</p> <p>10 the record forward enough and develop the issues</p> <p>11 and do that efficiently without backtracking so</p> <p>12 that the parties involved can decide, me, as an</p> <p>13 examiner, it's ready to be allowed or the</p> <p>14 applicant to say, well, maybe I need to try a</p> <p>15 different tactic.</p> <p>16 Q. Okay. Do you know if the</p> <p>17 principle -- strike that.</p> <p>18 Do you know if the policy of compact</p> <p>19 prosecution exists in writing?</p> <p>20 MS. STEWART: Objection. I think it</p> <p>21 assumes a fact that's not been established.</p> <p>22</p>
<p style="text-align: right;">Page 51</p> <p>1 that do not exist in writing?</p> <p>2 MS. STEWART: Objection. Vague.</p> <p>3 THE WITNESS: No. I don't think I do.</p> <p>4 BY MR. DELAQUIL:</p> <p>5 Q. Are you aware of any policies regarding</p> <p>6 the examination of Mr. Hyatt's patent applications</p> <p>7 that do not exist in writing?</p> <p>8 A. I'm sorry. Did you already ask that</p> <p>9 one?</p> <p>10 Q. I asked a similar question for guidance,</p> <p>11 but not policies.</p> <p>12 Would you like me to ask it again?</p> <p>13 A. Yes, please.</p> <p>14 Q. Are you aware of any policies regarding</p> <p>15 the examination of Mr. Hyatt's patent applications</p> <p>16 that do not exist in writing?</p> <p>17 A. No.</p> <p>18 Q. Are you familiar with the principle of</p> <p>19 compact prosecution?</p> <p>20 A. Yes.</p> <p>21 Q. What is compact prosecution?</p> <p>22 A. Well, compact prosecution, and people</p>	<p style="text-align: right;">Page 53</p> <p>1 BY MR. DELAQUIL:</p> <p>2 Q. You can answer.</p> <p>3 A. I've read the MPEP. I think it might</p> <p>4 use the term "compact prosecution" in there.</p> <p>5 Q. Do you understand the policy of compact</p> <p>6 prosecution to mean that examiners should state</p> <p>7 all the reasons and bases for rejecting claims in</p> <p>8 the first office action on an application?</p> <p>9 MS. STEWART: Objection. You're</p> <p>10 characterizing it as a policy. You asked about a</p> <p>11 principle. A fact not established, it's a policy.</p> <p>12 THE WITNESS: I've had -- I've had it</p> <p>13 explained to me over the years of my examining</p> <p>14 that a good practice is to state all your bases up</p> <p>15 front.</p> <p>16 In other words, you don't want to hold</p> <p>17 your cards and play gotcha against the applicants.</p> <p>18 BY MR. DELAQUIL:</p> <p>19 Q. Do you understand compact prosecution to</p> <p>20 be a policy of the Patent and Trademark Office in</p> <p>21 examining patents?</p> <p>22 A. Again, going back to my understanding of</p>

14 (Pages 50 to 53)

Page 54	Page 56
<p>1 what I think a policy would be, I don't -- I can't 2 say with any certainty that it's stated clearly 3 enough to be considered a policy. 4 Q. Do you know for certain whether compact 5 prosecution is provided for in the MPEP? 6 A. I would have to read it again. 7 Q. So you examine patent applications every 8 day, but you're not certain if compact prosecution 9 is a policy that's stated in the MPEP? 10 MS. STEWART: Objection. Argumentative. 11 THE WITNESS: What I'm saying is I know 12 that the word is used, but the exact outlines of 13 it are left up to interpretation. 14 BY MR. DELAQUIL: 15 Q. Do you know how the Patent and Trademark 16 Office has interpreted compact prosecution? 17 MS. STEWART: Objection. Asked and 18 answered. 19 BY MR. DELAQUIL: 20 Q. You can answer. 21 A. I believe I stated my view on that. 22 Q. I asked if you know. It's a yes-or-no</p>	<p>1 PowerPoint slide entitled Principles of Compact 2 Prosecution. 3 A. (Witness complies.) 4 Q. On there is a second bullet that says, 5 "Examiner makes all suitable rejections, 6 objections and indications or suggestions and 7 allowable subject matter appropriate for applicant 8 to bring in on amendment." 9 Does that refresh your recollection as 10 to whether the term -- or whether the US Patent 11 and Trademark Office has interpreted compact 12 prosecution? 13 A. Yes. This seems to provide more clarity 14 on that matter. 15 Q. Based on your refreshed recollection, 16 how do you understand the US Patent and Trademark 17 Office's interpretation of compact prosecution? 18 MS. STEWART: I want to state an 19 objection to this document. It wasn't produced in 20 discovery. It isn't dated and we have no idea how 21 it was used. 22 MR. DELAQUIL: No speaking objections,</p>
Page 55	Page 57
<p>1 question. 2 MS. STEWART: Objection. Argumentative. 3 BY MR. DELAQUIL: 4 Q. Would you please reread the question 5 that's right at the top of your screen? 6 (The record was read back.) 7 MS. STEWART: Same objection. 8 THE WITNESS: No, I don't have a 9 definitive statement on it. 10 MR. DELAQUIL: Would you give me the URL 11 exhibit, please. 12 (Briney Exhibit 3 was marked.) 13 BY MR. DELAQUIL: 14 Q. Mr. Briney, you've just been handed a 15 document marked as Exhibit Briney 3. 16 Are you familiar with this document? 17 (Witness reviewed the exhibit.) 18 THE WITNESS: No. 19 BY MR. DELAQUIL: 20 Q. Mr. Briney, I'd like you to turn to the 21 second page, and I'd like you to turn to the 22 bottom right quadrant of that page with a</p>	<p>1 Counsel. 2 MS. STEWART: I'll say my objection. It 3 assumes facts not in evidence that it's a 4 statement of USPTO policy. 5 THE WITNESS: Do you still have an open 6 question? 7 MR. DELAQUIL: I do have a question 8 pending. 9 Would you please reread the question. 10 (The record was read back.) 11 THE WITNESS: I would say these are 12 good -- this slide provides practical advice 13 assuming that it is, you know, an authentic 14 document that's been widely disseminated among the 15 examination core. 16 With all the those assumptions in mind, 17 I would say this provides some concrete bullet 18 points, things that could be done. Best 19 practices. 20 BY MR. DELAQUIL: 21 Q. Do you try to follow these best 22 practices in your examination of Mr. Hyatt's</p>

15 (Pages 54 to 57)

Page 58

1 patent applications?

2 MS. STEWART: Objection. Vague.

3 THE WITNESS: Well, I consider myself to
4 do best practices. Do all of these apply in every
5 single application? I don't know. It all
6 depends. Some strategies are better than others.
7 BY MR. DELAQUIL:

8 Q. Do you attempt to put all bases for
9 rejection in the first office action that you
10 issue on Mr. Hyatt's patent applications?

11 A. Yes, I do.

12 Q. Thank you.

13 Have you prepared office actions
14 rejecting claims in any of Mr. Hyatt's patent
15 applications?

16 MS. STEWART: Objection. I think we've
17 drawn a clear line during discovery that
18 individual decisions made in individual cases is
19 not discoverable.

20 MR. DELAQUIL: Let me rephrase the
21 question.
22

Page 59

1 BY MR. DELAQUIL:

2 Q. Have you signed office actions rejecting
3 claims in any of Mr. Hyatt's patent applications?

4 A. Yes, I have.

5 Q. And you applied the best practices that
6 you could in ensuring that the office actions that
7 you signed were correct?

8 MS. STEWART: Objection. Individual
9 decisions and individual cases is outside the
10 scope of discovery.

11 MR. DELAQUIL: So to clarify,
12 Ms. Stewart, are you instructing the witness not
13 to answer whether he applied best practices or
14 assured that best practices were employed in the
15 office actions he signed rejecting claims in
16 Mr. Hyatt's patent applications?

17 MS. STEWART: "Best practices" is a very
18 vague term. So to the extent you're trying to
19 determine what practices the witness applied in an
20 individual case, I'm objecting.

21 And if you have a very specific point
22 about what was applied in an individual case, then

Page 60

1 that is also predecisional.

2 So I think the witness already testified
3 that he attempts to apply best practices in his
4 examination. So anything drilling down to exactly
5 what occurred in an individual case would be
6 getting outside the scope of discovery, which is
7 on general policies applicable to his
8 applications.

9 BY MR. DELAQUIL:

10 Q. Mr. Briney, let me ask it a different
11 way.

12 In the office actions you've signed
13 rejecting Mr. Hyatt's patent -- claims in
14 Mr. Hyatt's patent applications, have the office
15 actions included all possible bases for rejection
16 to the best of your professional ability?

17 MS. STEWART: I'm going to object to the
18 extent you're asking about specific decisions made
19 in specific cases. And the rejections in the
20 individual cases speak for themselves.

21 Any rejection that was considered and
22 decided not to be included would be predecisional.

Page 61

1 MR. DELAQUIL: Are you instructing the
2 witness not to answer, Ms. Stewart?

3 THE WITNESS: To the best I understand
4 your question, it's calling for predecisional
5 privileged information, I'm instructing the
6 witness not to answer.

7 BY MR. DELAQUIL:

8 Q. Will you follow that instruction,
9 Mr. Briney?

10 A. Yes, I will.

11 MR. DELAQUIL: Would you give me PTO
12 441105, please.

13 Would you please mark this as Exhibit
14 Briney 4.

15 (Briney Exhibit 4 was marked.)

16 BY MR. DELAQUIL:

17 Q. Mr. Briney, you've been handed a
18 document marked Briney Exhibit 4.

19 Are you familiar with this document?

20 A. Give me a minute.

21 Q. Take as much time as you need.
22 (Witness reviewed the exhibit.)

16 (Pages 58 to 61)

<p style="text-align: right;">Page 62</p> <p>1 THE WITNESS: Okay. It looks familiar</p> <p>2 to me.</p> <p>3 BY MR. DELAQUIL:</p> <p>4 Q. Would you turn to the last page, which</p> <p>5 has the Bates No. PTO4-0041163, please.</p> <p>6 A. All right.</p> <p>7 Q. Do you see on this page where it says</p> <p>8 /Walter F. Briney, III?</p> <p>9 A. Yes.</p> <p>10 Q. Does that /Walter F. Briney, III mean</p> <p>11 that you signed this office action?</p> <p>12 A. That is correct.</p> <p>13 Q. Does this office action reject patent</p> <p>14 application -- strike that.</p> <p>15 Does this office action reject any of</p> <p>16 the claims in Patent Application, Serial</p> <p>17 No. 08/471,810, for prosecution laches?</p> <p>18 A. I do not believe that rejection is in</p> <p>19 this application or this office action. Sorry.</p> <p>20 Q. When you signed this application to the</p> <p>21 best of your professional ability, did it include</p> <p>22 all bases for the rejection of the claims in</p>	<p style="text-align: right;">Page 64</p> <p>1 MS. STEWART: I think so; 46363?</p> <p>2 MR. DELAQUIL: That's right.</p> <p>3 BY MR. DELAQUIL:</p> <p>4 Q. Mr. Briney, you've just been handed a</p> <p>5 document marked Briney Exhibit 5.</p> <p>6 Are you familiar with this document?</p> <p>7 A. Give me a minute.</p> <p>8 Q. Sure. Take as much time as you need.</p> <p>9 (Witness reviewed the exhibit.)</p> <p>10 THE WITNESS: Yes. I'm familiar.</p> <p>11 BY MR. DELAQUIL:</p> <p>12 Q. If you turn to the second to the last</p> <p>13 page of this document Bates marked PTO4-0046440,</p> <p>14 at the bottom, you will see /Walter F. Brian III/.</p> <p>15 Does that indicate that you signed this office</p> <p>16 action?</p> <p>17 A. Yes.</p> <p>18 Q. Does this office action reject any of</p> <p>19 the claims in Patent Serial Application</p> <p>20 No. 08/472,031 for prosecution laches?</p> <p>21 A. This office action does not include any</p> <p>22 claim rejections for prosecution laches.</p>
<p style="text-align: right;">Page 63</p> <p>1 Application No. 08/471,810?</p> <p>2 MS. STEWART: Objection. Instruct the</p> <p>3 witness not to answer as to the deliberations that</p> <p>4 went into preparing the office action.</p> <p>5 BY MR. DELAQUIL:</p> <p>6 Q. Will you follow your counsel's --</p> <p>7 A. I will.</p> <p>8 Q. But you do agree that this document does</p> <p>9 not include any rejection for prosecution laches?</p> <p>10 MS. STEWART: Objection. Asked and</p> <p>11 answered.</p> <p>12 BY MR. DELAQUIL:</p> <p>13 Q. You can answer.</p> <p>14 A. No. It does not include laches.</p> <p>15 MR. DELAQUIL: Would you hand me Exhibit</p> <p>16 PTO 446363.</p> <p>17 (Briney Exhibit 5 was marked.)</p> <p>18 MR. DELAQUIL: Did I hand this to you,</p> <p>19 Ms. Stewart?</p> <p>20 MS. STEWART: What?</p> <p>21 MR. DELAQUIL: Did I give you a copy of</p> <p>22 this document, Ms. Stewart?</p>	<p style="text-align: right;">Page 65</p> <p>1 Q. Okay. I've got a banker's box full of</p> <p>2 documents, but I think we may be able to cut</p> <p>3 through some of that.</p> <p>4 Is it fair to say that you've signed</p> <p>5 numerous office actions rejecting Mr. Hyatt's</p> <p>6 claims in various patent applications where those</p> <p>7 rejections did not include rejections for</p> <p>8 prosecution laches?</p> <p>9 A. Yes. These are two examples of office</p> <p>10 actions I wrote that did not include prosecution</p> <p>11 laches.</p> <p>12 Q. Do patent applicants typically -- strike</p> <p>13 that.</p> <p>14 After you issue an office action</p> <p>15 rejecting claims in a patent application, does the</p> <p>16 applicant have the right to respond to that office</p> <p>17 action?</p> <p>18 A. Yes.</p> <p>19 Q. Is that response -- what content is the</p> <p>20 applicant permitted to put in the response to an</p> <p>21 office action rejecting claims in a patent</p> <p>22 application?</p>

17 (Pages 62 to 65)

Page 66

1 MS. STEWART: Objection. Calls for a
2 legal conclusion.

3 BY MR. DELAQUIL:

4 Q. You can answer.

5 A. Well, we generally follow the
6 regulations, and they have certain limits about
7 what is considered a responsive reply.

8 Q. Okay. And what are those limits, to the
9 best of your understanding?

10 A. It's -- it has to be fully response --
11 the -- the response, or the reply, to not confuse
12 terms, the reply to an office action has to be
13 fully responsive to the office action.

14 And so generally that means you have to
15 respond -- or the applicant has to respond to the
16 rejections and the objections of record.

17 Q. Okay. And is an applicant permitted to
18 respond to the objections that are not of record?

19 MS. STEWART: Objection. Calls for a
20 legal conclusion.

21 THE WITNESS: I'm not sure I understand.
22

Page 67

1 BY MR. DELAQUIL:

2 Q. Let me ask it a different way.

3 Do applicants typically
4 respond -- strike that.

5 Do applicants typically file replies to
6 office actions rejecting claims that address
7 grounds for rejection that are not included in the
8 office action to which they are replying?

9 MS. STEWART: Objection. Vague. And I
10 do want to state for the record that the
11 deposition was offered outside the discovery
12 period as a courtesy so that you could probe this
13 issue of Hyatt policies that was provided in the
14 discovery order.

15 So if we keep getting too far outside
16 what the policies were or were not applied to the
17 Hyatt applications, I feel like we're going
18 outside the bounds of the deposition.

19 MR. DELAQUIL: Our position is that if
20 you intend or reserve the right to introduce
21 Mr. Hyatt -- strike that -- Mr. Briney's testimony
22 about examination policies and guidance that

Page 68

1 deposition questions into Mr. Briney's application
2 of those policies and guidance to office actions
3 is fair grounds for our deposition.

4 That's what these questions are directed
5 to, in our view.

6 MS. STEWART: But my understanding is
7 you're talking about just what happens generically
8 in a typical case. And I just want to try and
9 cabin it a little more to Mr. Hyatt because I know
10 we have limited time here.

11 MR. DELAQUIL: Well, let me -- sure.
12 Understood.

13 BY MR. DELAQUIL:

14 Q. Let me ask a different question.

15 Would there be any reason, in your view
16 as an examiner, for Mr. Hyatt to reply to an
17 office action rejecting his claims that did not
18 include as a grounds for his rejection prosecution
19 laches in a manner that addressed the prosecution
20 laches issue?

21 MS. STEWART: Objection. Vague. And
22 also calls for a hypothetical. And the court

Page 69

1 specifically instructed the parties not to ask
2 examiners about hypotheticals or speculation.

3 So I object to the question.

4 MR. DELAQUIL: Are you instructing him
5 not to answer?

6 MS. STEWART: I'm not instructing him
7 not to answer. But if the deposition keeps
8 probing into materials that the court specifically
9 said were outside the scope of the deposition, we
10 might have to suspend the deposition or table
11 those questions for another time until we can
12 resolve that with the court.

13 MR. DELAQUIL: If at any time you want
14 to suspend the deposition so that you can make a
15 motion to the court, please do so.

16 Would you please reread the question.

17 (The record was read back.)

18 MS. STEWART: Objection. Calls for
19 speculation.

20 THE WITNESS: I really don't know. I
21 guess if he read a court case and was fearful that
22 he should do something, he would do it. But

18 (Pages 66 to 69)

Page 70	Page 72
<p>1 that's all I can offer.</p> <p>2 BY MR. DELAQUIL:</p> <p>3 Q. Is it consistent with the policy of</p> <p>4 compact prosecution to hold back from asserting a</p> <p>5 potential ground of rejection for a subsequent</p> <p>6 office action?</p> <p>7 MS. STEWART: Objection. Assumes facts</p> <p>8 that haven't been established.</p> <p>9 THE WITNESS: Well, again, I don't know</p> <p>10 that it's a set policy. But as far as best</p> <p>11 practices are concerned, I've had it explained to</p> <p>12 me once don't hold your cards back.</p> <p>13 BY MR. DELAQUIL:</p> <p>14 Q. Why should an examiner not hold his</p> <p>15 cards back and issue an office actions?</p> <p>16 A. I can only speculate or reason that</p> <p>17 it's -- we're not in the -- we're not gamesmen.</p> <p>18 Q. Is it the PTO's policy that examiners</p> <p>19 should work to facilitate allowance of claims in a</p> <p>20 patent application?</p> <p>21 A. Allowances is an important function of</p> <p>22 our job, and we are supposed to identify allowable</p>	<p>1 referring to?</p> <p>2 MR. DELAQUIL: Page 3, marked Slide 8.</p> <p>3 THE WITNESS: I think you mean six.</p> <p>4 BY MR. DELAQUIL:</p> <p>5 Q. Six. You're correct. I should see my</p> <p>6 eye examiner.</p> <p>7 MS. STEWART: I can barely read this.</p> <p>8 BY MR. DELAQUIL:</p> <p>9 Q. Do you see where it says, "Examiner</p> <p>10 should always try to facilitate allowance where</p> <p>11 appropriate"?</p> <p>12 A. Yes.</p> <p>13 Q. Do you agree that that's the best</p> <p>14 principle or best practice in examination?</p> <p>15 A. Yes. That is the best practice.</p> <p>16 Q. Have you ever received guidance</p> <p>17 regarding Mr. Hyatt's applications instructing you</p> <p>18 to write a rejection as to material that Mr. Hyatt</p> <p>19 has not yet submitted?</p> <p>20 A. Like a speculative rejection about what</p> <p>21 he might present?</p> <p>22 Q. I'm asking if you've ever received</p>
Page 71	Page 73
<p>1 subject matter as soon as we can -- at the</p> <p>2 earliest stage.</p> <p>3 Q. So the answer to my question was "yes"?</p> <p>4 A. Well --</p> <p>5 MS. STEWART: Objection.</p> <p>6 Mischaracterizes the witness' testimony.</p> <p>7 THE WITNESS: Again, if you're asking if</p> <p>8 it's a policy of the office, I would say, again,</p> <p>9 best practice is defined allowable subject matter</p> <p>10 at the earliest possible stage.</p> <p>11 BY MR. DELAQUIL:</p> <p>12 Q. Okay. I'd like to turn you back to the</p> <p>13 Exhibit marked as Brian 3 entitled "Best Practices</p> <p>14 in Compact Prosecution."</p> <p>15 I'd like to direct you to page 3 of that</p> <p>16 document, which is PowerPoint Slide 8. Under the</p> <p>17 title "Principles of Compact Prosecution</p> <p>18 Continued," it says in the final bullet on that</p> <p>19 slide, "In a color different than every other</p> <p>20 statement on this slide, examiner should always</p> <p>21 try to facilitate allowance where appropriate."</p> <p>22 MS. STEWART: I'm sorry. Where are you</p>	<p>1 guidance in the context of examining Mr. Hyatt's</p> <p>2 patent applications where you have been instructed</p> <p>3 to write a new rejection if Mr. Hyatt submits</p> <p>4 material that he has not yet submitted to the PTO.</p> <p>5 A. No.</p> <p>6 MS. STEWART: Objection. Vague.</p> <p>7 MR. DELAQUIL: Would you give me Exhibit</p> <p>8 PTO 161365, please.</p> <p>9 Would you mark this as Exhibit PTO 6,</p> <p>10 please.</p> <p>11 MS. STEWART: I think you mean Briney 6.</p> <p>12 MR. DELAQUIL: Briney 6.</p> <p>13 (Briney Exhibit 6 was marked.)</p> <p>14 BY MR. DELAQUIL:</p> <p>15 Q. Mr. Briney, are you familiar with this</p> <p>16 email.</p> <p>17 (Witness reviewed the exhibit.)</p> <p>18 THE WITNESS: Yeah, I believe I've seen</p> <p>19 this before.</p> <p>20 BY MR. DELAQUIL:</p> <p>21 Q. Is this one of the emails you reviewed</p> <p>22 to prepare for this deposition?</p>

19 (Pages 70 to 73)

Page 74	Page 76
<p>1 A. No, I don't think so.</p> <p>2 Q. Would you go to the TO line of this</p> <p>3 email. It says "Briney III, Walter"?</p> <p>4 A. Yes.</p> <p>5 Q. Do you have any reason to believe that</p> <p>6 you didn't receive this email?</p> <p>7 A. No.</p> <p>8 Q. This email reads in full, "I've seen a</p> <p>9 couple of actions lately where you in the abstract</p> <p>10 pick a reasonable date as the not before this date</p> <p>11 and then the art rejection looks like you're</p> <p>12 trying to beat a 1970 date.</p> <p>13 "Have the courage to beat the date you</p> <p>14 identify. If you do the best you can what this</p> <p>15 party shows, you write a rejection on the date you</p> <p>16 identify and then he comes back and shows you an</p> <p>17 earlier date and a different spec, we'll write a</p> <p>18 new rejection and go final. He was already</p> <p>19 required to show earlier support."</p> <p>20 Did I read that correctly?</p> <p>21 A. Yes.</p> <p>22 Q. This email instructs you to write a new</p>	<p>1 if you make a mistake, we'll write a new</p> <p>2 rejection.</p> <p>3 BY MR. DELAQUIL:</p> <p>4 Q. Well, if you make a mistake, isn't</p> <p>5 Mr. Hyatt entitled to submit materials showing</p> <p>6 that you made a mistake?</p> <p>7 A. Yes, of course.</p> <p>8 Q. Why would Mr. Morse be telling you to</p> <p>9 write a new rejection in response to materials</p> <p>10 showing that the PTO made a mistake?</p> <p>11 MS. STEWART: Objection. Argumentative.</p> <p>12 THE WITNESS: Yes. Well, that is the</p> <p>13 back-and-forth nature of prosecution.</p> <p>14 BY MR. DELAQUIL:</p> <p>15 Q. It's a part of the back-and-forth nature</p> <p>16 of prosecution to instruct examiners to issue</p> <p>17 rejections to material that's not yet been</p> <p>18 submitted showing that a rejection was in error?</p> <p>19 MS. STEWART: Objection. Argumentative.</p> <p>20 Mischaracterizes the document.</p> <p>21 THE WITNESS: This is not saying that</p> <p>22 you cannot allow if an allowance is appropriate.</p>
Page 75	Page 77
<p>1 rejection and go final if Mr. Hyatt submits</p> <p>2 certain information to you that was not previously</p> <p>3 submitted; is that correct?</p> <p>4 MS. STEWART: Objection. Incomplete</p> <p>5 characterization of the document.</p> <p>6 MR. DELAQUIL: No speaking objections,</p> <p>7 Counsel.</p> <p>8 MS. STEWART: I can state the basis of</p> <p>9 the objection. Assumes facts not established.</p> <p>10 THE WITNESS: Yeah. I don't know</p> <p>11 exactly how to characterize this document. It</p> <p>12 looks like it's talking about claim priority</p> <p>13 dates.</p> <p>14 I guess some examiners were saying</p> <p>15 you're entitled to such-and-such date, but I'm</p> <p>16 going to still find old art instead of more</p> <p>17 contemporaneous art.</p> <p>18 If you do the best you can with the</p> <p>19 support. So -- so if you're wrong in your date,</p> <p>20 and you go with it, when he comes back and shows</p> <p>21 you're wrong...</p> <p>22 Yeah, I think what it's saying here is</p>	<p>1 BY MR. DELAQUIL:</p> <p>2 Q. What it says is we'll write a new</p> <p>3 rejection and go final.</p> <p>4 That's what it says, doesn't it?</p> <p>5 A. That's the words, yes.</p> <p>6 Q. The word "allowance" is not in this</p> <p>7 email, is it?</p> <p>8 A. No.</p> <p>9 Q. Have you ever allowed a claim in a</p> <p>10 patent application filed by Mr. Hyatt?</p> <p>11 A. No.</p> <p>12 Q. Are you aware of the term "submarine</p> <p>13 patent applications" in reference to certain</p> <p>14 patent applicants?</p> <p>15 A. Yes, I've heard that term.</p> <p>16 Q. Do you understand that term to be -- by</p> <p>17 "that term," I mean submarine applicants to mean</p> <p>18 the same thing as submariner?</p> <p>19 A. Submarine patents, submariner?</p> <p>20 Q. Yes.</p> <p>21 A. I guess they sound similar. I've not</p> <p>22 used that term, that I know of.</p>

20 (Pages 74 to 77)

Page 78

1 Q. So you're familiar with the term
2 "submarine patent applicant"?

3 A. Sure.

4 Q. But you're not familiar with the term
5 "submariner"?

6 A. No. I mean, it's -- seems like a pretty
7 easy connection there.

8 Q. All right. What does the term
9 "submarine patent applicant" mean?

10 A. Well, that's up for debate. But my
11 basic understanding is it's a patent that is not
12 widely known to the public by some means, and it
13 comes out of nowhere and is typically disruptive
14 of an established industry.

15 Q. Does the MPEP uses the term "submarine
16 patent applicant"?

17 A. I don't know.

18 Q. Do you know if the PTO has any policies
19 for, quote-unquote, "submarine patent applicants"
20 that differ than those for other patent
21 applicants?

22 A. Can you repeat that question again?

Page 79

1 Q. Okay.

2 Do you know if the PTO has any policies
3 for, quote-unquote, "submarine patent applicants"
4 that differ from those of other patent applicants?

5 A. Well, I'm aware of there was at some
6 point a Saws program. I don't know if that's
7 considered a policy.

8 Q. What do you understand about the Saws
9 program?

10 A. Very little. It was mostly before my
11 time as an examiner. I was never dramatically
12 involved with it.

13 Q. Okay. What very little of --
14 understanding it's very little, what do you
15 understand of the Saws program?

16 A. The term "submarine" or "disruptive
17 technology," I think, is associated. My basic
18 understanding is any application that would be --
19 if it were allowed, it would be kind of out of
20 the -- out of the ordinary.

21 Q. What do you mean by "out of the
22 ordinary" if it were allowed?

Page 80

1 A. Like disruptive, something that would be
2 very disruptive. Like, if it was upsetting an
3 established industry.

4 Q. Okay. Is the upset to an established
5 industry one of the policies applicable to the
6 examination of patents that's set forth in the
7 MPEP, to the best of your knowledge?

8 A. Can you repeat that? I didn't follow.

9 MR. DELAQUIL: Please read the question
10 back.

11 (The record was read back.)

12 THE WITNESS: Again, that's a -- that's
13 a legal question because we have 101 doctrine and
14 we have the whole notion of preemption, preemption
15 of a abstract idea.

16 And so we've -- you know, we've seen
17 inventions or patent applications with claims that
18 might disrupt a whole industry.

19 So to that extent...

20 BY MR. DELAQUIL:

21 Q. Do you know --

22 MS. STEWART: Sorry. I don't think the

Page 81

1 witness finished.

2 BY MR. DELAQUIL:

3 Q. I certainly didn't mean to interrupt
4 you.

5 A. Of course, no offense taken.

6 Q. Did I -- did I interrupt you?

7 A. I was just going to say that so to the
8 extent the MPEP talks about it, that's -- that
9 would be my what understanding is. Only -- only
10 in connection with the general nature of some of
11 the -- the statutes that we enforce.

12 Q. Okay. Those subsections you mentioned,
13 101 -- what was the other?

14 A. 101.

15 Q. That deals with patentable subject
16 matter, doesn't it?

17 A. Correct.

18 Q. That doesn't deal with examination
19 procedure; correct?

20 A. That -- no, it's not a -- oh, not
21 Section 101 of the MPEP. I'm talking about 35 USC
22 Section 101.

21 (Pages 78 to 81)

<p style="text-align: right;">Page 82</p> <p>1 Q. Okay. And my question is 35 USC</p> <p>2 Section 101 deals with patentable subject matter;</p> <p>3 correct?</p> <p>4 A. That's correct.</p> <p>5 Q. It does not deal with examination</p> <p>6 procedure; correct?</p> <p>7 MS. STEWART: Objection. Calls for a</p> <p>8 legal conclusion.</p> <p>9 THE WITNESS: Right. I mean, it --</p> <p>10 there are legal cases tied into it with procedures</p> <p>11 for how to implement it, so...</p> <p>12 BY MR. DELAQUIL:</p> <p>13 Q. Okay. When you examine patents, does</p> <p>14 whether or not you believe the claim states a</p> <p>15 patentable subject matter within the meaning of</p> <p>16 Section 101 affect the procedure that you apply in</p> <p>17 the examination of those patents applications?</p> <p>18 A. No.</p> <p>19 Q. Okay. Are you aware of any policy that</p> <p>20 the PTO has that states that patent applications</p> <p>21 that raise a question about patentable subject</p> <p>22 matter under Section 101 are subject to a</p>	<p style="text-align: right;">Page 84</p> <p>1 A. Yeah. It's part of the examination</p> <p>2 flowchart.</p> <p>3 Q. Do you understand the term "submarine</p> <p>4 patent applicant" to be pejorative?</p> <p>5 A. Yeah. I've seen it used mostly in a</p> <p>6 pejorative sense.</p> <p>7 Q. Why is that? Why would it be</p> <p>8 pejorative?</p> <p>9 A. Well, although there are apologists for</p> <p>10 it, too, so I've seen it both ways. It's not</p> <p>11 exclusively pejorative and it's just about</p> <p>12 people's expectations, I would -- I would venture</p> <p>13 to say.</p> <p>14 Q. Okay.</p> <p>15 A. Some people get hurt. They get upset.</p> <p>16 Some people benefit. They're happy for it.</p> <p>17 Q. So are you able to say whether it is</p> <p>18 used in a pejorative sense most of the time the</p> <p>19 term "submarine patent applicants" is used?</p> <p>20 A. I don't know. I'm not aware of all the</p> <p>21 times it's been used.</p> <p>22 Q. Do you know if Saws is still in effect?</p>
<p style="text-align: right;">Page 83</p> <p>1 different examination procedure?</p> <p>2 MS. STEWART: Objection. Vague.</p> <p>3 THE WITNESS: Yeah, can you restate</p> <p>4 that?</p> <p>5 MR. DELAQUIL: Would you please reread</p> <p>6 the question.</p> <p>7 (The record was read back.)</p> <p>8 THE WITNESS: Well, there is a policy</p> <p>9 for -- for evaluating 101, but the outcome</p> <p>10 doesn't -- like, once you get to the bottom of</p> <p>11 that flowchart for 101, you move on. There is</p> <p>12 no -- there is no decision box at the end.</p> <p>13 BY MR. DELAQUIL:</p> <p>14 Q. So was it fair to say that you examine a</p> <p>15 claim for patentable subject under Section 101 the</p> <p>16 same way you would evaluate it for written</p> <p>17 description requirement or for obviousness or for</p> <p>18 any other reason why that claim might be</p> <p>19 rejectable?</p> <p>20 A. You do all of them.</p> <p>21 Q. But it's not a different procedure.</p> <p>22 It's part of the procedure; is that fair?</p>	<p style="text-align: right;">Page 85</p> <p>1 A. My understanding is it is no longer in</p> <p>2 effect.</p> <p>3 Q. Do you know when Saws was discontinued?</p> <p>4 A. It seems like that's a recent memory,</p> <p>5 but it's fuzzy to me because I didn't -- I wasn't</p> <p>6 really tied up into it.</p> <p>7 Q. Do you know if patent applicants whose</p> <p>8 applications were subject of Saws were informed of</p> <p>9 that fact?</p> <p>10 A. Maybe in some circumstances. Again, I</p> <p>11 have very limited knowledge so I -- I don't</p> <p>12 confidently know.</p> <p>13 Q. When you use the term "submarine patent</p> <p>14 applicants," do you use it in a positive way?</p> <p>15 MS. STEWART: Objection. Misstates the</p> <p>16 witness' testimony.</p> <p>17 BY MR. DELAQUIL:</p> <p>18 Q. You can answer.</p> <p>19 A. Again, I -- I understand the term as</p> <p>20 it's describing a set of circumstances. I don't</p> <p>21 put a whole a lot of moral weight on the decision</p> <p>22 to do that -- if that's what you're asking like</p>

22 (Pages 82 to 85)

<p style="text-align: right;">Page 86</p> <p>1 "pejorative." 2 Q. Have you ever heard any individual 3 patent applicants referred to as "submarine patent 4 applicants"? 5 A. Yes. 6 Q. Who? 7 A. Well, number one, Mr. Hyatt has been 8 labeled as a submarine patent practitioner, and I 9 believe -- I hope I don't get this name wrong. I 10 think it's Jerome Levelson. I think he was also 11 known as a patent submariner, to use that term. 12 That's all I'm aware of. 13 Q. Are you familiar with the name John 14 Harvey? 15 A. Now that you mention it, yes. I've 16 heard that name. 17 Q. Have you heard Mr. Harvey referred to as 18 a submarine patent applicant? 19 A. I -- you know, I have, but I'm not 20 familiar with the Harvey situation. 21 Q. Do you know who has referred to 22 Mr. Hyatt as a submarine patent applicant in your</p>	<p style="text-align: right;">Page 88</p> <p>1 MR. DELAQUIL: Would you hand me Exhibit 2 PTO 429527. We should not have used 429527 3 already. 4 MS. STEWART: While you're looking for 5 it, is it time for a bathroom break? 6 MR. DELAQUIL: Can you give me five 7 minutes? 8 Give me 51371 if you can't find it. 9 (Briney Exhibit 7 was marked.) 10 MR. DELAQUIL: Thank you. 11 BY MR. DELAQUIL: 12 Q. Mr. Briney, you've just been handed a 13 document that's marked as Exhibit Briney 7. 14 Are you familiar with this document? 15 A. Let me take a look. I will not flip 16 through all -- 17 Q. Sure. 18 A. -- 250-some pages. 19 (Witness reviewed the exhibit.) 20 THE WITNESS: Okay. I think -- yeah, 21 this looks like a complete copy of an office 22 action.</p>
<p style="text-align: right;">Page 87</p> <p>1 presence? 2 A. I'm sure we've used the term loosely in 3 our art unit when talking about the -- the 4 applications because we've discussed the 5 background, the history of the applications and I 6 know that that's come up in our discussions. 7 Q. You said used the term loosely. 8 What do you mean use the term "loosely"? 9 A. Well, I mean, I don't afford it any kind 10 of significance aside from some people have used 11 it to describe the actions -- certain actions. 12 Certain patent practices. 13 Q. Is the fact that an applicant has been 14 described as a submarine patent applicant relevant 15 in any way to his eligibility for a patent? 16 A. The term itself has no meaning to me. 17 Everything is based on the record, the actions, 18 the law. 19 Q. So by "the term has no meaning," do you 20 mean that it's irrelevant as to whether the 21 applicant is entitled to a patent? 22 A. Yes. That's exactly what I'm saying.</p>	<p style="text-align: right;">Page 89</p> <p>1 BY MR. DELAQUIL: 2 Q. If you go to the first page Bates marked 3 PTO 429527 in the top right corner, it says 4 "Examiner: Walter F. Briney, III"? 5 Do you see that? 6 A. Yes. 7 Q. Okay. You see Walter F. Briney, III as 8 the examiner? 9 A. I do. 10 Q. If you go to the last page all the way 11 at the end, it says "/Walter F. Briney, III/," 12 that means you signed this office action; correct? 13 A. Correct. 14 Q. I'd like you to turn to page PTO 429571, 15 please. There's a flag that will make it easier 16 for you. 17 A. All right. 18 Q. If you turn by line 5, it says, "Not 19 surprisingly, Applicant has been identified by 20 commentary as a submarine patent applicant." 21 Do you see that? 22 A. I do.</p>

23 (Pages 86 to 89)

Page 90	Page 92
<p>1 Q. Okay. And you testified earlier that</p> <p>2 whether or not a patent applicant is a submarine</p> <p>3 patent applicant doesn't impact his eligibility</p> <p>4 for a patent; is that correct?</p> <p>5 A. The term -- yeah, the use of the term is</p> <p>6 not important.</p> <p>7 Q. Okay. And you also testified that the</p> <p>8 term "submarine patent applicant" is understood by</p> <p>9 many to be pejorative; correct?</p> <p>10 A. I believe I said I don't know if it's</p> <p>11 mostly used as pejorative or not.</p> <p>12 Q. Is it -- is it used as pejorative?</p> <p>13 A. It is used as pejorative, yes, by some.</p> <p>14 Q. Such as commentators who have identified</p> <p>15 Mr. Hyatt as a submarine patent applicant?</p> <p>16 A. Yes.</p> <p>17 Q. Thank you.</p> <p>18 MR. DELAQUIL: We are ready for a</p> <p>19 break -- one more question.</p> <p>20 BY MR. DELAQUIL:</p> <p>21 Q. Have you issued other office actions</p> <p>22 that have referred to Mr. Hyatt as a submarine</p>	<p>1 of specific patent applications with other PTO</p> <p>2 employees affiliated with group 2615?</p> <p>3 A. Can you repeat that?</p> <p>4 Q. Sure. Maybe I'll ask it a little</p> <p>5 clearer.</p> <p>6 Have you ever communicated either</p> <p>7 discussions, over the phone, in email,</p> <p>8 communicated in any way about Mr. Hyatt with other</p> <p>9 group 2615 members?</p> <p>10 And when I ask about Mr. Hyatt, I mean</p> <p>11 about him personally as opposed to his patent</p> <p>12 applications.</p> <p>13 A. Yes. In a -- like, personally?</p> <p>14 Q. Yes.</p> <p>15 A. Yeah. We've talked about Hyatt -- well,</p> <p>16 even though that's a little -- it's on the line.</p> <p>17 Q. Tell me what it is. What were those</p> <p>18 communications?</p> <p>19 A. We just talked about Hyatt in general,</p> <p>20 like, and usually we're just wondering, you know,</p> <p>21 what his interest is.</p> <p>22 Q. Is that relevant to the examination of</p>
Page 91	Page 93
<p>1 patent applicant?</p> <p>2 A. Yes, other office actions, including</p> <p>3 this laches rejection, have that same statement.</p> <p>4 Q. Numerous other office actions; correct?</p> <p>5 A. I'm not sure how many to date, but, yes.</p> <p>6 MR. DELAQUIL: We're ready for a break?</p> <p>7 THE VIDEOGRAPHER: Going off the record</p> <p>8 at 11:03 a.m.</p> <p>9 (Recess from 11:03 a.m. to 11:14 a.m.)</p> <p>10 THE VIDEOGRAPHER: We're going back on</p> <p>11 the record at 11:14 a.m. This is Tape No. 2 in</p> <p>12 the deposition of Walter F. Briney, III.</p> <p>13 BY MR. DELAQUIL:</p> <p>14 Q. Welcome back, Mr. Briney.</p> <p>15 Have you ever spoken to Mr. Hyatt?</p> <p>16 A. No. Like on the phone you mean?</p> <p>17 Q. Let's start with on the phone.</p> <p>18 A. No.</p> <p>19 Q. In person?</p> <p>20 A. No.</p> <p>21 Q. Have you ever communicated about</p> <p>22 Mr. Hyatt outside the context of the examination</p>	<p>1 his patent applications?</p> <p>2 A. No. It was never intended to be like,</p> <p>3 you know, to feed back into the job, just human</p> <p>4 curiosity.</p> <p>5 Q. Do you remember any specific</p> <p>6 communications you had about Mr. Hyatt?</p> <p>7 A. Yes.</p> <p>8 Q. Please describe all of them.</p> <p>9 MS. STEWART: Objection. Compound.</p> <p>10 THE WITNESS: What -- what format do you</p> <p>11 want to talk about?</p> <p>12 BY MR. DELAQUIL:</p> <p>13 Q. Let's start with in person.</p> <p>14 A. In person. Yeah, I mean, I've talked in</p> <p>15 person with -- with my coworkers, and we talk</p> <p>16 about the job, what do we think is going to</p> <p>17 happen, which I guess is more about -- I think</p> <p>18 that's what we mostly talk about, what do you</p> <p>19 think is going to happen with these cases.</p> <p>20 Q. Have you ever had a discussion about</p> <p>21 what would happen when you allowed some of</p> <p>22 Mr. Hyatt's claims?</p>

Page 94	Page 96
<p>1 A. I don't remember any specific</p> <p>2 conversations about what would happen about</p> <p>3 allowing the claims.</p> <p>4 Q. Have you had discussions about what</p> <p>5 might happen if the PTO finally rejected</p> <p>6 Mr. Hyatt's claims?</p> <p>7 A. Actually, now I do remember we did talk</p> <p>8 about like what happens if we allow the claims as</p> <p>9 they stand. But I guess that's more of a question</p> <p>10 of -- you know, it's more of a legal decisional</p> <p>11 question.</p> <p>12 Q. Would you please describe that</p> <p>13 discussion? Who was it with?</p> <p>14 A. I probably had that conversation with</p> <p>15 half of my coworkers, the same conversation</p> <p>16 because we're all curious about the effects that</p> <p>17 these cases might have.</p> <p>18 Q. By "these cases," do you mean this</p> <p>19 litigation or his applications?</p> <p>20 A. I mean, yeah, the applications we're</p> <p>21 working on.</p> <p>22 Q. Is it fair to say that's a regular topic</p>	<p>1 A. Yes.</p> <p>2 Q. So those are in-person discussions;</p> <p>3 correct?</p> <p>4 A. Yes.</p> <p>5 Q. Have you discussed Mr. Hyatt over the</p> <p>6 instant messaging system you mentioned earlier?</p> <p>7 A. Let me think. Again, are we talking the</p> <p>8 same line, like more personal --</p> <p>9 Q. Yes.</p> <p>10 A. -- or work related?</p> <p>11 Q. More personal, not examination related.</p> <p>12 A. No. I'm pretty confident all my instant</p> <p>13 message communication has been like, hey, can I</p> <p>14 give you a phone call.</p> <p>15 Q. Okay.</p> <p>16 A. We don't really talk details over that</p> <p>17 meeting.</p> <p>18 Q. Why not?</p> <p>19 A. At least, I don't.</p> <p>20 Q. Do others?</p> <p>21 A. I have no idea.</p> <p>22 Q. In the instant messaging, are you part</p>
Page 95	Page 97
<p>1 of discussion among the examiners in group 2615?</p> <p>2 A. We don't always talk about it, but I've</p> <p>3 had it with probably half of my coworkers over the</p> <p>4 last five years.</p> <p>5 Q. Are the consequences of the PTO's</p> <p>6 decisions on the patent application something that</p> <p>7 PTO policy directs examiners to consider in</p> <p>8 examining patent applications?</p> <p>9 A. No, generally not. In these Hyatt cases</p> <p>10 or applications, try and stick to using that term</p> <p>11 "applications."</p> <p>12 In the Hyatt applications, we're not</p> <p>13 coached to consider the consequences down the</p> <p>14 line. We're still supposed to apply the law to</p> <p>15 the facts.</p> <p>16 Q. But you've discussed those consequences</p> <p>17 with approximately half of your coworkers,</p> <p>18 nevertheless?</p> <p>19 A. Yes, putting meaning to the work, I</p> <p>20 guess.</p> <p>21 Q. Have you had those discussions with</p> <p>22 Mr. Morse?</p>	<p>1 of the group 2615 group?</p> <p>2 A. No. There is no -- to my knowledge, you</p> <p>3 have individual contacts. You can group them on</p> <p>4 your end. Like on the client side, you can</p> <p>5 organize your contacts.</p> <p>6 Q. Do you have a group 2615 group in your</p> <p>7 instant messaging system for work?</p> <p>8 A. Under the parameters, yes. I have a</p> <p>9 client side way to organize so I can see quickly</p> <p>10 if I can contact any of my coworkers, I can open,</p> <p>11 you know, up the tab and say, hey, so-and-so is on</p> <p>12 the line.</p> <p>13 Q. Have you received any communications</p> <p>14 through the instant messaging system about</p> <p>15 Mr. Hyatt personally apart from communications</p> <p>16 about the examination of specific applications?</p> <p>17 MS. STEWART: Objection. Asked and</p> <p>18 answered.</p> <p>19 THE WITNESS: Again, I don't remember</p> <p>20 any specific ones.</p> <p>21 BY MR. DELAQUIL:</p> <p>22 Q. You said -- you testified earlier</p>

25 (Pages 94 to 97)

<p style="text-align: right;">Page 98</p> <p>1 something to the effect of that you wouldn't have</p> <p>2 conversations about -- detailed conversations on</p> <p>3 instant messaging. It would be more in the nature</p> <p>4 of, call me, are you free for a call.</p> <p>5 Is that a fair way to characterize your</p> <p>6 earlier testimony?</p> <p>7 A. Yeah. I don't really like using -- I</p> <p>8 mean, I do use it sometimes, but it's --</p> <p>9 generally, I try and use the phone so I can have a</p> <p>10 conversation.</p> <p>11 Q. Have you had any in-person -- strike</p> <p>12 that.</p> <p>13 Have you had any telephone</p> <p>14 communications with your group coworkers in 2615</p> <p>15 concerning Mr. Hyatt personally as opposed to his</p> <p>16 individual patent applications?</p> <p>17 A. Every phone call that I can remember, it</p> <p>18 always starts work related, then when we're done</p> <p>19 talking, we might say, what do you think is going</p> <p>20 to happen.</p> <p>21 Q. Why are you concerned about that?</p> <p>22 MS. STEWART: Objection. It</p>	<p style="text-align: right;">Page 100</p> <p>1 communications concerning Mr. Hyatt personally</p> <p>2 that you recall.</p> <p>3 MS. STEWART: Objection. Compound.</p> <p>4 BY MR. DELAQUIL:</p> <p>5 Q. You can answer.</p> <p>6 A. Okay. Well, I remember finding some</p> <p>7 articles about Mr. Hyatt online and I shared those</p> <p>8 with my coworkers.</p> <p>9 Q. Anything else?</p> <p>10 A. Maybe. I don't have -- I don't recall.</p> <p>11 Again, five years of emails.</p> <p>12 Q. Does the PTO have any policies</p> <p>13 concerning -- strike that.</p> <p>14 Does the PTO have any policies</p> <p>15 concerning the examination of a patent applicant's</p> <p>16 applications that relate to whether that applicant</p> <p>17 has engaged in litigation?</p> <p>18 A. I didn't follow it. Can you repeat</p> <p>19 that?</p> <p>20 Q. Does the PTO have any patent application</p> <p>21 policies that relate to whether a patent applicant</p> <p>22 has engaged in litigation?</p>
<p style="text-align: right;">Page 99</p> <p>1 mischaracterizes the witness' testimony.</p> <p>2 BY MR. DELAQUIL:</p> <p>3 Q. Why do you discuss what might happen?</p> <p>4 MS. STEWART: Objection. Asked and</p> <p>5 answered.</p> <p>6 THE WITNESS: I believe I said earlier,</p> <p>7 it's kind of human curiosity to talk about the</p> <p>8 job.</p> <p>9 BY MR. DELAQUIL:</p> <p>10 Q. We've gone through in-person</p> <p>11 communications, gone through instant messaging.</p> <p>12 We've gone through phones.</p> <p>13 Any other way you communicate with your</p> <p>14 coworkers from group 2615?</p> <p>15 A. Sure, email.</p> <p>16 Q. Any email communications about</p> <p>17 Mr. Hyatt, personally?</p> <p>18 A. Yes.</p> <p>19 Q. Any you can recall specifically sitting</p> <p>20 here today?</p> <p>21 A. Yes.</p> <p>22 Q. Please tell me each of the email</p>	<p style="text-align: right;">Page 101</p> <p>1 A. Oh, okay. I don't know. I can only</p> <p>2 speak from my experience in working with these</p> <p>3 Hyatt applications in that we are generally made</p> <p>4 aware of the ongoing. Like we get updates to</p> <p>5 say, hey, there's been a lawsuit filed.</p> <p>6 But I don't know if there's -- that</p> <p>7 doesn't have the semblance of a policy to me. But</p> <p>8 we need to be aware because sometimes things go to</p> <p>9 appeal, we have to make records of related appeals</p> <p>10 and things like that.</p> <p>11 Q. Okay. What relevance does Mr. Hyatt's</p> <p>12 litigation activities have on your -- have to the</p> <p>13 examination of his patent applications?</p> <p>14 MS. STEWART: Objection. Assumes a fact</p> <p>15 and mischaracterizes the witness' testimony.</p> <p>16 THE WITNESS: Right. That goes into my</p> <p>17 decision making. Sometimes there's facts alleged</p> <p>18 or whatever.</p> <p>19 BY MR. DELAQUIL:</p> <p>20 Q. How would that go into your decision</p> <p>21 making?</p> <p>22 A. If he admits a fact in court, and it</p>

26 (Pages 98 to 101)

<p style="text-align: right;">Page 102</p> <p>1 applies to my particular application.</p> <p>2 Q. So if he's engaged in patent</p> <p>3 application, and he admits a fact in court, and</p> <p>4 it's relevant to your examination of an</p> <p>5 application.</p> <p>6 What if he's engaged in litigation on a</p> <p>7 tax matter, what relevance would that have to the</p> <p>8 examination of his patent applications?</p> <p>9 A. That would not be directly related to</p> <p>10 his patent prosecution.</p> <p>11 Q. That wasn't the question I asked.</p> <p>12 The question I asked is: What relevance</p> <p>13 would it have to the examination of his patent</p> <p>14 applications.</p> <p>15 MS. STEWART: Objection. Asked and</p> <p>16 answered.</p> <p>17 THE WITNESS: I believe I said it</p> <p>18 wouldn't directly affect that, again, unless</p> <p>19 somehow it came up as -- I don't know -- some kind</p> <p>20 of estoppel issue or, again, if he admitted a fact</p> <p>21 like he didn't invent something. I don't know.</p> <p>22</p>	<p style="text-align: right;">Page 104</p> <p>1 contributing to -- if it's obfuscating information</p> <p>2 that we need to know at the office or if it's</p> <p>3 delaying prosecution like the laches, but whether</p> <p>4 that is specific -- whether that went into a</p> <p>5 specific decision, that's all on record.</p> <p>6 Q. As the examiner on many of Mr. Hyatt's</p> <p>7 patent applications, has Mr. Hyatt's litigation in</p> <p>8 Section 145 cases against the Patent and Trademark</p> <p>9 Office affected your examination of those patent</p> <p>10 applications?</p> <p>11 A. Well, actually, I don't -- I'm trying to</p> <p>12 think. I know I had some -- again, that's a</p> <p>13 particular case. Yes, I think -- and I don't want</p> <p>14 to say anything too specific. But I think there</p> <p>15 has been some overlap there.</p> <p>16 Q. Generally, how has Mr. Hyatt's</p> <p>17 litigation in Section 145 actions against the PTO</p> <p>18 affected your examination of the patent</p> <p>19 applications?</p> <p>20 A. Well, how do you mean "affect"? Do you</p> <p>21 mean like the procedure I've taken or decisions I</p> <p>22 just made?</p>
<p style="text-align: right;">Page 103</p> <p>1 BY MR. DELAQUIL:</p> <p>2 Q. Have you ever seen a situation where a</p> <p>3 statement he's made in litigation has affected the</p> <p>4 examination of one of his patent applications?</p> <p>5 MS. STEWART: Objection. I want to</p> <p>6 instruct the witness not to talk about</p> <p>7 deliberations of a specific application.</p> <p>8 But to the extent counsel is asking like</p> <p>9 a general question, that's fine.</p> <p>10 MR. DELAQUIL: Generally.</p> <p>11 THE WITNESS: I'm trying to think. I</p> <p>12 don't remember. But there's been a lot of related</p> <p>13 litigation, and we had to consider that.</p> <p>14 BY MR. DELAQUIL:</p> <p>15 Q. Is Mr. Hyatt's litigation style relevant</p> <p>16 to the examination of his patent applications?</p> <p>17 A. Again, it could be. It could be.</p> <p>18 Q. Would you please explain how Mr. Hyatt's</p> <p>19 litigation style would be relevant to the</p> <p>20 examination of his patent applications?</p> <p>21 A. Again, I don't want to talk about any</p> <p>22 specific matter, but in general, if it's somehow</p>	<p style="text-align: right;">Page 105</p> <p>1 Q. Let's start with that. The procedures</p> <p>2 you've taken.</p> <p>3 A. I have to read them and understand them</p> <p>4 at least at a surface level to see if there's any</p> <p>5 related issues or, again, as I said, the facts,</p> <p>6 the facts that he alleges.</p> <p>7 Q. Okay. So you've had to read pleadings?</p> <p>8 A. Yeah. At the bare minimum, I read the</p> <p>9 pleadings or the briefs.</p> <p>10 Q. How long has that taken you in an</p> <p>11 individual case?</p> <p>12 A. I oftentimes reread them. So it's hard</p> <p>13 to say because as the case moves on, I'll read it</p> <p>14 when it first comes out and I'll have to kind of</p> <p>15 refresh my memory as I get into other things.</p> <p>16 Q. Has that affected your examination of</p> <p>17 Mr. Hyatt's applications in any other way?</p> <p>18 A. Beyond procedurally?</p> <p>19 Q. Beyond procedurally.</p> <p>20 MS. STEWART: Objection. Vague.</p> <p>21 THE WITNESS: Well, again, it probably</p> <p>22 has, but I just don't remember all the details</p>

27 (Pages 102 to 105)

<p style="text-align: right;">Page 106</p> <p>1 that went into my decision making.</p> <p>2 Again, it's been a long time, a lot of</p> <p>3 facts. Nothing sticks out, but I don't remember</p> <p>4 all those details.</p> <p>5 BY MR. DELAQUIL:</p> <p>6 Q. Would you characterize Mr. Hyatt's</p> <p>7 litigation activities in Section 145 actions as a</p> <p>8 significant influence on your consideration of his</p> <p>9 pending patent applications?</p> <p>10 A. Well, can you be a little more specific</p> <p>11 about what 145 actions you're talking about that</p> <p>12 might help me understand?</p> <p>13 Q. Any and all.</p> <p>14 A. Any and all. Can you repeat the</p> <p>15 question?</p> <p>16 MR. DELAQUIL: Would you please read</p> <p>17 back the question.</p> <p>18 (The record was read back.)</p> <p>19 MS. STEWART: Objection. Calls for</p> <p>20 speculation.</p> <p>21 THE WITNESS: I'm not sure what you mean</p> <p>22 by "significant."</p>	<p style="text-align: right;">Page 108</p> <p>1 BY MR. DELAQUIL:</p> <p>2 Q. Mr. Briney, you've just been handed a</p> <p>3 document marked Exhibit Briney 8. That's an email</p> <p>4 from Greg Morse to a variety of individuals,</p> <p>5 including yourself, dated September 22, 2014.</p> <p>6 A. Okay.</p> <p>7 Q. It says Subject: Case tangentially</p> <p>8 related to your applications.</p> <p>9 A. Uh-huh.</p> <p>10 Q. First line is, "Please do not respond to</p> <p>11 this email."</p> <p>12 And the second line is, "I commend this</p> <p>13 decision to your attention to consider the</p> <p>14 similarities in litigation style and length of</p> <p>15 pendency to your applications. I have no belief</p> <p>16 one way or another about the correctness of the</p> <p>17 decision on tax law or choice of law issues."</p> <p>18 Okay?</p> <p>19 A. Okay.</p> <p>20 Q. Do you remember this email?</p> <p>21 A. Yes, I do.</p> <p>22 Q. How was it tangentially related to your</p>
<p style="text-align: right;">Page 107</p> <p>1 BY MR. DELAQUIL:</p> <p>2 Q. Are you familiar with the term</p> <p>3 "significant"?</p> <p>4 MS. STEWART: Objection. Argumentative.</p> <p>5 THE WITNESS: It's an English word.</p> <p>6 BY MR. DELAQUIL:</p> <p>7 Q. Are you familiar with the common and</p> <p>8 normal usage in the English language?</p> <p>9 A. Yes.</p> <p>10 Q. In the context of my question,</p> <p>11 significant has the same meaning it has as is</p> <p>12 common normal usage in the English language.</p> <p>13 MR. DELAQUIL: Would you please reread</p> <p>14 the question.</p> <p>15 (The record was read back.)</p> <p>16 MS. STEWART: Same objection.</p> <p>17 THE WITNESS: The answer is I really</p> <p>18 don't remember.</p> <p>19 MR. DELAQUIL: Okay. Would you hand me</p> <p>20 PTO 16778.</p> <p>21 (Briney Exhibit 8 was marked.)</p> <p>22</p>	<p style="text-align: right;">Page 109</p> <p>1 applications?</p> <p>2 A. Well, Greg -- it looks like Greg wrote</p> <p>3 the email. So I can only guess at what he meant.</p> <p>4 Q. Not speculating, what -- did you believe</p> <p>5 that this decision was tangentially related to the</p> <p>6 applications of Mr. Hyatt's that you were</p> <p>7 examining?</p> <p>8 A. I don't want to contradict Greg's</p> <p>9 statement, but it's only tangentially related</p> <p>10 because I'm guessing that Hyatt's name is attached</p> <p>11 to whatever this links to.</p> <p>12 Q. So it's tangentially related only as</p> <p>13 much as Mr. Hyatt was the party in this litigation</p> <p>14 and was the applicant on the patent applications.</p> <p>15 A. Right.</p> <p>16 Q. Okay. His claims didn't turn on issues</p> <p>17 of tax law or choice of law, not the claims in the</p> <p>18 applications?</p> <p>19 A. The applications I examined? Yeah, they</p> <p>20 don't touch tax law or choice of law.</p> <p>21 Q. That probably wouldn't be patentable</p> <p>22 subject matter, would it?</p>

28 (Pages 106 to 109)

Page 110	Page 112
<p>1 MS. STEWART: Objection. Calls for a 2 legal conclusion. 3 MR. DELAQUIL: I'll withdraw that 4 question. 5 MS. STEWART: That's rhetorical. 6 BY MR. DELAQUIL: 7 Q. It goes on and says, "I commend this 8 decision to your attention to consider the 9 similarities in litigation style." 10 What relevance did the litigation style 11 that Mr. Morse referenced have to your examination 12 of the patent applications? 13 A. Well, I'm trying to put myself back in 14 the mind set of a patent examiner in 15 September 2014 and, unfortunately, it's hard to 16 pinpoint where we were in our decision making 17 process there. 18 So maybe it had some relevance. It's 19 hard to say. 20 Q. Hard to say. 21 So it may have been relevant, then, to 22 the examination of the patent applications?</p>	<p>1 Q. And that has nothing to do with 2 examination of patent application; right? 3 A. It would only have -- if they said 4 something, again, that would related to the facts 5 of my case. 6 Q. By the facts of the case, you mean the 7 facts of the application? 8 A. Yeah. 9 MR. DELAQUIL: Would you hand me PTO 10 16747, please. 11 (Briney Exhibit 9 was marked.) 12 BY MR. DELAQUIL: 13 Q. The court reporter just handed you an 14 Exhibit marked Briney 9. It's an email from Greg 15 Morse to you and others, May 6, 2016, with the 16 forwarding an ECF bounce in the case in the 17 Eastern District of Virginia, full message, "And 18 so ends the saga. Note that this is a dismissal 19 with prejudice. This is the case discussed in a 20 hyperlink to a website called Patently-O. 21 "My assumption is that at the time the 22 original lawsuit was filed in Nevada, Mr. Hyatt</p>
Page 111	Page 113
<p>1 A. It seems like a stretch to me at first 2 glance. 3 Q. Does the PTO have examination policies 4 for a patent applicant's applications that are 5 dependent on whether the patent applicant has 6 communicated with the media? 7 A. Not that I'm aware of. 8 Q. The PTO is a government agency; right? 9 A. Yes. 10 Q. And individuals are free under the First 11 Amendment to communicate with anyone they see fit 12 regarding matters of concern to them without the 13 government altering its conduct based on that, at 14 least as a general matter; right? 15 MS. STEWART: Objection. Calls for a 16 legal conclusion. 17 THE WITNESS: Well, my understanding is 18 people can -- can speak their minds. They can't 19 yell "fire" in a crowded theater. 20 BY MR. DELAQUIL: 21 Q. They can issue press releases; right? 22 A. Yes.</p>	<p>1 made press releases leading to these articles." 2 Do you know what Patently-O is? 3 A. Yes, I'm familiar with it. 4 Q. What is it? 5 A. Patently-O it's a blog or online 6 magazine, if you will, that basically posts 7 articles about patent law topics and related 8 things, copyright, trademarks sometimes as well. 9 Q. Do you regularly visit the Patently-O 10 website? 11 A. Yes. It's a good source of information. 12 Q. Reputable website? 13 A. I consider it to be one. 14 Q. It's not like a crazy person's blog on 15 Word Press? 16 A. No. My understanding is that the 17 proprietor is a patent law professor. 18 Q. What did Mr. Morse's assumption that 19 Mr. Hyatt made press releases leading to these 20 articles have to do with the examination of 21 Mr. Hyatt's patent applications? 22 MS. STEWART: Objection. Assumes a fact</p>

29 (Pages 110 to 113)

Page 114	Page 116
<p>1 not established.</p> <p>2 BY MR. DELAQUIL:</p> <p>3 Q. Let's read the last sentence in the top</p> <p>4 email. "My" -- and the author of this email is</p> <p>5 Greg Morse -- "assumption is that at the time the</p> <p>6 original lawsuit was filed in Nevada, Mr. Hyatt</p> <p>7 made press releases leading to these articles."</p> <p>8 What did Mr. Morse's assumption that</p> <p>9 Mr. Hyatt made press releases leading to these</p> <p>10 articles, including the article in Patently-O,</p> <p>11 have to do with the examination of Mr. Hyatt's</p> <p>12 patent applications?</p> <p>13 MS. STEWART: Objection. Assumes a fact</p> <p>14 that's not been established.</p> <p>15 THE WITNESS: When I read this email,</p> <p>16 all I see is Greg saying to us, here's some news</p> <p>17 articles. Mr. Hyatt may have had a hand in it.</p> <p>18 My assumption is that Mr. Hyatt made press</p> <p>19 releases leading to these articles.</p> <p>20 MR. DELAQUIL: Okay. Objection.</p> <p>21 Nonresponsive.</p> <p>22 Would you please read back the question.</p>	<p>1 email, for instance, it's more of an interest</p> <p>2 piece.</p> <p>3 BY MR. DELAQUIL:</p> <p>4 Q. That wasn't the question I asked.</p> <p>5 Is there any information about Mr. Hyatt</p> <p>6 that you would not believe is related to the</p> <p>7 examination of his patent applications?</p> <p>8 MS. STEWART: Objection. Argumentative.</p> <p>9 THE WITNESS: Of course.</p> <p>10 BY MR. DELAQUIL:</p> <p>11 Q. Like what?</p> <p>12 A. Well, we don't need to know everything</p> <p>13 about Mr. Hyatt. But sometimes, as I said earlier</p> <p>14 in my testimony, human curiosity.</p> <p>15 Q. You don't need to know what type of food</p> <p>16 he eats; right?</p> <p>17 A. No.</p> <p>18 MS. STEWART: Objection. Argumentative.</p> <p>19 BY MR. DELAQUIL:</p> <p>20 Q. You don't need to know anything about</p> <p>21 his marital status; right?</p> <p>22 MS. STEWART: Objection. Argumentative.</p>
Page 115	Page 117
<p>1 (The record was read back.)</p> <p>2 MS. STEWART: Objection. Assumes a fact</p> <p>3 that hasn't been established.</p> <p>4 THE WITNESS: Well, I have a hard time</p> <p>5 answering that because I'm -- what did it have to</p> <p>6 do with? I mean, it's related to our work in the</p> <p>7 sense that it's, here's some news about Hyatt and</p> <p>8 what we're working on.</p> <p>9 I think this article, Hyatt versus US</p> <p>10 Patent and Trademark Office, Three Generations of</p> <p>11 Board Examinations are Enough," I think that was</p> <p>12 an article about something that we had done and</p> <p>13 Hyatt's initial response.</p> <p>14 So it's just keeping us abreast of some</p> <p>15 developments in the media concerning what we're</p> <p>16 working on.</p> <p>17 BY MR. DELAQUIL:</p> <p>18 Q. Is any information at all concerning</p> <p>19 Mr. Hyatt related to your application of his</p> <p>20 patent examination?</p> <p>21 MS. STEWART: Objection. Argumentative.</p> <p>22 THE WITNESS: I just said like this</p>	<p>1 BY MR. DELAQUIL:</p> <p>2 Q. Right?</p> <p>3 A. Those are things that are not related to</p> <p>4 examining his applications.</p> <p>5 Q. Have you ever searched the Internet for</p> <p>6 news articles about Mr. Hyatt?</p> <p>7 A. Yes, I have.</p> <p>8 Q. Did you do that on PTO time?</p> <p>9 MS. STEWART: Objection. Argumentative.</p> <p>10 THE WITNESS: I really don't remember.</p> <p>11 BY MR. DELAQUIL:</p> <p>12 Q. Do you know what the term "PTO time" is?</p> <p>13 A. Yes.</p> <p>14 Q. So you've searched the Internet for</p> <p>15 articles about Mr. Hyatt; correct?</p> <p>16 How many times have you done that?</p> <p>17 A. I don't know. Three, four times.</p> <p>18 Q. What was the purpose of that?</p> <p>19 A. Human curiosity. Just trying to</p> <p>20 understand like what I'm working on.</p> <p>21 Q. Fair to say when you were searching the</p> <p>22 Internet for articles about Mr. Hyatt, you weren't</p>

30 (Pages 114 to 117)

<p style="text-align: right;">Page 118</p> <p>1 examining his applications?</p> <p>2 MS. STEWART: Objection. Argumentative.</p> <p>3 This is getting way outside the bounds of</p> <p>4 appropriate discovery for this limited deposition.</p> <p>5 THE WITNESS: When I searched the</p> <p>6 Internet, it's all tied to the patents. I'm</p> <p>7 looking for just Hyatt and patent.</p> <p>8 If something turns up, I click on it,</p> <p>9 see if it's relevant. I might find something</p> <p>10 interesting; might not.</p> <p>11 BY MR. DELAQUIL:</p> <p>12 Q. Does the PTO have a policy on patent</p> <p>13 examiners searching for information on patent</p> <p>14 applicants?</p> <p>15 MS. STEWART: Objection. Vague.</p> <p>16 THE WITNESS: Do they have -- well, I</p> <p>17 mean, not that I'm aware of. Searching for patent</p> <p>18 applicants is part of prior art searching and</p> <p>19 researching the case because you need to look for</p> <p>20 articles they may have written, things that could</p> <p>21 create a bar against their right to a patent.</p> <p>22</p>	<p style="text-align: right;">Page 120</p> <p>1 important to him have to do with your examination</p> <p>2 of his patent applications?</p> <p>3 MS. STEWART: Objection.</p> <p>4 Mischaracterizes the witness' testimony.</p> <p>5 THE WITNESS: Well, they don't affect my</p> <p>6 day-to-day operation or like the facts or the law.</p> <p>7 It's just more of a treat the guy with respect.</p> <p>8 MR. DELAQUIL: Let's go to another</p> <p>9 exhibit.</p> <p>10 (Briney Exhibit 11 was marked.)</p> <p>11 BY MR. DELAQUIL:</p> <p>12 Q. You've been handed Exhibit Briney 11.</p> <p>13 Is this one of the emails you reviewed</p> <p>14 in preparation for your deposition?</p> <p>15 A. It is.</p> <p>16 Q. Okay. And this is --</p> <p>17 A. Oh, wait. I'm sorry. I take that back.</p> <p>18 I didn't review this particular one for the</p> <p>19 deposition.</p> <p>20 Q. Who is Greg Morse -- strike that. We</p> <p>21 know who Greg Morse is.</p> <p>22 Who is Jamie Atala?</p>
<p style="text-align: right;">Page 119</p> <p>1 BY MR. DELAQUIL:</p> <p>2 Q. So that's a legitimate purpose relating</p> <p>3 to examination within PTO policy, in your view?</p> <p>4 A. Yes.</p> <p>5 Q. Have you found any articles on the</p> <p>6 Internet that you believe provide a unique glimpse</p> <p>7 into Mr. Hyatt's mind?</p> <p>8 A. Yes.</p> <p>9 Q. What articles were those?</p> <p>10 A. Well, I found one article that talked</p> <p>11 about his divorce.</p> <p>12 Q. What unique glimpses into Mr. Hyatt's</p> <p>13 mind did that article give you?</p> <p>14 A. That suggested to me his patents are</p> <p>15 very important to him or his applications, however</p> <p>16 you want to characterize it.</p> <p>17 MR. DELAQUIL: Randal, would you hand me</p> <p>18 the inventor's divorce article.</p> <p>19 (Briney Exhibit 10 was marked.)</p> <p>20 BY MR. DELAQUIL:</p> <p>21 Q. Before we get to this article, what does</p> <p>22 the fact that Mr. Hyatt believes his patents are</p>	<p style="text-align: right;">Page 121</p> <p>1 A. Jamie is an examiner, and she worked in</p> <p>2 our unit, 2615.</p> <p>3 Q. Who is Giovanna Colan?</p> <p>4 A. She's an examiner that works in our</p> <p>5 unit.</p> <p>6 Q. Who is Matthew David?</p> <p>7 A. He's an examiner that works in our unit.</p> <p>8 Q. Who is Nishant Divecha?</p> <p>9 A. He's an examiner that works in our unit.</p> <p>10 Q. Who is Ram Khuu?</p> <p>11 A. He is also an examiner that works in our</p> <p>12 unit.</p> <p>13 Q. Who is Hien Dieu Thi Khuu?</p> <p>14 A. She is an examiner that works in our</p> <p>15 unit.</p> <p>16 Q. Does she go by the name Cindy Khuu?</p> <p>17 A. Yes.</p> <p>18 Q. Who is John Lee?</p> <p>19 A. He is an examiner that works in our</p> <p>20 unit.</p> <p>21 Q. Who is Phillip Lee?</p> <p>22 A. An examiner in our unit.</p>

31 (Pages 118 to 121)

Page 122	Page 124
<p>1 Q. Who is George Neurauter?</p> <p>2 A. An examiner in the unit.</p> <p>3 Q. Who is Ronnoreay Pich?</p> <p>4 A. An examiner in the unit.</p> <p>5 Q. Who is Elizabeth Rosen?</p> <p>6 A. Examiner in the unit.</p> <p>7 Q. Who Michael Roswell?</p> <p>8 A. Examiner in the unit.</p> <p>9 Q. Who is Michael Rutland-Wallis?</p> <p>10 A. Examiner in the unit.</p> <p>11 Q. Who is David Welch?</p> <p>12 A. An examiner in the unit.</p> <p>13 Q. Were there any examiners in the unit?</p> <p>14 By the "unit," I presume you mean group 2615?</p> <p>15 A. Yes.</p> <p>16 Q. Were there any examiners in the unit</p> <p>17 that you didn't include on this email?</p> <p>18 A. March 10, 2016, I don't remember. Maybe</p> <p>19 I forgot one person, but it looks pretty complete.</p> <p>20 Q. Okay. And your boss, Greg Morse?</p> <p>21 A. Yes.</p> <p>22 Q. And your message to them was, "I've been</p>	<p>1 BY MR. DELAQUIL:</p> <p>2 Q. How does sending an article to every</p> <p>3 single person examining Mr. Hyatt's patents on</p> <p>4 March 10, 2016 treating Mr. Hyatt with respect?</p> <p>5 MS. STEWART: Objection. Argumentative.</p> <p>6 THE WITNESS: Well, I said it right</p> <p>7 there. It's in my email.</p> <p>8 BY MR. DELAQUIL:</p> <p>9 Q. You said you were circulating this to</p> <p>10 treat him with respect.</p> <p>11 You said what?</p> <p>12 A. I said he places great value on his</p> <p>13 patent applications.</p> <p>14 Q. Do you know how much money Mr. Hyatt has</p> <p>15 made licensing his patents?</p> <p>16 A. I don't know.</p> <p>17 Q. Have you heard any figures ascribed to</p> <p>18 it?</p> <p>19 A. Many millions.</p> <p>20 Q. Seems pretty obvious he places value on</p> <p>21 his patent applications. He's licensed very</p> <p>22 valuable technology; right?</p>
Page 123	Page 125
<p>1 meaning to share these links for a while. The</p> <p>2 first points to a collection of articles about</p> <p>3 Hyatt. The second is one of those articles. I</p> <p>4 flagged the second one because it more than</p> <p>5 anything else I've read provides a unique glimpse</p> <p>6 into Hyatt's mind and the value he places on his</p> <p>7 patent applications."</p> <p>8 A. Yes.</p> <p>9 Q. That second link is essentially an</p> <p>10 article about Mr. Hyatt's divorce settlement?</p> <p>11 MS. STEWART: Objection. Assumes a fact</p> <p>12 that hasn't been established.</p> <p>13 BY MR. DELAQUIL:</p> <p>14 Q. Is that right?</p> <p>15 A. Well, it is, yeah, it is a link. And my</p> <p>16 recollection is that's what it's about.</p> <p>17 Q. So earlier, you testified that you</p> <p>18 circulated this article about Mr. Hyatt's divorce</p> <p>19 settlement to treat Mr. Hyatt with respect.</p> <p>20 That was your testimony, wasn't it?</p> <p>21 A. Yes.</p> <p>22 MS. STEWART: Objection.</p>	<p>1 A. Um-hum.</p> <p>2 MS. STEWART: Objection. Argumentative.</p> <p>3 BY MR. DELAQUIL:</p> <p>4 Q. So did Mr. Morse respond to this email</p> <p>5 in any way?</p> <p>6 A. I don't think so.</p> <p>7 Q. Did you think that the article you sent</p> <p>8 was in any respect siliceous?</p> <p>9 A. I would have to review it. That wasn't</p> <p>10 my --</p> <p>11 Q. Let's go through it.</p> <p>12 MS. STEWART: Objection. We're getting</p> <p>13 outside the scope of discovery here. And also I</p> <p>14 want to note for the record that Counsel is</p> <p>15 raising his voice at the witness.</p> <p>16 MR. DELAQUIL: This deposition is</p> <p>17 videotaped, so you'll have all the evidence you</p> <p>18 would like if you believe I'm acting improperly,</p> <p>19 Ms. Stewart.</p> <p>20 BY MR. DELAQUIL:</p> <p>21 Q. Let's go to Briney Exhibit 10.</p> <p>22 Do you recognize this document,</p>

32 (Pages 122 to 125)

Page 126	Page 128
<p>1 Mr. Briney?</p> <p>2 A. Yeah, it looks familiar.</p> <p>3 Q. Go to the bottom left of Exhibit 10.</p> <p>4 You've got a hyperlink there.</p> <p>5 A. (Witness complies.)</p> <p>6 Q. Does that hyperlink match the hyperlink</p> <p>7 in the email you forwarded in exhibit -- that we</p> <p>8 have used as the Exhibit Briney 10?</p> <p>9 A. It looks the same.</p> <p>10 Q. So this is the article.</p> <p>11 So Exhibit 11 is the article you</p> <p>12 forwarded to every person examining Mr. Hyatt's</p> <p>13 patent applications at the time; correct?</p> <p>14 A. (Nodding.)</p> <p>15 Q. Let's go paragraph by paragraph.</p> <p>16 MS. STEWART: No, we're not going to do</p> <p>17 that. That's harassing the witness.</p> <p>18 MR. DELAQUIL: I suggest you file a</p> <p>19 motion to suspend. We're going paragraph by</p> <p>20 paragraph. Please, let's get on the phone with</p> <p>21 the judge.</p> <p>22 MS. STEWART: Okay. Sure.</p>	<p>1 salacious, I think that's harassing and</p> <p>2 argumentative and I would object to that.</p> <p>3 And I also note for the record that we</p> <p>4 have limited time here today and these kind of</p> <p>5 last-minute depositions to engage in this kind of</p> <p>6 fore --</p> <p>7 MR. DELAQUIL: I don't intend to ask</p> <p>8 Mr. Briney any questions about salaciousness.</p> <p>9 BY MR. DELAQUIL:</p> <p>10 Q. In Exhibit 10, you said this article</p> <p>11 more than anything else you read provides a unique</p> <p>12 glimpse into Hyatt's mind.</p> <p>13 First paragraph, "The ex-wife of the</p> <p>14 inventor of the microprocessor which</p> <p>15 revolutionized the computer industry two decades</p> <p>16 ago lost a bid Tuesday to renegotiate her 1975</p> <p>17 divorce settlement to give her a share of the</p> <p>18 former Orange County man's nearly 90 million in</p> <p>19 newfound royalty payments."</p> <p>20 Is that the paragraph that gave you a</p> <p>21 unique glimpse into Mr. Hyatt's mind?</p> <p>22 MS. STEWART: Objection. Argumentative.</p>
Page 127	Page 129
<p>1 MR. DELAQUIL: Let's go off the record.</p> <p>2 THE VIDEOGRAPHER: Going off the record</p> <p>3 at 11:56 a.m.</p> <p>4 (Recess from 11:56 a.m. to 11:56 a.m.)</p> <p>5 THE VIDEOGRAPHER: We're going back on</p> <p>6 the record at 11:56 a.m.</p> <p>7 MS. STEWART: If the intent of counsel</p> <p>8 for Mr. Hyatt is to walk through a news article in</p> <p>9 the LA Times sentence by sentence to ask the</p> <p>10 witness whether or not he thinks it's salacious, I</p> <p>11 think that's harassing of the witness.</p> <p>12 I certainly have no objections to</p> <p>13 Counsel asking the witness about anything in the</p> <p>14 article that he considered to be relevant or</p> <p>15 intended to refer to in his email of March 10,</p> <p>16 2016.</p> <p>17 But to the extent counsel would like to</p> <p>18 ask any questions about this document that relates</p> <p>19 to the email, I have absolutely no objection.</p> <p>20 If, in fact, as counsel stated, he wants</p> <p>21 to go through every single sentence of the news</p> <p>22 article to ask the witness whether or not it's</p>	<p>1 These are not serious questions for the witness.</p> <p>2 THE WITNESS: And I don't remember. I</p> <p>3 read the whole article. I breezed through it.</p> <p>4 BY MR. DELAQUIL:</p> <p>5 Q. Why don't you read the article now and</p> <p>6 tell me which aspects of the article gave you a</p> <p>7 unique glimpse into Mr. Hyatt's mind.</p> <p>8 MS. STEWART: I believe the witness just</p> <p>9 said he doesn't remember.</p> <p>10 MR. DELAQUIL: He can read the article</p> <p>11 and if his recollection is refreshed, then he'll</p> <p>12 be able to answer that question.</p> <p>13 We don't have much longer for this</p> <p>14 deposition.</p> <p>15 MS. STEWART: If we can go off the</p> <p>16 record for one second while he's reading that.</p> <p>17 MR. DELAQUIL: Sure.</p> <p>18 THE VIDEOGRAPHER: We're going off the</p> <p>19 record at 12:01 p.m.</p> <p>20 (Recess from 12:01 p.m. to 12:01 p.m.)</p> <p>21 THE VIDEOGRAPHER: We're going back on</p> <p>22 the record at 12:01 p.m.</p>

33 (Pages 126 to 129)

Page 130	Page 132
<p>1 MS. STEWART: I think we should also 2 note for the record, Mr. Levine is present. He 3 came in some time ago to witness the deposition. 4 I just want to state that for the record. 5 MR. DELAQUIL: Duly noted. 6 THE WITNESS: I think what jumped out at 7 me when I look over this, again, is probably the 8 second to last paragraph was that, "Letteu sided 9 with Hyatt's argument that the settlement was fair 10 because Maystead got concrete assets, the house 11 and alimony payments of \$200 a month, while Hyatt 12 received only the patents. The patent 13 applications had to be upheld in future court 14 proceedings and were speculative value at the time 15 of the divorce, Hyatt had argued." 16 That's what jumped out at me, was that 17 his applications were like his baby. He valued 18 those greatly. That's ... 19 BY MR. DELAQUIL: 20 Q. Nothing else in the article? 21 A. Well, yeah. There's other things in the 22 article that I could talk about, but that was not</p>	<p>1 article could be prejudicial towards Mr. Hyatt 2 among other patent examiners? 3 A. I didn't give that a thought, no. 4 Q. Sitting here today, are you now 5 concerned that the sharing of his article could 6 have been prejudicial towards Mr. Hyatt? 7 MS. STEWART: Objection. Argumentative. 8 THE WITNESS: I don't know. It's an 9 article about two people who had a terrible 10 falling out. I can imagine some people might get 11 upset about that. I don't know. 12 I'm not someone who jumps on a news 13 article and thinks everything is a fact. I like 14 to look at both sides, figure out what things are, 15 try to come up to a conclusion. 16 BY MR. DELAQUIL: 17 Q. Having reread the article today, you 18 recognize that it may have been prejudicial 19 towards Mr. Hyatt to send this article to other 20 patent examiners in group 2615? 21 MS. STEWART: Objection. That misstates 22 the witness' testimony and is argumentative.</p>
Page 131	Page 133
<p>1 what I cared about. 2 Q. So your testimony is that you cared 3 about only that last paragraph? 4 A. The reason I shared this article, yeah. 5 And the other reason I shared the article was so 6 my other fellow examiners can see who they're 7 working with on a daily basis, basically. 8 Q. So you thought the other examiners 9 should read an article that includes one, two, 10 three, four, five, six, seven, eight, nine, 10, 11 11, 12, 13, 14 -- 13 unrelated paragraphs, 12 including allegations of criminal conduct made 13 against Mr. Hyatt, so that they could hear that 14 Mr. Hyatt thought that his patent applications 15 were valuable? 16 MS. STEWART: Objection. 17 Mischaracterizes the witness' testimony. Assumes 18 facts not in evidence. And also is argumentative. 19 THE WITNESS: Yeah. I sent it for what 20 I stated here is why I sent it. 21 BY MR. DELAQUIL: 22 Q. Were you concerned that sharing this</p>	<p>1 THE WITNESS: As I said, I'm looking at 2 this and I see negative facts. But I also see 3 positive facts. And I don't see any establishment 4 that Hyatt is a bad person in here or something 5 that would be prejudicial like that. 6 It's possible someone could take that 7 path, but I don't know. I don't know how my other 8 examiners or my fellow examiners reacted. 9 BY MR. DELAQUIL: 10 Q. Did any of your fellow examiners respond 11 to the email that we've labeled as Exhibit 12 Briney 10? 13 A. I believe I got one response to it, yes. 14 Q. From who? 15 A. From Cindy. 16 Q. What was Cindy's response? 17 A. I don't remember what she said. 18 Q. Was that response by email? 19 A. I believe it was, yes. 20 Q. There's one question I asked earlier 21 that I don't believe I ever got a yes-or-no answer 22 to.</p>

34 (Pages 130 to 133)

Page 134

1 Earlier, you testified to sending the
2 email marked as Exhibit 10 which included a link
3 to the article marked as Exhibit 11 was treating
4 Mr. Hyatt with respect.

5 Was that your testimony, Mr. Briney?

6 MS. STEWART: Objection. I'm sorry. I
7 think you messed up the exhibit numbers.

8 MR. DELAQUIL: The question is correct
9 on exhibit numbers. I can have the court reporter
10 restate if it would be helpful to you.

11 (The record was read back.)

12 THE WITNESS: Yeah. I see what the
13 question was. This one is 11. This one is 10
14 (indicating).

15 BY MR. DELAQUIL:

16 Q. Got it. You are exactly correct. So
17 let me ask it again. I want to make sure I
18 understand your earlier testimony, Mr. Briney.

19 Was it your earlier testimony that
20 sending the email marked as Exhibit 11 that
21 included a link to the article marked Exhibit
22 Briney 10 treating Mr. Hyatt with respect?

Page 135

1 A. My motivation for sending the email was
2 for people to understand this and see that
3 Mr. Hyatt places a great value on his patent
4 applications.

5 I don't -- I mean, the only reason I
6 could think to do that was you got to treat this
7 guy with respect. He doesn't deserve derision,
8 don't paint him into a corner. Treat him fairly.
9 Look at the facts.

10 MR. DELAQUIL: I think we're done. Give
11 me one minute.

12 I'll be back in just one moment. We can
13 go off the record.

14 THE VIDEOGRAPHER: We're going off the
15 record at 12:09 p.m.

16 (Recess from 12:09 p.m. to 12:10 p.m.)

17 THE VIDEOGRAPHER: We're going back on
18 the record at 12:11 p.m.

19 BY MR. DELAQUIL:

20 Q. Mr. Briney, right before we broke, you
21 basically testified something to the effect of you
22 wanted to be sure Mr. Hyatt didn't receive

Page 136

1 derision or that he didn't deserve derision.

2 Do you remember that testimony?

3 A. Yes.

4 Q. Have you heard anyone at the Patent and
5 Trademark Office refer to Mr. Hyatt in a derisive
6 manner?

7 A. I wouldn't say like they weren't -- I
8 think it kind of goes back to the question of is
9 submarine or submariner pejorative.

10 Sometimes I had the sense that people
11 were looking at him badly.

12 Q. Who were the people you had a sense were
13 looking at Mr. Hyatt badly?

14 A. I don't remember any specifics. Again,
15 I had conversations with all my -- well, almost
16 all my coworkers, probably half of them about
17 various things, and I just want to make sure the
18 air was -- that we were still doing our job.

19 Q. And the way to do that, in your view,
20 was to send the link to the article marked as
21 Exhibit 10?

22 A. Yeah. Maybe. Yeah, yeah.

Page 137

1 Q. You said "maybe" in your answer before.

2 What did you mean by "maybe"?

3 A. I misspoke.

4 Q. Why didn't you just send the paragraph
5 you identified, "Letteu sided with Hyatt's
6 argument that the settlement was fair because
7 Maystead got concrete assets, house and alimony
8 payments of \$200 a month while Mr. Hyatt received
9 only the patents. Patent applications had to be
10 upheld in future court proceedings and were
11 speculative value at the time of the divorce,
12 Hyatt had argued."

13 A. Because, I mean, this is a whole
14 article. I don't like to just cut little pieces
15 out.

16 Q. You thought it was important for that to
17 be viewed in the context of the article?

18 MS. STEWART: Objection.

19 Mischaracterizes the witness' testimony.

20 BY MR. DELAQUIL:

21 Q. You tell me, was that a fair way to
22 characterize your testimony, Mr. Briney?

35 (Pages 134 to 137)

Page 138

1 A. I don't like to cut things out.
 2 Q. Earlier in the context of this
 3 discussion, you referred to "the team." You sent
 4 the email to "the team."

5 Do you recall that?

6 A. Well, we talked about all the examiners
 7 in the -- the TO list.

8 Q. You consider them a team?

9 A. Yeah. We're part of an art unit.

10 Q. So the team essentially meant group
 11 2615; correct?

12 A. Yes.

13 Q. You used the word "team."

14 Do you mean it in the sense that you
 15 were all working towards a common goal?

16 MS. STEWART: Objection.

17 Mischaracterizes the witness' testimony.

18 THE WITNESS: We're an art unit. We all
 19 work on these applications and we can help each
 20 other where there's overlaps.

21 MR. DELAQUIL: That's it. Pass the
 22 witness.

Page 139

1 EXAMINATION

2 BY MS. STEWART:

3 Q. I'm just going to ask a few follow-up
 4 questions perhaps to clarify your testimony.

5 When you talked earlier about
 6 applications that are assigned to you, and
 7 Mr. DeLaquil gave you a list of applications, have
 8 the applications that have been assigned to you
 9 during your period of working in this particular
 10 art unit varied over time?

11 A. No, not too much. I believe -- I
 12 believe I was first assigned all the applications
 13 that were directly children of 05/849,812.

14 And then I also was assigned a few
 15 months, I don't remember exactly when I was then
 16 assigned 05/302,771.

17 So that came later. I'm not sure if
 18 anyone else had it before me.

19 Q. At the time that the applications were
 20 assigned to you, approximately, if you recall, how
 21 many claims were included in those applications
 22 cumulatively?

Page 140

1 A. In the digital audio family, there's
 2 about 18 applications. I think there's roughly
 3 5,000 total claims.

4 Q. And based on your prior experience in
 5 the office, is that an unusual number of claims
 6 for application?

7 A. Yeah. Divvied up among all the
 8 applications, it is a large amount, very unusual,
 9 and something I never seen before I started
 10 working on this project.

11 Q. What's the volume of the application
 12 file histories that you had to read in those
 13 cases?

14 A. Well, they're all a little different.
 15 Obviously, 05/849,812 is the oldest. That one
 16 dates back to 1977. I think it was November 1977,
 17 it was filed.

18 That one has a more extensive
 19 prosecution history. It's also very complex.
 20 There's oftentimes related appeals up to the
 21 Federal Circuit, lots of them. The examiner
 22 answers and stuff like that.

Page 141

1 But how voluminous is it? Do you want a
 2 page number? I don't know that I can do that.

3 Q. Can you give me kind of a ballpark of
 4 the 18 applications in terms of size and also in
 5 terms of separate documents?

6 MR. DELAQUIL: Objection. Compound.

7 THE WITNESS: Well, in terms of page
 8 numbers, I mean, it's got to be thousands of pages
 9 for each. In terms of separate documents, you
 10 have the initial filings. You have preliminary
 11 and supplemental filings before an office action
 12 was issued. Then you have like the initial office
 13 action: Sometimes there's a restriction
 14 requirement before the office action. Then
 15 there's like 129 filings.

16 So after things would go from nonfinal
 17 to final, applicant could file the 129 to reopen
 18 prosecution.

19 So when you tally it all up, you end up
 20 with 50 to 100 documents of substance that you
 21 have to go through when you consider all the claim
 22 amendments and everything.

36 (Pages 138 to 141)

Page 142	Page 144
<p>1 That's where a lot of our work comes in.</p> <p>2 It's looking at the actual responses. The</p> <p>3 substantive responses. There would be, you know,</p> <p>4 five to ten substantive responses in each one,</p> <p>5 which when you're jumping into an application that</p> <p>6 is very difficult to manage especially when you</p> <p>7 have to relate it to 18 other or 17 other</p> <p>8 applications that are closely related.</p> <p>9 BY MS. STEWART:</p> <p>10 Q. You said 50 to 100 substantive.</p> <p>11 So that could be as many as 1800</p> <p>12 different substantive office actions that you're</p> <p>13 juggling across the 18 applications?</p> <p>14 MR. DELAQUIL: Objection. Form.</p> <p>15 THE WITNESS: No.</p> <p>16 MR. DELAQUIL: I'm just trying to</p> <p>17 understand.</p> <p>18 THE WITNESS: So office action-wise,</p> <p>19 there wouldn't be that many office actions.</p> <p>20 BY MS. STEWART:</p> <p>21 Q. Substantive documents, you said 50 to</p> <p>22 100?</p>	<p>1 A. Yes, I have.</p> <p>2 Q. And earlier, Mr. DeLaquil asked you</p> <p>3 about, you know, a SPE's expertise -- let me try</p> <p>4 and phrase this properly.</p> <p>5 Mr. DeLaquil was -- was asking you about</p> <p>6 Mr. Morse's expertise. He's the senior at Art</p> <p>7 Unit; correct?</p> <p>8 A. Yes.</p> <p>9 Q. And you have worked in other art units.</p> <p>10 A. I have.</p> <p>11 Q. Have the SPEs in your other art units</p> <p>12 always had the same expertise that you've had?</p> <p>13 A. No, no. Sometimes yes; sometimes no.</p> <p>14 My first supervisor, because I first worked in</p> <p>15 like telephonic communications, and my supervisor</p> <p>16 there was very knowledgeable and helped mentor me</p> <p>17 in the art as well as just patent practice.</p> <p>18 Q. And that's when you didn't have</p> <p>19 signatory authority?</p> <p>20 A. That's when I was a junior. Over the</p> <p>21 years, I've had different levels of expertise.</p> <p>22 Sometimes I didn't inquire. My most recent</p>
Page 143	Page 145
<p>1 A. Right. Because you have to look at --</p> <p>2 and that's just ballpark. It's very hard to know</p> <p>3 without sitting and looking at the records.</p> <p>4 Again and every application is</p> <p>5 different. Some of them were very streamlined so</p> <p>6 there may only be like 20 things. And some would</p> <p>7 be on that higher end. It is very hard for me to</p> <p>8 sit here and ballpark right off the top of my</p> <p>9 head.</p> <p>10 Q. And earlier, Mr. DeLaquil asked --</p> <p>11 showed you some specific office actions and asked</p> <p>12 you if there were laches rejections in that</p> <p>13 particular office action.</p> <p>14 Do you recall that?</p> <p>15 A. I do.</p> <p>16 Q. And have you issued -- just at a high</p> <p>17 level, have you issued any laches rejections in</p> <p>18 any of Mr. Hyatt's applications that you've worked</p> <p>19 on?</p> <p>20 A. Yes, I have.</p> <p>21 Q. Have you issued any laches warnings in</p> <p>22 any of those applications?</p>	<p>1 supervisor before Greg, I don't believe -- I think</p> <p>2 he came from a different art area.</p> <p>3 So, in fact, I would oftentimes help him</p> <p>4 out with junior examiners that weren't familiar</p> <p>5 with the technology. I would help answer</p> <p>6 questions to help my supervisor.</p> <p>7 Q. And you testified earlier about you use</p> <p>8 best practices with respect to compact</p> <p>9 prosecution?</p> <p>10 A. Right.</p> <p>11 Q. And let's look at your time examining</p> <p>12 before Mr. Hyatt.</p> <p>13 Have you always made every plausible</p> <p>14 rejection in every office action that you've</p> <p>15 issued?</p> <p>16 A. Just in the Hyatt cases?</p> <p>17 Q. Prior to Mr. Hyatt.</p> <p>18 A. No, I don't always make every single</p> <p>19 rejection.</p> <p>20 Q. Why is that?</p> <p>21 A. Well, there's a certain amount of</p> <p>22 discretion. Sometimes you just go with the best</p>

37 (Pages 142 to 145)

Page 146	Page 148
<p>1 rejection. I can go with -- if I know I can do a</p> <p>2 103 or a 102 and that will force him to tighten up</p> <p>3 the claim language, I'm not going to necessarily</p> <p>4 do every single possible rejection unless I think</p> <p>5 that it's very important that that issue gets</p> <p>6 resolved.</p> <p>7 Because if I can kind of foresee this</p> <p>8 issue isn't going to get fixed even if you fix</p> <p>9 this issue, so there's a certain amount of</p> <p>10 discretion there where I have to decide what's the</p> <p>11 most important thing, what's going to push the</p> <p>12 case forward.</p> <p>13 Q. And so far in your application of</p> <p>14 Mr. Hyatt's -- so far in your examination of</p> <p>15 Mr. Hyatt's applications, have you ever come</p> <p>16 across a claim that you decided was allowable?</p> <p>17 A. I was close --</p> <p>18 Q. Okay. I don't want to hear about what</p> <p>19 you almost did or maybe did. I just want to know,</p> <p>20 did you ever find a claim that was allowable?</p> <p>21 A. No. I -- ultimately, no.</p> <p>22 Q. When Mr. DeLaquil asked you about time</p>	<p>1 any personal time in terms of use of your</p> <p>2 computer. Is there a little latitude there?</p> <p>3 A. Yes. There are acceptable limits of --</p> <p>4 acceptable personal uses of government resources,</p> <p>5 and we're briefed on those every so often, like</p> <p>6 every few years, get a refresher about what's</p> <p>7 acceptable use of the Internet, reading news and</p> <p>8 checking email.</p> <p>9 Q. And before you started working in the</p> <p>10 Hyatt group, how many years have you been total in</p> <p>11 the USPTO.</p> <p>12 A. I've been working at the Patent Office</p> <p>13 for 14 years.</p> <p>14 Q. How many years would that have been</p> <p>15 working on Mr. Hyatt's cases, primarily?</p> <p>16 A. Just about five now.</p> <p>17 Q. So in those nine years, have you ever</p> <p>18 discussed with your colleagues other cases you're</p> <p>19 working on?</p> <p>20 A. Yes, yes. We talk about the cases that</p> <p>21 we're working on.</p> <p>22 Q. And are those conversations always</p>
Page 147	Page 149
<p>1 and attendance policies earlier today, do you</p> <p>2 recall that?</p> <p>3 A. Yes.</p> <p>4 Q. And you work at home; correct?</p> <p>5 A. Right.</p> <p>6 Q. So are there times in the day where you</p> <p>7 are at your computer where you're not on official</p> <p>8 work time?</p> <p>9 A. Yeah. Well, during the day because I</p> <p>10 have increased flex programs. So sometimes I'm</p> <p>11 sitting at my desk, but I'm doing personal</p> <p>12 matters.</p> <p>13 Q. Because is it correct that with this</p> <p>14 flex time policy, you can take breaks during the</p> <p>15 day?</p> <p>16 A. That's correct, yes.</p> <p>17 Q. Even if you're working exactly 8.5</p> <p>18 hours, does the office give you any time for</p> <p>19 breaks or lunch or anything like that?</p> <p>20 A. Yes. We're required to take a break 30</p> <p>21 minutes for lunch every single day.</p> <p>22 Q. And does the office permit you any like</p>	<p>1 restricted specifically to the office actions or</p> <p>2 do you sometimes just discuss the cases,</p> <p>3 generally?</p> <p>4 A. We do both. Sometimes it's about the</p> <p>5 merits like, hey, what do you do here, or like,</p> <p>6 hey, you know, this is a cool idea.</p> <p>7 Q. When you were talking earlier with</p> <p>8 Mr. DeLaquil about other related 145 litigations</p> <p>9 involving Mr. Hyatt's applications, are you aware</p> <p>10 of -- I think Mr. DeLaquil was talking about</p> <p>11 litigation style.</p> <p>12 Were you aware of the lawsuits that were</p> <p>13 dismissed for failure to prosecute?</p> <p>14 A. I've been made aware of those.</p> <p>15 MR. DELAQUIL: Objection. Form.</p> <p>16 BY MS. STEWART:</p> <p>17 Q. Were you aware of those lawsuits?</p> <p>18 A. Yes. I'm aware of the others, two, I</p> <p>19 believe, I'm aware of them.</p> <p>20 Q. Do you know what "failure to prosecute"</p> <p>21 means?</p> <p>22 MR. DELAQUIL: Objection. Calls for a</p>

Page 150

1 legal conclusion.

2 MS. STEWART: You used the term. I
3 don't know how he uses it.

4 THE WITNESS: Failure to prosecute,
5 something is -- I'm not an expert -- it's more
6 because I don't do litigation.

7 But my basic understanding from reading
8 the decisions was that you have to take positive
9 steps to resolve that case and like in a period of
10 years of an action would be an example of a
11 failure to prosecute.

12 BY MS. STEWART:

13 Q. And in your nine years before you were
14 working on Mr. Hyatt's cases, were there ever any
15 situations where related litigation impacted your
16 examination in those cases?

17 A. While working -- can you repeat that?

18 Q. In your prior -- in your initial nine
19 years in the office before you started working
20 primarily on Mr. Hyatt's applications --

21 A. Yes.

22 Q. -- did you ever have situations where

Page 151

1 there was outside litigation that related to your
2 cases?

3 A. No. I don't think I had any cases quite
4 like that. I had some where there were related
5 applications that another examiner in my art unit
6 was working on and we would have like experts come
7 in. Like, the applicant would bring in an expert,
8 and he would sit down.

9 That's really the closest. I don't
10 think I have any where there was litigation, like
11 ongoing litigation like 145 litigation.

12 Q. What about like an administrative appeal
13 before the USPTO?

14 A. Yes. I know one instance when we were
15 all, me and at least one other examiner, our
16 applications were being appealed at the same time
17 from the same applicant.

18 So we had to kind of be on the same page
19 about like our understanding of things or we tried
20 to be, try and help each other because there was a
21 lot of testimony from experts.

22 So we wanted to make sure that we had

Page 152

1 someone take advantage of the resources you have
2 basically to get a good understanding.

3 MS. STEWART: I have no more questions
4 subject to you -- if you have more questions.

5 MR. DELAQUIL: I've got a few follow-up
6 questions.

7 RE-EXAMINATION

8 BY MR. DELAQUIL:

9 Q. A few follow-up questions.

10 During Ms. Stewart's examination, you
11 mentioned that some of the applications you're
12 examining had previously been to the Board of
13 Patent Appeals and Interferences. Is that
14 correct?

15 A. Yes. I believe --

16 MS. STEWART: I'm sorry. I don't recall
17 him testifying about Hyatt's cases going to court.
18 I asked pre-Hyatt cases.

19 MR. DELAQUIL: He did. The record will
20 speak on this. I'll ask it a different way, if
21 you want.

22

Page 153

1 BY MR. DELAQUIL:

2 Q. Mr. Briney, do you know if any of the
3 patent applications that you're currently
4 examining had previously been subject to an appeal
5 that Mr. Hyatt had taken to the Board of Patent
6 Appeals and Interferences?

7 A. My examinations, have they gone up to
8 the board?

9 Q. Yes.

10 A. Yes. I believe 05/302,771 has been to
11 the board. And maybe 05/849,812. Forgive me if I
12 get that wrong. It seems like it.

13 I know there was decisions in the file,
14 but now I can't recall if it was that case or just
15 a related case that got stuck in there.

16 Q. Do you know if any of them had been
17 actually issued and later withdrawn from issuance?

18 A. Any of my applications have been issued?

19 Q. Yes.

20 A. I believe -- I believe 05/849,812 had
21 received a notice of a liability.

22 Q. Do you know if Mr. Hyatt had gone so far

39 (Pages 150 to 153)

Page 154	Page 156
<p>1 as to pay the issuance fee?</p> <p>2 A. No. I didn't look up that detail. I</p> <p>3 don't know that.</p> <p>4 Q. So in the cases that have been to the</p> <p>5 board where you were assigned them, another</p> <p>6 examiner had already examined those applications</p> <p>7 and entered two rejections; is that correct?</p> <p>8 A. As a basis for going to the board, yes,</p> <p>9 there has to be two rejections of the claims. So</p> <p>10 I'm assuming, yes, the examiner did that.</p> <p>11 Q. Do you know how long that case was</p> <p>12 pending -- those cases were pending before the</p> <p>13 board?</p> <p>14 A. No.</p> <p>15 Q. Do you know how they got back to you, if</p> <p>16 they were previously subject to an appeal brief?</p> <p>17 A. Again, I'd have to look at the record to</p> <p>18 refresh my memory.</p> <p>19 Q. But Mr. Hyatt had filed appeal briefs</p> <p>20 and attempted to obtain administrative review</p> <p>21 prior to your involvement on those applications?</p> <p>22 A. Yes, I believe so.</p>	<p>1 MS. STEWART: So I think, as Counsel is</p> <p>2 aware, we're not talking about why a particular</p> <p>3 rejection was or was not issued in a specific</p> <p>4 application because that goes into hypotheticals,</p> <p>5 speculations, mental processes of the examiner,</p> <p>6 which is outside the bounds of discovery.</p> <p>7 MR. DELAQUIL: You elicited testimony</p> <p>8 from him on the concrete reasons he might not put</p> <p>9 a final rejection in other applications.</p> <p>10 MS. STEWART: Right. And I --</p> <p>11 MR. DELAQUIL: I think this is fair</p> <p>12 game.</p> <p>13 MS. STEWART: I believe if you check the</p> <p>14 transcript, I was specifically referring to</p> <p>15 applications that he examined prior to ever</p> <p>16 joining the Hyatt group. And also just at a very</p> <p>17 high level, not about any specific decision, any</p> <p>18 specific case, just about best practices, just as</p> <p>19 you had asked him.</p> <p>20 MR. DELAQUIL: In my view, you opened</p> <p>21 the door.</p> <p>22 Are you going to instruct him not to</p>
Page 155	Page 157
<p>1 Q. And in the case of '812, another</p> <p>2 examiner who had examined the file previous to you</p> <p>3 had even gone so far as to allow claims?</p> <p>4 A. Yeah. I believe that happened, yes.</p> <p>5 Q. Ms. Stewart asked you about compact</p> <p>6 prosecution.</p> <p>7 Do you recall that line of questioning?</p> <p>8 A. Yes, she did.</p> <p>9 Q. And in that testimony, you testified</p> <p>10 that prior to your involvement in the Hyatt group,</p> <p>11 you had on occasion not put every ground of</p> <p>12 rejection in a first office action; is that</p> <p>13 correct?</p> <p>14 A. Yes.</p> <p>15 Q. And you stated that the reason that you</p> <p>16 did that was because you believed it would be the</p> <p>17 best way forward on that individual application?</p> <p>18 A. Yes.</p> <p>19 Q. How did not putting prosecution laches</p> <p>20 warning or decision in application in the exhibit</p> <p>21 bearing Bates No. PTO4-29527 advance the</p> <p>22 prosecution of that patent application?</p>	<p>1 answer?</p> <p>2 MS. STEWART: I don't know how I could</p> <p>3 open the door to something about an individual</p> <p>4 Hyatt application when I asked him a question</p> <p>5 about a non-Hyatt application.</p> <p>6 So then if you are asking him a specific</p> <p>7 reason why a specific rejection was made or not</p> <p>8 made on one of Mr. Hyatt's applications, the judge</p> <p>9 clearly said that's outside discovery and it's</p> <p>10 also predecisional.</p> <p>11 So I have to instruct the witness not to</p> <p>12 answer.</p> <p>13 BY MR. DELAQUIL:</p> <p>14 Q. Will you follow your counsel's</p> <p>15 instruction?</p> <p>16 A. I will.</p> <p>17 Q. Ms. Stewart asked you about other</p> <p>18 non-Hyatt cases that you were involved in where</p> <p>19 you communicated with other examiners; is that</p> <p>20 right?</p> <p>21 A. Yes.</p> <p>22 MS. STEWART: Objection. Vague.</p>

40 (Pages 154 to 157)

Page 158

1 BY MR. DELAQUIL:

2 Q. Have you ever sent links to articles
3 about the applicants in those other cases?

4 A. I don't remember. It's a long time ago.

5 MR. DELAQUIL: That's good. I'm done.

6 RE-EXAMINATION

7 BY MS. STEWART:

8 Q. All right. I just have one limited area
9 of inquiry.

10 To follow up with Mr. DeLaquil's
11 question about the particular application where
12 evidently claims had been allowed -- deemed
13 allowable, do you recall what that application
14 number was?

15 A. The one where -- yeah, pretty sure
16 05/849,812. Sorry. It's really tough to
17 remember.

18 Q. You don't remember the number, but you
19 remember the basic application that Mr. DeLaquil
20 was asking about?

21 A. Yes.

22 Q. And do you know if subsequent to that

Page 160

1 that correct?

2 A. Again, there's multiple ways to answer
3 that: Yes. Like he could have paid the issuance
4 fee, it could have issued and that could have been
5 the end.

6 But he may have discovered later that he
7 needed to reissue the patent to correct something.
8 You can always narrow the scope, for instance, to
9 fix a problem that you detect later on after
10 issuance.

11 So he could have had reason to amend
12 afterwards, but that would be speculation. I
13 don't know what he would -- if he would do that or
14 not.

15 Q. But one thing that is not speculation is
16 if the PTO hadn't withdrawn that patent from
17 issuance, it would have been an issued patent.

18 A. If he paid the fee, yes. And if he
19 didn't submit any amendments after allowance, yes.

20 Q. I'll represent to you that the final
21 record indicates that he did pay the fee.

22 A. Okay.

Page 159

1 point in time -- do you know whether Mr. Hyatt
2 amended or withdrew any of those claims, do you
3 recall? I mean, I know it's in the record,
4 but ...

5 MR. DELAQUIL: Objection. Form.

6 THE WITNESS: I'd have to look in the
7 record to see. I think my recollection of things
8 was -- there was an allowance and then there was a
9 reopening of prosecution, I believe, a new
10 rejection, and then Mr. Hyatt would amend after
11 that.

12 That's my basic -- that's my basic
13 recollection of that fact pattern.

14 MS. STEWART: Okay.

15 MR. DELAQUIL: One follow-up question
16 from that.

17 RE-EXAMINATION

18 BY MR. DELAQUIL:

19 Q. So had the PTO not withdrawn from
20 issuance those allowed claims in the '812
21 application, a patent would have issued, and
22 Mr. Hyatt wouldn't have had anything to amend; is

Page 161

1 MS. STEWART: That's a fact not in
2 evidence. We don't have the record in front of
3 us. I object to that.

4 MR. DELAQUIL: I'm done. Thank you for
5 your time, Mr. Briney.

6 MS. STEWART: Thank you.

7 THE VIDEOGRAPHER: We're going off the
8 record at 11:40. This concludes the deposition.
9 (Whereupon, at 11:40 a.m., the taking of
10 the instant deposition ceased.)
11
12
13
14
15
16
17
18
19
20
21
22

41 (Pages 158 to 161)

Page 162

1 CERTIFICATE

2 DISTRICT OF COLUMBIA:

3
4 I, Ann Medis, Registered Professional
5 Reporter and Notary Public, hereby certify the
6 witness, WALTER FREDERICK BRINEY, III, was by me
7 first duly sworn to testify to the truth, that the
8 foregoing deposition was taken at the time and
9 place stated herein, and that the said deposition
10 was recorded stenographically by me and then
11 reduced to printing under my direction, and
12 constitutes a true record of the testimony given
13 by said witness.

14 I certify the inspection, reading and signing
15 of said deposition were NOT waived by counsel for
16 the respective parties and by the witness.

17 I certify I am not a relative or employee of
18 any of the parties, or a relative or employee of
19 either counsel, and I am in no way interested
20 directly or indirectly in this action.

21 IN WITNESS WHEREOF, I have hereunto set my
22 hand and affixed my seal of office this 29th day

Page 163

1 of September, 2017.

2
3 _____
4 Notary Public
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22

Page 164

1 TRANSPERFECT DEPOSITION SERVICES

2 216 East 45th Street

3 Suite 903

4 New York, New York 10017

5 212.400.8845

6 ERRATA SHEET

7 CASE: GILBERT HYATT v JOSEPH MATAL

8 DATE: SEPTEMBER 28, 2017

9 WITNESS: WALTER FREDERICK BRINEY, III

10 Page Line Change and reason for change:

11 _____
12 _____
13 _____
14 _____
15 _____
16 _____
17 _____
18 _____
19 _____

20 Subscribed and sworn to me this
21 _____ day of _____, 2017.

22 Notary Public

Page 165

1 ACKNOWLEDGMENT OF DEPONENT

2
3
4
5
6 I, WALTER FREDERICK BRINEY, III, do here certify
7 that I have read the foregoing pages 1 to 161 and
8 that the same is a correct transcription of the
9 answers given by me to the questions herein propounded,
10 except for the corrections or changes in form or
11 substance, if any, noted in the attached errata sheet.
12
13

14 _____
15 DATE WALTER FREDERICK BRINEY, III
16

17 Subscribed and sworn to me this
18 _____ day of _____, 2017.

19 _____
20 Notary Public
21
22

42 (Pages 162 to 165)

**UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA**

GILBERT P. HYATT,
Plaintiff,

v.

JOSEPH MATAL,
Defendant.

Civil Action No. 1:09-cv-1864 (RCL)
Civil Action No. 1:09-cv-1869 (RCL)
Civil Action No. 1:09-cv-1872 (RCL)
Civil Action No. 1:05-cv-2310 (RCL)

**DEFENDANT’S FIRST SUPPLEMENTAL OBJECTIONS AND RESPONSES TO
PLAINTIFF’S FIRST SET OF INTERROGATORIES (Nos. 1-7)**

Pursuant to Federal Rule of Civil Procedure 33, Defendant, Joseph Matal,¹ performing the functions and duties of the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office (“USPTO” or “Defendant”), by and through undersigned counsel, hereby responds to Plaintiff’s First Set of Interrogatories (Nos. 1-7) (“Interrogatories”) as follows:

GENERAL OBJECTIONS

1. Defendant objects to these Interrogatories to the extent that they seek information or materials subject to the attorney-client privilege, materials prepared in anticipation of litigation or which otherwise constitutes work product, or information which is protected by any other applicable governmental privilege, including but not limited to the deliberative process privilege.

¹ U.S. Secretary of Commerce Wilbur Ross named U.S. Patent and Trademark Office (USPTO) Associate Solicitor Joseph Matal to perform the functions and duties of the Under Secretary of Commerce for Intellectual Property and Director of the USPTO. The position became effective June 7, 2017, and followed the resignation of former USPTO Director Michelle K. Lee on June 6, 2017.

2. Defendant objects to these Interrogatories to the extent that they seek information which is neither relevant to, nor appears reasonably calculated to lead to the discovery of admissible evidence in connection with, any claim or defense of a party to this action, for it imposes an undue burden not commensurate with legitimate discovery needs.

3. Defendant objects to each Interrogatory to the extent that it seeks information or documents not within Defendant's possession, custody, or control.

4. Defendant objects to these Interrogatories to the extent that they seek information which, if disclosed, would violate a statute or regulation, such as the Privacy Act.

5. USPTO objects to each Interrogatory to the extent that it compels the USPTO to breach its confidentiality obligations under 35 U.S.C. § 122 as applied to another applicant's application.

6. Defendant objects to each Interrogatory to the extent that the information and/or documents requested have been previously provided to the Plaintiff during the administrative proceedings underlying the four patent applications in these actions and Mr. Hyatt's other related patent applications filed at the USPTO, and to the extent the information and/or documents requested are equally available to Plaintiff.

7. Defendant reserves the right to supplement, clarify, revise or correct any or all information contained in these responses should additional or different information become available through discovery or otherwise, pursuant to Fed. R. Civ. P. 26(e).

8. In providing these responses to Plaintiff's Interrogatories, Defendant does not in any manner admit or imply that he considers any of the responses hereto, or any documents produced in response, to be relevant or material to the subject matter of this action or to the

claims or defenses of any party herein, or that such discovery responses or documents are reasonably calculated to lead to the discovery of admissible evidence.

9. Defendant does not waive and hereby reserves the right to assert any and all objections to the admissibility into evidence at the trial of this action, or in any other proceeding, of any information provided in response to the Interrogatories or any document produced or referred to in response to the Interrogatories, on all grounds, including, but not limited to, relevance, materiality, and privilege.

10. Defendant objects to the Instructions, Definitions, and Interrogatories to the extent they seek to impose or modify discovery obligations in a manner inconsistent with or more extensive in scope than those required under the Federal Rules of Civil Procedure, the Local Rules of the United States District Court for the District of Columbia, and the Court's May 2, 2017, Order On Laches Discovery (*see, e.g.*, Case No. 05-2310, ECF No. 131), particularly given the limited amount of time to conduct discovery and the Court's instructions that "discovery should be limited to factual issues surrounding whether Mr. Hyatt 'deliberately and without excuse' delayed patent prosecutions that would not be contained in the administrative record or in which the parties dispute the record," and "given the quasi-judicial nature of patent proceedings and the need for an expeditious conclusion to these cases, all discovery into these issues ought be narrow and limited to factual matters-not delve into hypotheticals or speculation or the reasons, mental processes, or conclusions of the examiners or other PTO officials." *Id.* In this regard, the USPTO objects to each Interrogatory to the extent that it calls for the production of documentation that is unduly burdensome in relation to the relevance of the sought information to the USPTO's affirmative defense of prosecution laches. Moreover, as the Court limited discovery to factual matters and excluded documents and information protected by the

deliberative process privilege, the USPTO will not search for, collect, and/or produce documents protected by the deliberative process privilege.

11. The USPTO incorporates by reference every general objection set forth above into each specific objection and response. A specific objection or response may repeat a general objection for emphasis or for some other reason. The failure to include any general objection in any specific objection or response does not waive any general objection to the Interrogatory. The USPTO reserves its right to amend its responses.

RESPONSES AND SPECIFIC OBJECTIONS

Subject to and without waiving the foregoing General Objections and Qualifications, Defendant responds to Plaintiff's First Set of Interrogatories as follows:

INTERROGATORY NO. 1

Identify all patent examiners having any involvement with Mr. Hyatt's patent applications after April 8, 1995; for each such examiner, list the dates which he or she first became involved with the patent applications, ceased to be involved with the patent applications, and the patent applications with which he or she was involved.

RESPONSE TO INTERROGATORY NO. 1

Defendant objects to this Interrogatory as it seeks information contained in the administrative records of Mr. Hyatt's applications or otherwise available to the Plaintiff.

Subject to and without waiving the foregoing objections, and pursuant to Federal Rule of Civil Procedure 33(d), the USPTO has produced a document with responsive information at PTO15-0000001.

INTERROGATORY NO. 2

Identify all supervisors, managerial employees, and employees in the office of the Patent Commissioner, office of the Deputy Commissioner, Office of Patent Legal Administration, and

Office of Petitions responsible for, working on, or otherwise involved with Mr. Hyatt's patent applications after April 8, 1995; for each such supervisor, list the dates which he or she first became involved with the patent applications, ceased being involved with the patent applications, and with which patent applications he or she was involved.

RESPONSE TO INTERROGATORY NO. 2

Defendant objects to this Interrogatory as overbroad and unduly burdensome as it seeks information that has little or no relevance to the issue of prosecution laches and it imposes an undue burden not commensurate with legitimate discovery needs. Defendant objects to this Interrogatory as it seeks information contained in the administrative records of Mr. Hyatt's applications.

Subject to and without waiving the foregoing objections, the information sought is available from the administrative records of Mr. Hyatt's patent applications, which are in his possession, and which the USPTO has produced to plaintiff.

FIRST SUPPLEMENTAL RESPONSE TO INTERROGATORY NO. 2

Defendant incorporates the same objections the USPTO has previously made in response to this Interrogatory. Subject to and without waiving the foregoing objections, the USPTO supplements its response as follows:

Pursuant to Federal Rule of Civil Procedure 33(d), the USPTO has produced a document with responsive information at PTO15-0000001. The USPTO further identifies the following individuals that were involved with Mr. Hyatt's applications: Pinchus Laufer from approximately 2001-2005; Greg Morse from approximately 2013 – present; Richard Hjerpe from approximately the late-1990s to approximately 2004; Reginald Bragdon from approximately 2003 to approximately 2007.

INTERROGATORY NO. 3

Identify all file histories or portions of file histories of Mr. Hyatt's patent applications that were lost by the PTO after April 8, 1995, irrespective of whether those histories were subsequently located or reconstructed; for each such history or portion of history, please provide the date and circumstances of its loss and the discovery of its loss, whether it has been restored, and, if so, the date and circumstances of its restoration.

RESPONSE TO INTERROGATORY NO. 3

Defendant objects to this Interrogatory as overbroad and unduly burdensome as it seeks information that has little or no relevance to the issue of prosecution laches, particularly in view of the fact that, as the Court recognized, USPTO delay cannot excuse Mr. Hyatt's delay. Defendant further objects to this Interrogatory as it seeks information concerning the circumstances of transactions that occurred many years, if not decades, ago, and the information sought imposes an undue burden not commensurate with legitimate discovery needs.

Subject to and without waiving the foregoing objections, the information sought is available from the PALM records the USPTO has produced. *See* PTO15-0000003 - 0004803.

INTERROGATORY NO. 4

Identify which, if any, of Mr. Hyatt's patent applications that have been subject to or otherwise associated with the Sensitive Application Warning System ("SAWS") program or any similar program for identifying patent applications for additional scrutiny, review, or oversight; for each such application, please provide the date and nature of each program-related action to which the application was subject.

RESPONSE TO INTERROGATORY NO. 4

Defendant objects to this Interrogatory as it seeks information that has little or no relevance to the issue of prosecution laches, particularly in view of the fact that, as the Court recognized, USPTO delay cannot excuse Mr. Hyatt's delay. Defendant further objects to this

Interrogatory as it seeks information that is apparent from the administrative records of Mr. Hyatt's applications and it seeks information that is otherwise known to Mr. Hyatt. Defendant further objects to this Interrogatory as it seeks information and documents subject to the deliberative process privilege. Defendant further objects to this Interrogatory as it compels the USPTO to breach its confidentiality obligations under 35 U.S.C. § 122 as applied to another applicant's application.

Subject to and without waiving the foregoing objections, the USPTO provides the following response. The USPTO believes approximately five of Mr. Hyatt's patent applications were flagged in the SAWS program from approximately 2000-2010. None of the four applications before the Court are included in these five applications. None of Mr. Hyatt's applications are currently flagged in the SAWS program as the program has been discontinued.

FIRST SUPPLEMENTAL RESPONSE TO INTERROGATORY NO. 4

Defendant incorporates the same objections the USPTO has previously made in response to this Interrogatory. Subject to and without waiving the foregoing objections, the USPTO supplements its response as follows:

The following five applications were in the SAWS program from approximately 2000-2010:

Application Serial No. 06/181,492;

Application Serial No. 08/286,620;

Application Serial No. 08/456,138;

Application Serial No. 08/471,214;

Application Serial No. 08/471,795.

The following application was in the SAWS program in 2014: application serial 08/456,263.

The USPTO is not aware of any other Hyatt applications that were in the SAWS program.

INTERROGATORY NO. 5

For each of Mr. Hyatt's patent applications that were withdrawn from issue, including those identified in Document Request No. 7, identify the person who made the decision to withdraw it from issue and the physical location of the respective application file history (or any copy thereof) at the time of that person's decision.

RESPONSE TO INTERROGATORY NO. 5

Defendant objects to this Interrogatory as it seeks information that has little or no relevance to the issue of prosecution laches, particularly in view of the fact that, as the Court recognized, USPTO delay cannot excuse Mr. Hyatt's delay. Defendant further objects to this Interrogatory as it seeks information and documents subject to the deliberative process privilege. Defendant further objects to this Interrogatory as it seeks information contained in the administrative records of Mr. Hyatt's patent applications.

Subject to and without waiving the foregoing objections, the USPTO has no further information to provide other than what is included in the administrative record and the documents it has produced in response to Document Request No. 7.

FIRST SUPPLEMENTAL RESPONSE TO INTERROGATORY NO. 5

Defendant incorporates the same objections the USPTO has previously made in response to this Interrogatory. Subject to and without waiving the foregoing objections, the USPTO supplements its response as follows:

The following individuals were involved in the decision to withdraw from issuance U.S. Patent No. 5,625,761: Examiner Robert Harrell; SPE Parshotam Lall; Joe Rolla, Director, Group 2600.

The following individuals were involved in the decision to withdraw from issuance patent application serial no. 07/357,570: Examiner Michael Shingleton; SPE Robert Pascal; Director Rolf Hille, TC 2800; Director Gerald Goldberg, TC 2700.

The following individuals were involved in the decision to withdraw from issuance patent application serial no. 05/849,812: Bruce Lehman; Nick Godici, Director, Group 2600; Examiner Raulfe Zache; Examiner Jeffrey Brier; SPE Thomas Lee; Joe Rolla, Director, Group 2300.

The following individuals were involved in the decision to withdraw from issuance patent application serial no. 08/433,307: Examiner Terrell Fears; Nick Godici, Director, Group 2600.

INTERROGATORY NO. 6

For each alteration to or deletion of Patent Application Locating and Monitoring System (“PALM”) records relating to the examination or other action on Mr. Hyatt’s patent applications made after April 8, 1995, please provide the date and nature of the action and identify the person who requested or performed it or, if records of such alterations or deletions have not been maintained for any period of time subsequent to April 8, 1995, please identify all persons authorized to undertake such alterations or deletions and the time periods of such authorization.

RESPONSE TO INTERROGATORY NO. 6

Defendant objects to this Interrogatory as it seeks information that has little or no relevance to the issue of prosecution laches, particularly in view of the fact that, as the Court recognized, USPTO delay cannot excuse Mr. Hyatt’s delay. Defendant further objects to this Interrogatory as it seeks information and documents subject to the deliberative process privilege. Defendant further objects to this Interrogatory as it seeks information contained in the administrative records of Mr. Hyatt’s patent applications.

Subject to and without waiving the foregoing objections, the USPTO has produced responsive information at PTO15-0023599.

INTERROGATORY NO. 7

If you contend that any of the documents in the administrative records of Plaintiff's patent applications are relevant to your prosecution laches defense, identify with particularity (e.g., with a Bates number) which documents the PTO will rely upon to support its defense

RESPONSE TO INTERROGATORY NO. 7

Defendant objects to this Interrogatory as premature in that the USPTO is not obligated to identify at this time all of the documents it will rely upon to support its affirmative defense of prosecution laches. That being said, the USPTO has already identified in detail many of the documents that it believes supports its prosecution laches defense. *See, e.g.*, the USPTO's briefing in support of its motion to dismiss for prosecution laches, the USPTO's opposition to Mr. Hyatt's motion for discovery, and the USPTO's opposition to Mr. Hyatt's renewed motion for discovery, including the accompanying laches appendices provided therewith. *See, e.g.*, Laches Appendix volume 1, A200000-206906; Laches Appendix volume 2, A206907-208782. The USPTO has produced these laches appendices in response to Mr. Hyatt's discovery requests nos. 18, 19, 20, and 22. *See* PTO15-0014816-21530.

In that briefing, the USPTO stated that the administrative records of the four applications before the Court support the USPTO's prosecution laches defense. *Id.* The USPTO further stated in its briefing that it believes the administrative records of all his related patent applications support the USPTO's laches defense because they show Mr. Hyatt's pattern of repeatedly filing numerous claims amendments, with the result that his claim set ballooned to over 115,000, while at the same time rewriting many claims; shifting the claims to a different invention; and filing claims for the same invention in different applications—all of which has unreasonably delayed meaningful examination. *Id.* As the Federal Circuit has stated, a pattern of overall delay in a series of related patent applications can trigger prosecution laches. *See*

Symbol Technologies, Inc v. Lemelson Medical, Education & Research foundation, LP, 422 F.3d 1378, 1384-86 (Fed. Cir. 2005). Thus, as the file histories of Mr. Hyatt's applications show a pattern of dilatory conduct that is highly relevant to the issue of prosecution laches, the USPTO will rely on them to support its affirmative defense of prosecution laches.

Furthermore, the USPTO has identified additional specific examples of Mr. Hyatt's unreasonable conduct in its First Set of Interrogatories.

The USPTO reserves all rights to supplement this response and rely on any examples of conduct in the administrative records of Mr. Hyatt's patent applications that demonstrates a pattern of conduct that has delayed prosecution or otherwise supports the USPTO's affirmative defense of prosecution laches.

Dated: July 10, 2017

Respectfully submitted,

CHANNING D. PHILLIPS, D.C. Bar #415793
United States Attorney
for the District of Columbia

DANIEL F. VAN HORN, D.C. Bar #924092
Chief, Civil Division

By: /s/ Robert E. McBride
JASON T. COHEN, ME Bar #004465
Assistant United States Attorney
ROBERT E. McBRIDE
Special Assistant United States Attorney
ROBERT J. McMANUS
Special Assistant United States Attorney
THOMAS W. KRAUSE
Special Assistant United States Attorney
United States Attorney's Office, Civil Division
555 Fourth Street, NW
Washington, DC 20530
Tel: 202.252.2523
Fax: 202.252.2599
Email: Jason.Cohen@usdoj.gov

Counsel for Defendant

CERTIFICATE OF SERVICE

I hereby certify that on July 10, 2017, the foregoing was delivered electronically to the following counsel for Plaintiff:

Aaron M. Panner
Thomas B. Bennett
KELLOGG, HUBER, HANSEN, TODD, EVANS & FIGEL, P.L.L.C.
1615 M Street, N.W.
Suite 400
Washington, D.C. 20036
apanner@khhte.com
tbennett@khhte.com

Andrew M. Grossman
Paul M. Levine
Mark DeLaquil
Baker & Hostetler LLP
1050 Connecticut Ave., N.W.
Suite 1100
Washington, D.C. 20036
agrossman@bakerlaw.com
pmlevine@bakerlaw.com
mdelaquil@bakerlaw.com

/s/ Robert E. McBride
ROBERT E. MCBRIDE
Special Assistant United States Attorney

**UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA**

GILBERT P. HYATT,
Plaintiff,

v.

JOSEPH MATAL,
Defendant.

Civil Action No. 1:09-cv-1864 (RCL)
Civil Action No. 1:09-cv-1869 (RCL)
Civil Action No. 1:09-cv-1872 (RCL)
Civil Action No. 1:05-cv-2310 (RCL)

**DEFENDANT’S FIRST SUPPLEMENTAL OBJECTIONS AND RESPONSES TO
PLAINTIFF’S INTERROGATORY No. 7**

Pursuant to Federal Rule of Civil Procedure 33, Defendant, Joseph Matal,¹ performing the functions and duties of the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office (“USPTO” or “Defendant”), by and through undersigned counsel, hereby responds to Plaintiff’s First Set of Interrogatories (Nos. 1-7) (“Interrogatories”) as follows:

GENERAL OBJECTIONS

Defendant objects to these Interrogatories to the extent that they seek information or materials subject to the attorney-client privilege, materials prepared in anticipation of litigation or which otherwise constitutes work product, or information which is protected by any other applicable governmental privilege, including but not limited to the deliberative process privilege.

Defendant objects to these Interrogatories to the extent that they seek information which is neither relevant to, nor appears reasonably calculated to lead to the discovery of admissible

¹ U.S. Secretary of Commerce Wilbur Ross named U.S. Patent and Trademark Office (USPTO) Associate Solicitor Joseph Matal to perform the functions and duties of the Under Secretary of Commerce for Intellectual Property and Director of the USPTO. The position became effective June 7, 2017, and followed the resignation of former USPTO Director Michelle K. Lee on June 6, 2017.

evidence in connection with, any claim or defense of a party to this action, for it imposes an undue burden not commensurate with legitimate discovery needs.

Defendant objects to each Interrogatory to the extent that it seeks information or documents not within Defendant's possession, custody, or control.

Defendant objects to these Interrogatories to the extent that they seek information which, if disclosed, would violate a statute or regulation, such as the Privacy Act.

USPTO objects to each Interrogatory to the extent that it compels the USPTO to breach its confidentiality obligations under 35 U.S.C. § 122 as applied to another applicant's application.

Defendant objects to each Interrogatory to the extent that the information and/or documents requested have been previously provided to the Plaintiff during the administrative proceedings underlying the four patent applications in these actions and Mr. Hyatt's other related patent applications filed at the USPTO, and to the extent the information and/or documents requested are equally available to Plaintiff.

Defendant reserves the right to supplement, clarify, revise or correct any or all information contained in these responses should additional or different information become available through discovery or otherwise, pursuant to Fed. R. Civ. P. 26(e).

In providing these responses to Plaintiff's Interrogatories, Defendant does not in any manner admit or imply that he considers any of the responses hereto, or any documents produced in response, to be relevant or material to the subject matter of this action or to the claims or defenses of any party herein, or that such discovery responses or documents are reasonably calculated to lead to the discovery of admissible evidence.

Defendant does not waive and hereby reserves the right to assert any and all objections to the admissibility into evidence at the trial of this action, or in any other proceeding, of any

information provided in response to the Interrogatories or any document produced or referred to in response to the Interrogatories, on all grounds, including, but not limited to, relevance, materiality, and privilege.

Defendant objects to the Instructions, Definitions, and Interrogatories to the extent they seek to impose or modify discovery obligations in a manner inconsistent with or more extensive in scope than those required under the Federal Rules of Civil Procedure, the Local Rules of the United States District Court for the District of Columbia, and the Court's May 2, 2017, Order On Laches Discovery (*see, e.g.*, Case No. 05-2310, ECF No. 131), particularly given the limited amount of time to conduct discovery and the Court's instructions that "discovery should be limited to factual issues surrounding whether Mr. Hyatt 'deliberately and without excuse' delayed patent prosecutions that would not be contained in the administrative record or in which the parties dispute the record," and "given the quasi-judicial nature of patent proceedings and the need for an expeditious conclusion to these cases, all discovery into these issues ought be narrow and limited to factual matters-not delve into hypotheticals or speculation or the reasons, mental processes, or conclusions of the examiners or other PTO officials." *Id.* In this regard, the USPTO objects to each Interrogatory to the extent that it calls for the production of documentation that is unduly burdensome in relation to the relevance of the sought information to the USPTO's affirmative defense of prosecution laches. Moreover, as the Court limited discovery to factual matters and excluded documents and information protected by the deliberative process privilege, the USPTO will not search for, collect, and/or produce documents protected by the deliberative process privilege.

The USPTO incorporates by reference every general objection set forth above into each specific objection and response. A specific objection or response may repeat a general objection for

emphasis or for some other reason. The failure to include any general objection in any specific objection or response does not waive any general objection to the Interrogatory. The USPTO reserves its right to amend its responses.

RESPONSES AND SPECIFIC OBJECTIONS

Subject to and without waiving the foregoing General Objections and Qualifications, Defendant responds to Plaintiff's First Set of Interrogatories as follows:

INTERROGATORY NO. 1

Identify all patent examiners having any involvement with Mr. Hyatt's patent applications after April 8, 1995; for each such examiner, list the dates which he or she first became involved with the patent applications, ceased to be involved with the patent applications, and the patent applications with which he or she was involved.

RESPONSE TO INTERROGATORY NO. 1

Defendant objects to this Interrogatory as it seeks information contained in the administrative records of Mr. Hyatt's applications or otherwise available to the Plaintiff.

Subject to and without waiving the foregoing objections, and pursuant to Federal Rule of Civil Procedure 33(d), the USPTO has produced a document with responsive information at PTO15-0000001.

INTERROGATORY NO. 2

Identify all supervisors, managerial employees, and employees in the office of the Patent Commissioner, office of the Deputy Commissioner, Office of Patent Legal Administration, and Office of Petitions responsible for, working on, or otherwise involved with Mr. Hyatt's patent applications after April 8, 1995; for each such supervisor, list the dates which he or she first became involved with the patent applications, ceased being involved with the patent applications, and with which patent applications he or she was involved.

RESPONSE TO INTERROGATORY NO. 2

Defendant objects to this Interrogatory as overbroad and unduly burdensome as it seeks information that has little or no relevance to the issue of prosecution laches and it imposes an undue burden not commensurate with legitimate discovery needs. Defendant objects to this Interrogatory as it seeks information contained in the administrative records of Mr. Hyatt's applications.

Subject to and without waiving the foregoing objections, the information sought is available from the administrative records of Mr. Hyatt's patent applications, which are in his possession, and which the USPTO has produced to plaintiff.

FIRST SUPPLEMENTAL RESPONSE TO INTERROGATORY NO. 2

Defendant incorporates the same objections the USPTO has previously made in response to this Interrogatory. Subject to and without waiving the foregoing objections, the USPTO supplements its response as follows:

Pursuant to Federal Rule of Civil Procedure 33(d), the USPTO has produced a document with responsive information at PTO15-0000001. The USPTO further identifies the following individuals that were involved with Mr. Hyatt's applications: Pinchus Laufer from approximately 2001-2005; Greg Morse from approximately 2013 – present; Richard Hjerpe from approximately the late-1990s to approximately 2004; Reginald Bragdon from approximately 2003 to approximately 2007.

INTERROGATORY NO. 3

Identify all file histories or portions of file histories of Mr. Hyatt's patent applications that were lost by the PTO after April 8, 1995, irrespective of whether those histories were subsequently located or reconstructed; for each such history or portion of history, please provide the date and

circumstances of its loss and the discovery of its loss, whether it has been restored, and, if so, the date and circumstances of its restoration.

RESPONSE TO INTERROGATORY NO. 3

Defendant objects to this Interrogatory as overbroad and unduly burdensome as it seeks information that has little or no relevance to the issue of prosecution laches, particularly in view of the fact that, as the Court recognized, USPTO delay cannot excuse Mr. Hyatt's delay.

Defendant further objects to this Interrogatory as it seeks information concerning the circumstances of transactions that occurred many years, if not decades, ago, and the information sought imposes an undue burden not commensurate with legitimate discovery needs.

Subject to and without waiving the foregoing objections, the information sought is available from the PALM records the USPTO has produced. *See* PTO15-0000003 - 0004803.

INTERROGATORY NO. 4

Identify which, if any, of Mr. Hyatt's patent applications that have been subject to or otherwise associated with the Sensitive Application Warning System ("SAWS") program or any similar program for identifying patent applications for additional scrutiny, review, or oversight; for each such application, please provide the date and nature of each program-related action to which the application was subject.

RESPONSE TO INTERROGATORY NO. 4

Defendant objects to this Interrogatory as it seeks information that has little or no relevance to the issue of prosecution laches, particularly in view of the fact that, as the Court recognized, USPTO delay cannot excuse Mr. Hyatt's delay. Defendant further objects to this Interrogatory as it seeks information that is apparent from the administrative records of Mr. Hyatt's applications and it seeks information that is otherwise known to Mr. Hyatt. Defendant further objects to this Interrogatory as it seeks information and documents subject to the deliberative

process privilege. Defendant further objects to this Interrogatory as it compels the USPTO to breach its confidentiality obligations under 35 U.S.C. § 122 as applied to another applicant's application.

Subject to and without waiving the foregoing objections, the USPTO provides the following response. The USPTO believes approximately five of Mr. Hyatt's patent applications were flagged in the SAWS program from approximately 2000-2010. None of the four applications before the Court are included in these five applications. None of Mr. Hyatt's applications are currently flagged in the SAWS program as the program has been discontinued.

FIRST SUPPLEMENTAL RESPONSE TO INTERROGATORY NO. 4

Defendant incorporates the same objections the USPTO has previously made in response to this Interrogatory. Subject to and without waiving the foregoing objections, the USPTO supplements its response as follows:

The following five applications were in the SAWS program from approximately 2000-2010:

Application Serial No. 06/181,492;

Application Serial No. 08/286,620;

Application Serial No. 08/456,138;

Application Serial No. 08/471,214;

Application Serial No. 08/471,795.

The following application was in the SAWS program in 2014: application serial 08/456,263.

The USPTO is not aware of any other Hyatt applications that were in the SAWS program.

INTERROGATORY NO. 5

For each of Mr. Hyatt's patent applications that were withdrawn from issue, including those identified in Document Request No. 7, identify the person who made the decision to withdraw it

from issue and the physical location of the respective application file history (or any copy thereof) at the time of that person's decision.

RESPONSE TO INTERROGATORY NO. 5

Defendant objects to this Interrogatory as it seeks information that has little or no relevance to the issue of prosecution laches, particularly in view of the fact that, as the Court recognized, USPTO delay cannot excuse Mr. Hyatt's delay. Defendant further objects to this Interrogatory as it seeks information and documents subject to the deliberative process privilege. Defendant further objects to this Interrogatory as it seeks information contained in the administrative records of Mr. Hyatt's patent applications.

Subject to and without waiving the foregoing objections, the USPTO has no further information to provide other than what is included in the administrative record and the documents it has produced in response to Document Request No. 7.

FIRST SUPPLEMENTAL RESPONSE TO INTERROGATORY NO. 5

Defendant incorporates the same objections the USPTO has previously made in response to this Interrogatory. Subject to and without waiving the foregoing objections, the USPTO supplements its response as follows:

The following individuals were involved in the decision to withdraw from issuance U.S. Patent No. 5,625,761: Examiner Robert Harrell; SPE Parshotam Lall; Joe Rolla, Director, Group 2600.

The following individuals were involved in the decision to withdraw from issuance patent application serial no. 07/357,570: Examiner Michael Shingleton; SPE Robert Pascal; Director Rolf Hille, TC 2800; Director Gerald Goldberg, TC 2700.

The following individuals were involved in the decision to withdraw from issuance patent application serial no. 05/849,812: Bruce Lehman; Nick Godici, Director, Group 2600; Examiner Raulfe Zache; Examiner Jeffrey Brier; SPE Thomas Lee; Joe Rolla, Director, Group 2300.

The following individuals were involved in the decision to withdraw from issuance patent application serial no. 08/433,307: Examiner Terrell Fears; Nick Godici, Director, Group 2600.

INTERROGATORY NO. 6

For each alteration to or deletion of Patent Application Locating and Monitoring System (“PALM”) records relating to the examination or other action on Mr. Hyatt’s patent applications made after April 8, 1995, please provide the date and nature of the action and identify the person who requested or performed it or, if records of such alterations or deletions have not been maintained for any period of time subsequent to April 8, 1995, please identify all persons authorized to undertake such alterations or deletions and the time periods of such authorization.

RESPONSE TO INTERROGATORY NO. 6

Defendant objects to this Interrogatory as it seeks information that has little or no relevance to the issue of prosecution laches, particularly in view of the fact that, as the Court recognized, USPTO delay cannot excuse Mr. Hyatt’s delay. Defendant further objects to this Interrogatory as it seeks information and documents subject to the deliberative process privilege. Defendant further objects to this Interrogatory as it seeks information contained in the administrative records of Mr. Hyatt’s patent applications.

Subject to and without waiving the foregoing objections, the USPTO has produced responsive information at PTO15-0023599.

INTERROGATORY NO. 7

If you contend that any of the documents in the administrative records of Plaintiff’s patent applications are relevant to your prosecution laches defense, identify with particularity (e.g., with a Bates number) which documents the PTO will rely upon to support its defense

RESPONSE TO INTERROGATORY NO. 7

Defendant objects to this Interrogatory as premature in that the USPTO is not obligated to identify at this time all of the documents it will rely upon to support its affirmative defense of prosecution laches. That being said, the USPTO has already identified in detail many of the documents that it believes supports its prosecution laches defense. *See, e.g.*, the USPTO's briefing in support of its motion to dismiss for prosecution laches, the USPTO's opposition to Mr. Hyatt's motion for discovery, and the USPTO's opposition to Mr. Hyatt's renewed motion for discovery, including the accompanying laches appendices provided therewith. *See, e.g.*, Laches Appendix volume 1, A200000-206906; Laches Appendix volume 2, A206907-208782. The USPTO has produced these laches appendices in response to Mr. Hyatt's discovery requests nos. 18, 19, 20, and 22. *See* PTO15-0014816-21530.

In that briefing, the USPTO stated that the administrative records of the four applications before the Court support the USPTO's prosecution laches defense. *Id.* The USPTO further stated in its briefing that it believes the administrative records of all his related patent applications support the USPTO's laches defense because they show Mr. Hyatt's pattern of repeatedly filing numerous claims amendments, with the result that his claim set ballooned to over 115,000, while at the same time rewriting many claims; shifting the claims to a different invention; and filing claims for the same invention in different applications—all of which has unreasonably delayed meaningful examination. *Id.* As the Federal Circuit has stated, a pattern of overall delay in a series of related patent applications can trigger prosecution laches. *See Symbol Technologies, Inc v. Lemelson Medical, Education & Research foundation, LP*, 422 F.3d 1378, 1384-86 (Fed. Cir. 2005). Thus, as the file histories of Mr. Hyatt's applications show a pattern of dilatory conduct that is highly relevant to the issue of prosecution laches, the USPTO will rely on them to supports its affirmative defense of prosecution laches.

Furthermore, the USPTO has identified additional specific examples of Mr. Hyatt's unreasonable conduct in its First Set of Interrogatories.

The USPTO reserves all rights to supplement this response and rely on any examples of conduct in the administrative records of Mr. Hyatt's patent applications that demonstrates a pattern of conduct that has delayed prosecution or otherwise supports the USPTO's affirmative defense of prosecution laches.

SUPPLEMENTAL RESPONSE TO INTERROGATORY NO. 7

Defendant incorporates the same objections that it previously made in response to this Interrogatory. Subject to and without waiving the foregoing objections, the USPTO supplements its response as follows:

Defendant identifies as relevant to its prosecution laches defense the substantive portions (e.g., specifications, preliminary amendments, claim amendments, office actions, office action responses, briefing to the Board, Board decisions) of the administrative records of all of Mr. Hyatt's roughly 400 applications because they show Mr. Hyatt's pattern of conduct across a series of related patent applications that unreasonably delayed examination of his claims.²

Defendant further identifies below by Bates Number a narrow subset of specific documents it will rely upon to support its prosecution laches defense. The specifically cited documents include:

- the administrative records for the four applications at issue;

² Defendant does not identify these relevant documents by bates number because Plaintiff's counsel, Paul Levine, told the USPTO in a July 6, 2017 email at 5:09 pm: "If the PTO claims that all the documents in the application file histories are 'relevant' to its defense, simply state as much in your response in lieu of providing a long list of bates numbers. However, please separately provide the bates numbers of the documents the PTO will rely upon to support its defense, per the Court order."

- the administrative record for one or more exemplary applications selected from each of the 12 different families of Hyatt applications;
- Exemplary Office Actions and Responses;
- Examples of Overlapping Claims in the four applications at issue and other applications;
- Documents comprising the laches appendix to Defendant's motion to dismiss and Defendant's opposition to Plaintiff's renewed motion for discovery; and
- Documents cited in USPTO Interrogatories 12-17.

Defendant incorporates by reference and reserves the right to rely on any documents and/or examples cited within the specific documents identified below by Bates Number.

Defendant also incorporates by reference any documents relied upon in the forthcoming expert reports. Defendant further reserves the right to supplement the documents it will rely on to support its prosecution laches defense as discovery progress, the parties exchange expert reports and take expert discovery, and the USPTO learns which documents Mr. Hyatt will rely on to support his contention that he has not unreasonably delayed prosecution.

Applications at Issue	Bates Ranges
Application No. 08/456,398 (09-1864)	PTO10-0044821 - 0050745 (A1-5922) ³
Application No. 08/472,062 (09-1869)	PTO12-0082187 - 0083674 (A1-A1470) ⁴
Application No. 08/431,639 (09-1872)	PTO8-0006110 - 0008058 (A1-1945) ⁵
Application No. 08/457,211 (05-2310)	PTO10-0083133 - 0091285 (A1-12156) ⁶

³ Administrative Record for Application No. 08/456,398.

⁴ Administrative Record for Application No. 08/472,862.

⁵ Administrative Record for Application No. 08/431,639.

⁶ Administrative Record for Application No. 08/457,211.

Exemplary Applications	Bates Ranges
Application No. 08/470,671	PTO2-0024275 - 0034498
Application No. 08/454,902	PTO5-0029242 - 0032896
Application No. 08/457,716	PTO6-0068278 - 0072103
Application No. 08/464,007	PTO10-0296144 - 0301861
Application No. 08/445,458	PTO11-0015615 - 0018721
Application No. 08/471,704	PTO12-0061938 - 0064570
Application No. 08/470,899	PTO12-0040146 - 0041952
Application No. 08/471,428	PTO12-0048348 - 0050287
Application No. 08/471,932	PTO4-0042668 - 0045367
Application No. 08/419,585	PTO7-0068410 - 0074687
Application No. 05/302,771	PTO3-0000001 - 0008954
Application No. 08/472,025	PTO1-0025465 - 0027965
Application No. 08/462,919	PTO8-0049202 - 0052910
Application No. 08/462,333	PTO8-0038156 - 0043138
Application No. 08/417,530	PTO9-0011254 - 0014110

Exemplary Office Actions and Responses	Bates Ranges
Application No. 07/493,061	PTO1-0002499 - 0002542
Application No. 08/285,669	PTO1-0006284 - 0006327 PTO1-0004001 - 0004297
Application No. 08/428,737	PTO1-0008664 - 0008707
Application No. 08/429,272	PTO1-0011470 - 0011900
Application No. 08/433,307	PTO1-0015073 - 0015118 PTO1-0012975 - 0013188
Application No. 08/435,502	PTO1-0017528 - 0017573 PTO1-0016113 - 0016139 PTO1-0016658 - 0016676
Application No. 08/436,552	PTO1-0019594 - 0019639
Application No. 08/469,061	PTO1-0022477 - 0022522 PTO1-0020569 - 0020697
Application No. 08/471,214	PTO1-0024469 - 0024514
Application No. 08/472,025	PTO1-0027052 - 0027097 PTO1-0026105 - 0026123 PTO1-0025738 - 0025762 PTO1-0025465 - 0025503

Exemplary Office Actions and Responses	Bates Ranges
Application No. 08/469,532	PTO2-0015604 - 0015640 PTO2-0014506 - 0014517 PTO2-0013489 - 0013792 PTO2-0014145 - 0014174
Application No. 08/469,532	PTO2-0015602 - 0015640 PTO2-0014504 - 0014517 PTO2-0014145 - 0014174 PTO2-0013487 - 0013792
Application No. 08/470,671	PTO2-0032650 - 0032686 PTO2-0033396 - 0033417 PTO2-0033584 - 0033782 PTO2-0034144 - 0034173
Application No. 08/470,879	PTO2-0036919 - 0036958 PTO2-0034501 - 0034843
Application No. 08/470,897	PTO2-0072476 - 0072512s
Application No. 08/470,900	PTO2-0048330 - 0048878
Application No. 08/471,152	PTO2-0053353 - 0053389 PTO2-0051782 - 0051826
Application No. 08/471,547	PTO2-0056383 - 0056419 PTO2-0055785 - 0055816 PTO2-0055639 - 0055661
Application No. 08/471,548	PTO2-0065866 - 0065902 PTO2-0064289 - 0064325
Application No. 08/471,599	PTO2-0069419 - 0069455
Application No. 08/471,699	PTO2-0075468 - 0075504 PTO2-0074337 - 0074351 PTO2-0073976 - 0074002
Application No. 08/471,703	PTO2-0078641 - 0078677
Application No. 08/471,713	PTO2-0082281 - 0082317

Exemplary Office Actions and Responses	Bates Ranges
	PTO2-0081240 - 0081252 PTO2-0080764 - 0080794
Application No. 08/471,815	PTO2-0088104 - 0088140
Application No. 08/471,931	PTO2-0091117 - 0091153
Application No. 08/472,409	PTO2-0099441 - 0099477
Application No. 08/479,423	PTO2-0102954 - 0102990
Application No. 07/502,588	PTO2-0003928 - 0003964 PTO2-0001757 - 0002095
Application No. 07/539,936	PTO2-0007165 - 0007201
Application No. 07/541,988	PTO2-0010397 – 0010433
Application No. 05/849,812	PTO4-0010038 - 0010095 PTO4-0012520 – 0012730
Application No. 08/469,528	PTO4-0015028 – 0016181
Application No. 08/470,665	PTO4-0019117 – 0019173
Application No. 08/470,666	PTO4-0021690 – 0021746
Application No. 08/470,856	PTO4-0024774 – 0024830
Application No. 08/470,859	PTO4-0027542 – 0027598
Application No. 08/470,898	PTO4-0030466 - 0030522 PTO4-0029527 - 0029782 PTO4-0029140 – 0029184
Application No. 08/471,062	PTO4-0033190 – 0033246
Application No. 08/471,434	PTO4-0035808 - 0035864 PTO4-0034567 – 0034848
Application No. 08/471,795	PTO4-0038865 – 0038921
Application No. 08/471,810	PTO4-0041406 - 0041462 PTO4-0040744 - 0040761 PTO4-0040142 – 0040222

Exemplary Office Actions and Responses	Bates Ranges
Application No. 08/471,932	PTO4-0043839 - 0043895 PTO4-42668 – 0043055
Application No. 08/472,031	PTO4-0046783 - 0046839 PTO4-0045887 – 0045904
Application No. 08/472,032	PTO4-0049756 - 0049813 PTO4-0048684 – 0048709
Application No. 08/472,041	PTO4-0053224 - 0053281 PTO4-0052278 - 0052295 PTO4-0051371 – 0051610
Application No. 08/479,097	PTO4-0055961 - 0056017 PTO4-0055078 – 0055101
Application No. 08/483,011	PTO4-0058575 - 0058631 PTO4-0057668 – 0057685
Application No. 08/486,151	PTO4-0061881 – 0061937
Application No. 07/357,570	PTO5-0001792 – 0001820 PTO5-0000001 - 0000146
Application No. 08/454,780	PTO5-0005771 - 0007239
Application No. 08/454,877	PTO5-0010995 - 0011023 PTO5-0009315 - 0009353
Application No. 08/454,879	PTO5-0014143 - 0014170
Application No. 08/454,884	PTO5-0016919 - 0016946
Application No. 08/454,889	PTO5-0020548 - 0020575 PTO5-0018907 - 0019192 PTO5-0018396 - 0018441
Application No. 08/454,896	PTO5-0023666 - 0023692 PTO5-0022272 - 0022446
Application No. 08/454,901	PTO5-0027613 - 0027641 PTO5-0025005 - 0025046
Application No. 08/454,902	PTO5-0031425 - 0031452

Exemplary Office Actions and Responses	Bates Ranges
	PTO5-0029962 - 0030124 PTO5-0029267 - 0029322
Application No. 08/455,117	PTO5-0035008 - 0035036 PTO5-0033373 - 0033395
Application No. 08/455,164	PTO5-0038377 - 0038404
Application No. 08/455,202	PTO5-0041756 - 0041782 PTO5-0039855 - 0039904
Application No. 08/455,356	PTO5-0045881 - 0045907 PTO5-0043656 - 0043691
Application No. 08/455,435	PTO5-0049163 - 0049190 PTO5-0047356 - 0047394
Application No. 08/455,456	PTO5-0052578 - 0052604
Application No. 08/455,505	PTO5-0056287 - 0056313 PTO5-0054182 - 0054296
Application No. 08/455,648	PTO5-0059431 - 0059457 PTO5-0057816 - 0057817
Application No. 08/455,738	PTO5-0061966 - 0061995 PTO5-0060737 - 0060738
Application No. 08/455,750	PTO5-0065076 - 0065102
Application No. 08/455,752	PTO5-0068782 - 0068808
Application No. 08/455,769	PTO5-0072216 - 0072242
Application No. 08/455,779	PTO5-0075470 - 0075496 PTO5-0073732 - 0073771
Application No. 08/456,126	PTO5-0078453 - 0078479 PTO5-0076836 - 0076873
Application No. 08/456,270	PTO5-0084404 - 0084430 PTO5-0082463 - 0082500
Application No. 08/457,659	PTO5-0088194 - 0088201
Application No. 08/457,941	PTO5-0091428 - 0091454

Exemplary Office Actions and Responses	Bates Ranges
Application No. 08/501,978	PTO5-0094507 - 0094533 PTO5-0093110 - 0093147
Application No. 08/501,979	PTO5-0097725 - 0097751 PTO5-0095948 - 0095986 PTO5-0096695 - 0096717
Application No. 08/501,980	PTO5-0100800 - 0100826 PTO5-0099120 - 0099121
Application No. 08/501,981	PTO5-0103753 - 0103779 PTO5-0102282 - 0102284
Application No. 07/419,911	PTO6-0001198 - 0001236 PTO6-0000275 - 0000303 PTO6-0000001 - 0000029
Application No. 08/439,032	PTO6-0004790 - 0005294 PTO6-0003986 - 0004025 PTO6-0003369 - 0003401
Application No. 08/439,033	PTO6-0008850 - 0008887 PTO6-0007399 - 0007434 PTO6-0007163 - 0007189
Application No. 08/456,327	PTO6-0012746 - 0012783 PTO6-0011350 - 0011371 PTO6-0010962 - 0011056
Application No. 08/456,332	PTO6-0016205 - 0016242
Application No. 08/456,338	PTO6-0019628 - 0019665 PTO6-0017824 - 0017995
Application No. 08/456,397	PTO6-0022728 - 0022765
Application No. 08/456,399	PTO6-0026153 - 0026190 PTO6-0024696 - 0024717
Application No. 08/456,599	PTO6-0029654 - 0029691 PTO6-0027989 - 0028016 PTO6-0027673 - 0027698

Exemplary Office Actions and Responses	Bates Ranges
Application No. 08/457,086	PTO6-0032835 - 0032872 PTO6-0031587 - 0031608
Application No. 08/457,195	PTO6-0036744 - 0036781 PTO6-0034871 - 0034902 PTO6-0034843 - 0034870
Application No. 08/457,210	PTO6-0039940 - 0039977 PTO6-0038796 - 0038836 PTO6-0038493 - 0038518
Application No. 08/457,344	PTO6-0043672 - 0043709 PTO6-0042373 - 0042411 PTO6-0041969 - 0041996
Application No. 08/457,355	PTO6-0047275 - 0047312
Application No. 08/457,361	PTO6-0050579 - 0050616
Application No. 08/457,369	PTO6-0053561 - 0053598
Application No. 08/457,446	PTO6-0059711 - 0059748 PTO6-0057790 - 0057813 PTO6-0057444 - 0057469
Application No. 08/457,609	PTO6-0063354 - 0063392
Application No. 08/457,663	PTO6-0066652 - 0066689 PTO6-0065387 - 0065416 PTO6-0065358 - 0065386
Application No. 08/457,716	PTO6-0070353 - 0070391 PTO6-0069003 - 0069041 PTO6-0068582 - 0068610
Application No. 08/457,717	PTO6-0074295 - 0074332 PTO6-0072611 - 0072634 PTO6-0072107 - 0072131
Application No. 08/457,939	PTO6-0077782 - 0077819 PTO6-0076689 - 0076724 PTO6-0076157 - 0076177

Exemplary Office Actions and Responses	Bates Ranges
Application No. 08/457,963	PTO6-0081424 - 0081463
Application No. 08/458,003	PTO6-0085017 - 0085054 PTO6-0083739 - 0083779 PTO6-0083024 - 0083051
Application No. 08/458,102	PTO6-0088550 - 0088587
Application No. 08/458,144	PTO6-0093227 - 0093264 PTO6-0090662 - 0090681 PTO6-0090224 - 0090249
Application No. 08/458,579	PTO6-0096892 - 0096929 PTO6-0095329 - 0095336
Application No. 08/459,090	PTO6-0099463 - 0099500 PTO6-0098279 - 0098301
Application No. 08/640,726	PTO6-0103052 - 0103089 PTO6-0101571 - 0101602 PTO6-0101199 - 0101226
Application No. 08/640,727	PTO6-0106647 - 0106684
Application No. 06/848,017	PTO7-0005348 - 0005385 PTO7-0003546 - 0003567
Application No. 08/417,532	PTO7-0007842 - 0008811
Application No. 08/418,211	PTO7-0014997 - 0015035 PTO7-0013640 - 0013681
Application No. 08/418,212	PTO7-0020886 - 0020924
Application No. 08/418,213	PTO7-0029187 - 0029225
Application No. 08/418,215	PTO7-0035637 - 0035404
Application No. 08/418,216	PTO7-0040194 - 0040232
Application No. 08/418,996	PTO7-0046198 - 0046236
Application No. 08/419,326	PTO7-0051368 - 0051406
Application No. 08/419,476	PTO7-0058038 - 0058076

Exemplary Office Actions and Responses	Bates Ranges
	PTO7-0055986 - 0056178
Application No. 08/419,584	PTO7-0063835 - 0063873 PTO7-0063287 - 0063355
Application No. 08/419,585	PTO7-0070653 - 0070691 PTO7-0068969 - 0069115 PTO7-0068410 - 0068463
Application No. 08/419,586	PTO7-0076992 - 0077030 PTO7-0075280 - 0075424 PTO7-0074690 - 0074740
Application No. 08/419,682	PTO7-0085231 - 0085268
Application No. 08/420,170	PTO7-0088758 - 0088795
Application No. 08/420,470	PTO7-0093586 - 0093624 PTO7-0091540 - 0091680
Application No. 08/423,073	PTO7-0099458 - 0099495
Application No. 08/423,234	PTO7-0104497 - 0104535
Application No. 08/423,235	PTO7-0109707 - 0109745
Application No. 08/423,390	PTO7-0115912 - 0115949
Application No. 08/426,361	PTO7-0121376 - 0121413
Application No. 08/426,450	PTO7-0125464 - 0125501
Application No. 08/426,521	PTO7-0130531 - 0130568
Application No. 08/426,548	PTO7-0135049 - 0135087
Application No. 08/426,549	PTO7-0138728 - 0138765
Application No. 08/426,554	PTO7-0143211 - 0143248
Application No. 08/426,754	PTO7-0148639 - 0148676
Application No. 08/426,779	PTO7-0154937 - 0154975
Application No. 08/427,547	PTO7-0159556 - 0159593
Application No. 08/428,359	PTO7-0165149 - 0165186 PTO7-0163533 - 0163680

Exemplary Office Actions and Responses	Bates Ranges
	PTO7-0163137 - 0163188
Application No. 08/434,424	PTO8-0011987 - 0012015
Application No. 08/436,854	PTO8-0019464 - 0019492 PTO8-0018351 - 0018374 PTO8-0017704 - 0017742
Application No. 08/436,855	PTO8-0023977 - 0024936 PTO8-0022959 - 0023144
Application No. 08/438,575	PTO8-0032109 - 0032137
Application No. 08/462,333	PTO8-0039786 - 0039814 PTO8-0038788 - 0038809 PTO8-0038156 - 0038193
Application No. 08/462,712	PTO8-0044687 - 0044715 PTO8-0043775 - 0043795 PTO8-0043139 - 0043175
Application No. 08/462,919	PTO8-0050421 - 0050449 PTO8-0049202 - 0049340
Application No. 08/463,109	PTO8-0054924 - 0054952 PTO8-0053171 - 0053192 PTO8-0052911 - 0052960
Application No. 08/463,117	PTO8-0061121 - 0061149 PTO8-0059992 - 0060014
Application No. 08/463,820	PTO8-0069009 - 0069037 PTO8-0067452 - 0067473
Application No. 08/464,114	PTO8-0075880 - 0075908 PTO8-0074778 - 0074800
Application No. 08/464,441	PTO8-0079986 - 0080014 PTO8-0078931 - 0078953
Application No. 08/464,986	PTO8-0086609 - 0086637
Application No. 08/465,482Application No. 08/465,627	PTO8-0092573 - 0092601 PTO8-0095352 - 0095380

Exemplary Office Actions and Responses	Bates Ranges
	PTO8-0094009 - 0094024
Application No. 08/465,659	PTO8-0098187 - 0098215
Application No. 07/763,395	PTO9-0003024 - 0003065
Application No. 07/774,159	PTO9-0007806 - 0007847
Application No. 08/323,471	PTO9-0009293 - 0009333 PTO9-0008175 - 0008205
Application No. 08/417,530	PTO9-0012439 - 0012479 PTO9-0011675 - 0011694 PTO9-0011289 - 0011317 PTO9-0011254 - 0011288
Application No. 08/419,590	PTO9-0015010 - 0015050
Application No. 08/419,681	PTO9-0017764 - 0017804 PTO9-0017171 - 0017183 PTO9-0016956 - 0016983 PTO9-0016012 - 0016949
Application No. 08/420,942	PTO9-0019999 - 0021316
Application No. 08/423,081	PTO9-0024333 - 0024373 PTO9-0023523 - 0023533 PTO9-0023181 - 0023521
Application No. 08/429,391	PTO9-0027718 - 0027758
Application No. 08/430,089	PTO9-0030074 - 0030114
Application No. 08/430,777	PTO9-0032993 - 0033033 PTO9-0032519 - 0032686 PTO9-0032005 - 0032057
Application No. 08/431,638	PTO9-0035861 - 0035901 PTO9-0034996 - 0035066
Application No. 08/432,249	PTO9-0038563 - 0038603
Application No. 08/432,384	PTO9-0040923 - 0040963
Application No. 08/432,878	PTO9-0043804 - 0043844

Exemplary Office Actions and Responses	Bates Ranges
Application No. 08/434,449	PTO9-00465543 - 0046583
Application No. 08/435,513	PTO9-0049512 - 0049552 PTO9-0048866 - 0048880 PTO9-0048598 - 0048632
Application No. 08/435,907	PTO9-0051667 - 0051707
Application No. 08/435,924	PTO9-0053819 - 0053859
Application No. 08/435,938	PTO9-0056623 - 0056663 PTO9-0055966 - 0056022
Application No. 08/436,853	PTO9-0058949 - 0058989
Application No. 08/437,527	PTO9-0061512 - 0061552 PTO9-0060937 - 0060955 PTO9-0060716 - 0060743
Application No. 08/437,736	PTO9-0064002 - 0064042 PTO9-0063381 - 0063434 PTO9-0063034 - 0063090s
Application No. 08/438,012	PTO9-0066951 - 0066991
Application No. 08/438,598	PTO9-0069707 - 0069747 PTO9-0068979 - 0069037
Application No. 08/458,197	PTO-0072089 - 0072129 PTO-0071596 - 0071612 PTO-0071449 - 0071473
Application No. 08/458,548	PTO9-0075451 - 0075491 PTO9-0075772 - 0075833 PTO9-0075842 - 0075898
Application No. 08/458,582	PTO9-0077256 - 0077296 PTO9-0076336 - 0076575
Application No. 08/459,220	PTO9-0079848 - 0079888 PTO9-0079215 - 0079229 PTO9-0078933 - 0078966

Exemplary Office Actions and Responses	Bates Ranges
Application No. 08/459,244	PTO9-0082522 - 0082562 PTO9-0081903 - 0081917 PTO9-0081667 - 0081694 PTO9-0081637 - 0081664
Application No. 08/459,505	PTO9-0086215 - 0086255
Application No. 08/459,508	PTO9-0087954 - 0087994 PTO9-0086876 - 0086890 PTO9-0086569 - 0086601
Application No. 08/459,599	PTO9-0091059 - 0091099 PTO9-0091652 - 0091672 PTO9-0091674 - 0091704
Application No. 08/459,877	PTO9-0092476 - 0092516 PTO9-0091898 - 0091935
Application No. 08/460,064	PTO9-0096103 - 0096143 PTO9-0096706 - 0096724 PTO9-0096729 - 0096756
Application No. 08/460,092	PTO9-0098655 - 0098695 PTO9-0099330 - 0099368 PTO9-0099369 - 0099392
Application No. 08/460,550	PTO9-0101211 - 0101251
Application No. 08/460,590	PTO9-0103661 - 0103701 PTO9-0103946 - 0104040 PTO9-0104048 - 0104104
Application No. 08/460,697	PTO9-0106210 - 0106250
Application No. 08/460,768	PTO9-0108591 - 0108631
Application No. 08/460,800	PTO9-0111082 - 0111122
Application No. 08/460,966	PTO9-0113396 - 0113436
Application No. 08/461,572	PTO9-0115346 - 0115386
Application No. 08/462,306	PTO9-0118469 - 0118509

Exemplary Office Actions and Responses	Bates Ranges
	PTO9-0119185 - 0119215
Application No. 08/463,118	PTO9-0120188 - 0120228
Application No. 08/463,791	PTO9-0123119 - 0123159
Application No. 08/464,032	PTO9-0126058 - 0126098
Application No. 08/464,035	PTO9-0127794 - 0127834 PTO9-0127278 - 0127410
Application No. 08/464,037	PTO9-0130666 - 0130706 PTO9-0130300 - 0130362
Application No. 08/464,085	PTO9-0133255 - 0133295
Application No. 08/464,246	PTO9-0136845 - 0136885 PTO9-0137605 - 0137621 PTO9-0137622 - 0137649
Application No. 08/464,520	PTO9-0138421 - 0138461
Application No. 08/464,521	PTO9-0141193 - 0141233
Application No. 08/464,980	PTO9-0143485 - 0143525
Application No. 08/464,995	PTO9-0145641 - 0145681 PTO9-0145247 - 0145331
Application No. 08/464,997	PTO9-0151056 - 0151096
Application No. 08/465,073	PTO9-0155091 - 0155131 PTO9-0155430 - 0155490
Application No. 08/465,152	PTO9-0157229 - 0157269
Application No. 08/465,176	PTO9-0158930 - 0158970
Application No. 08/465,923	PTO9-0164605 - 0164645
Application No. 08/466,994	PTO9-0166524 - 0166564
Application No. 08/467,471	PTO9-0169572 - 0169612
Application No. 08/469,002	PTO9-0170663 - 0170703
Application No. 07/289,355	PTO10-0022315 - 0022348
Application No. 08/456,296	PTO10-0027909 - 0027942

Exemplary Office Actions and Responses	Bates Ranges
Application No. 08/456,333	PTO10-0035341 - 0035374
Application No. 08/456,339	PTO10-0038701 - 0038749
Application No. 08/456,901	PTO10-0051945 - 0051978
Application No. 08/457,194	PTO10-0058597 - 0058630
Application No. 08/457,196	PTO10-0065379 - 0065412 PTO10-0064701 - 0064723 PTO10-0064281 PTO10-0064519 - 0064547
Application No. 08/457,197	PTO10-0071843 - 0071876
Application No. 08/457,208	PTO10-0078921 - 0078954 PTO10-0078021 - 0078043
Application No. 08/457,360	PTO10-0092155 - 0092188
Application No. 08/457,362	PTO10-0097700 - 0097733 PTO10-0096684 - 0096806
Application No. 08/457,448	PTO10-0103286 - 0103319
Application No. 08/457,715	PTO10-0108913 - 0108946 PTO10-0108168 - 0108191 PTO10-0107847 PTO10-0108119 - 0108144
Application No. 08/457,726	PTO10-0114774 - 0114807
Application No. 08/457,728	PTO10-0120906 - 0120939 PTO10-0119671 - 0119713
Application No. 08/458,004	PTO10-0125731 - 0125764 PTO10-0125370 - 0125426 PTO10-0124923 - 0125016 PTO10-0124410 - 0124452
Application No. 08/458,005	PTO10-0131615 - 0131648 PTO10-0131098 - 0131200
Application No. 08/458,006	PTO10-0136106 - 0136139

Exemplary Office Actions and Responses	Bates Ranges
Application No. 08/458,104	PTO10-0141702 - 0141735
Application No. 08/458,141	PTO10-0144198 - 0144231 PTO10-0143524 - 0143546 PTO10-0143129 - 0143156
Application No. 08/458,142	PTO10-0149379 - 0149412
Application No. 08/458,143	PTO10-0159527 - 0159560 PTO10-0160339 - 0160361 PTO10-0160411 - 0160440
Application No. 08/458,206	PTO10-0162374 - 0162407 PTO10-0161453 - 0161544
Application No. 08/458,549	PTO10-0170832 - 0170865 PTO10-0169672 - 0169794
Application No. 08/458,608	PTO10-0176156 - 0176189
Application No. 08/458,791	PTO10-0181513 - 0181546 PTO10-0180814 - 0180836 PTO10-0180467 - 0180495 PTO10-0180402 - 0180441
Application No. 08/459,152	PTO10-0186822 - 0186855
Application No. 08/459,158	PTO10-0192311 - 0192344 PTO10-0191775 - 0191880 PTO10-0190931 - 0191000
Application No. 08/459,221	PTO10-0198054 - 0198087
Application No. 08/459,648	PTO10-0207079 - 0207112 PTO10-0205585 - 0205635
Application No. 08/459,848	PTO10-0212599 - 0212632 PTO10-0211500 - 0211626
Application No. 08/460,172	PTO10-0217790 - 0217823
Application No. 08/460,422	PTO10-0222996 - 0223029
Application No. 08/460,433	PTO10-0230264 - 0230297

Exemplary Office Actions and Responses	Bates Ranges
	PTO10-0229228 - 0229249 PTO10-0228752 - 0228782 PTO10-0228681 - 0228728
Application No. 08/460,607	PTO10-0235164 - 0235197
Application No. 08/460,612	PTO10-0241103 - 0241136 PTO10-0240298 - 0240319 PTO10-0239929 - 0239960
Application No. 08/460,705	PTO10-0247975 - 0248008 PTO10-0247220 - 0247238 PTO10-0246859 - 0246884 PTO10-0246796 - 0246828
Application No. 08/460,718	PTO10-0253485 - 0253518 PTO10-0252728 - 0252750 PTO10-0252281 - 0252308
Application No. 08/460,737	PTO10-0259889 - 0259922
Application No. 08/461,288	PTO10-0264412 - 0264445
Application No. 08/461,567	PTO10-0269849 - 0269882
Application No. 08/463,111	PTO10-0275715 - 0275748 PTO10-0274095 - 0274135
Application No. 08/463,583	PTO10-0277356 - 0277389
Application No. 08/463,821	PTO10-0279091 - 0279124
Application No. 08/463,822	PTO10-0281362 - 0281395
Application No. 08/463,823	PTO10-0286702 - 0286735 PTO10-0285894 - 0285934
Application No. 08/463,824	PTO10-0291116 - 0291149
Application No. 08/464,007	PTO10-0297384 - 0297417 PTO10-0296913 - 0297023 PTO10-0296148 - 0296208
Application No. 08/464,034	PTO10-0302288 - 0302321

Exemplary Office Actions and Responses	Bates Ranges
Application No. 08/464,497	PTO10-0308887 - 0308920
Application No. 08/464,512	PTO10-0311706 - 0311739
Application No. 08/464,992	PTO10-0317326 - 0317359
Application No. 08/464,998Application No. 08/464,999	PTO10-0322603 - 0322636 PTO10-0328341 - 0328374
Application No. 08/465,071	PTO10-0334012 - 0334045 PTO10-0333173 - 0333195 PTO10-0332668 - 0332695
Application No. 08/465,083	PTO10-0340526 - 0340559
Application No. 08/465,173	PTO10-0347415 - 0347448 PTO10-0346323 - 0346428
Application No. 08/465,198	PTO10-0353036 - 0353069
Application No. 08/465,199	PTO10-0355483 - 0355516
Application No. 08/465,200	PTO10-0361228 - 0361261
Application No. 08/465,201	PTO10-0367254 - 0367287
Application No. 08/465,657	PTO10-0372173 - 0372206
Application No. 08/465,658	PTO10-0377518 - 0377551
Application No. 08/466,557	PTO10-0382973 - 0383006
Application No. 08/466,599	PTO10-0389002 - 0389035 PTO10-0388464 - 0388481 PTO10-0388110 - 0388131
Application No. 08/466,600	PTO10-0395287 - 0395320
Application No. 08/466,992	PTO10-0403047 - 0403080
Application No. 08/469,001	PTO10-0409785 - 0409818
Application No. 08/469,018	PTO10-0416697 - 0416730 PTO10-0416295 - 0416425 PTO10-0415618 - 0415677
Application No. 08/469,060	PTO10-0421624 - 0421657

Exemplary Office Actions and Responses	Bates Ranges
Application No. 08/469,077	PTO10-0427130 - 0427163
Application No. 08/469,261	PTO10-0432262 - 0432295
Application No. 08/469,262	PTO10-0438801 - 0438834
Application No. 08/469,263	PTO10-0444373 - 0444406 PTO10-0443956 - 0444065
Application No. 08/469,321	PTO10-0446730 - 0446763 PTO10-0446975 - 0446997 PTO10-0445577 - 0445605
Application No. 08/469,407	PTO10-0452533 - 0452566
Application No. 08/469,580	PTO10-0458252 - 0458285 PTO10-0457524 - 0457547 PTO10-0457095 - 0457123
Application No. 08/469,592	PTO10-0464895 - 0464928
Application No. 08/469,888	PTO10-0470858 - 0470891
Application No. 08/469,889	PTO10-0477003 - 0477036
Application No. 08/470,569	PTO10-0483361 - 0483394
Application No. 08/471,042	PTO10-0490995 - 0491028
Application No. 08/471,123	PTO10-0498289 - 0498322 PTO10-0497360 - 0497383 PTO10-0496877 - 0496906
Application No. 08/471,252	PTO10-0502330 - 0502363
Application No. 08/471,255	PTO10-0505015 - 0505048 PTO10-0504398 - 0504419
Application No. 08/471,425	PTO10-0512752 - 0512785
Application No. 08/471,542	PTO10-0520068 - 0520101
Application No. 08/471,553	PTO10-0527371 - 0527404
Application No. 08/471,600	PTO10-0533488 - 0533521

Exemplary Office Actions and Responses	Bates Ranges
Application No. 08/471,633 Application No. 08/471,695	PTO10-0541637 - 0541670 PTO10-0545227 - 0545260
Application No. 08/471,846	PTO10-0552086 - 0552119 PTO10-0551648 - 0551732 PTO10-0550913 - 0550978
Application No. 07/128,659	PTO11-0008778 - 0008838
Application No. 07/182,709	PTO11-0010621 - 0010682 PTO11-0009671 - 0009728 PTO11-0009733 - 0009759 PTO11-0009733 - 0009759
Application No. 08/445,456	PTO11-0013437 - 0013498 PTO11-0012580 - 0012736
Application No. 08/445,458	PTO11-0017213 - 0017273 PTO11-0015753 - 0015789 PTO11-0015753 - 0015789 PTO11-0015615 - 0015636
Application No. 08/454,810	PTO11-0020480 - 0020540
Application No. 08/454,873	PTO11-0023452 - 0023512 PTO11-0021898 - 0021936 PTO11-0022573 - 0022590 PTO11-0022546 - 0022569
Application No. 08/454,874	PTO11-0026076 - 0026136
Application No. 08/454,875	PTO11-0030327 - 0030387 PTO11-0028522 - 0028669 PTO11-0027813 - 0027863
Application No. 08/454,878	PTO11-0032836 - 0032896
Application No. 08/454,886	PTO11-0036153 - 0036213 PTO11-0034994 - 0035048 PTO11-0034332 - 0034480 PTO11-0034527 - 0034551

Exemplary Office Actions and Responses	Bates Ranges
Application No. 08/454,887	PTO11-0038955 - 0039015 PTO11-0038181 - 0038204 PTO11-0037588 - 0037626 PTO11-0037864 - 0037889
Application No. 08/454,984	PTO11-0042242 - 0042302 PTO11-0041441 - 0041461 PTO11-0040686 - 0040722 PTO11-0040957 - 0040981
Application No. 08/455,297	PTO11-0044934 - 0044994
Application No. 08/455,303	PTO11-0047995 - 0048055 PTO11-0046430 - 0046468
Application No. 08/455,309	PTO11-0052247 - 0052307 PTO11-0050474 - 0050504 PTO11-0049546 - 0049601 PTO11-0050449 - 0050473
Application No. 08/455,310	PTO11-0055456 - 0055516
Application No. 08/455,320	PTO11-0058290 - 0058350
Application No. 08/455,924	PTO11-0061326 - 0061386
Application No. 08/456,128	PTO11-0064252 - 0064312
Application No. 08/456,129	PTO11-0067460 - 0067520 PTO11-0066249 - 0066276 PTO11-0065785 - 0065839 PTO11-0065842 - 0065871
Application No. 08/456,130	PTO11-0070146 - 0070206 PTO11-0068912 - 0069096
Application No. 08/456,138	PTO11-0073411 - 0073471 PTO11-0072092 - 0072260
Application No. 08/432,478	PTO12-0003827 - 0003863
Application No. 08/435,033	PTO12-0005858 - 0005893 PTO12-0005296 - 0005473

Exemplary Office Actions and Responses	Bates Ranges
Application No. 08/435,894	PTO12-0007675 - 0007710
Application No. 08/435,901	PTO12-0010942 - 0010977
Application No. 08/466,164	PTO-12-0012709 - 0012744
Application No. 08/466,953	PTO12-0014891 - 0014926 PTO12-0014271 - 0014460
Application No. 08/468,501	PTO12-0016498 - 0016533
Application No. 08/469,058	PTO12-0018298 - 0018333
Application No. 08/469,098	PTO12-0019739 - 0019774
Application No. 08/469,565	PTO12-0021406 - 0021441
Application No. 08/469,573	PTO12-0022954 - 0022989 PTO12-0022416 - 0022572
Application No. 08/469,885	PTO12-0024846 - 0024881
Application No. 08/469,939	PTO12-0027244 - 0027279 PTO12-0027999 - 0028212
Application No. 08/470,079	PTO12-0028743 - 0028778 PTO12-0028237 - 0028409
Application No. 08/470,080	PTO12-0030391 - 0030426
Application No. 08/470,082	PTO12-0031835 - 0031870 PTO12-0031203 - 0031385
Application No. 08/470,084	PTO12-0033877 - 0033912
Application No. 08/470,177	PTO12-0035496 - 0035531 PTO12-0034814 - 0035106
Application No. 08/470,882	PTO12-0036893 - 0036928
Application No. 08/470,888	PTO12-0038733 - 0038768
Application No. 08/470,899	PTO12-0041308 - 0041343 PTO12-0041693 - 0041896
Application No. 08/471,070	PTO12-0042326 - 0042361
Application No. 08/471,135	PTO12-0045003 - 0045038

Exemplary Office Actions and Responses	Bates Ranges
Application No. 08471,138	PTO12-0046658 - 0046693
Application No. 08/471,428	PTO12-0048959 - 0048994 PTO12-0048348 - 0048565
Application No. 08/471,543	PTO12-0051615 - 0051650
Application No. 08/471,549	PTO12-0053073 - 0053109
Application No. 08/471,587	PTO12-0054517 - 0054935
Application No. 08/471,598	PTO12-0056983 - 0057018
Application No. 08/471,700	PTO12-0058776 - 0058811
Application No. 08/471,704	PTO12-0062963 - 0062998 PTO12-0062390 - 0062532 PTO12-0061943 - 0062386
Application No. 08/471,707	PTO12-0064937 - 0064972
Application No. 08/471,708	PTO12-0067153 - 0067188 PTO12-0066603 - 0066776
Application No. 08471,709	PTO12-0068982 - 0069017
Application No. 08/471,710	PTO12-0071147 - 0071182
Application No. 08/479,088	PTO12-0088403 - 0088439 PTO12-0087896 - 0088071
Application No. 08/483,016	PTO12-0091017 - 0091052
Application No. 08/471,925	PTO12-0078389 - 0080514

Laches Appendix	Bates Ranges
Laches Appendix - Volume I	PTO15-0014816 - PTO15-0021722 (A200000 - A206906)
Laches Appendix - Volume II	PTO15-0021723 - PTO15-0023598 (A206907 - A208782)

Overlapping Claims 08/456,398	Bates Ranges
Application No. 08/457,208	PTO10-0081518 - 0081580 at PTO10-0081553
Application No. 08/458,608	PTO10-0178789 - 0178824

	at PTO10-0178798 - 0178799
Application No. 08/464,497	PTO10-0309673 - 0309737 at PTO10-0309683 - 0309684 PTO10-0309673 - 0309737 at PTO10-0309675 - 0309676
Application No. 08/469,580	PTO10-0462158 - 0462207 at PTO10-0462173 PTO10-0461862 - 0461950 at PTO10-0461862 PTO10-0462408 - 0462510 at PTO10-0462464
Application No. 08/471,846	PTO10-0555068 - 0555181 at PTO10-0555159
Application No. 08/471,255	PTO10-0509823 - 0509902 at PTO10-0509878
Application No. 08/456,339	PTO10-0040373 - 0040490 at PTO10-0040387
Application No. 08/459,158	PTO10-0195296 - 0195319 at PTO10-0195296 PTO10-0195296 - 0195319 at PTO10-0195300
Overlapping Claims 08/456,062	Bates Ranges
Application No. 08/471,702	PTO12-0061367 - 0061445 at PTO12-0061411 - 0061412 PTO12-0061367 - 0061445 at PTO12-0061419 PTO12-0061367 - 0061445 at PTO12-0061392 - 0061393
Overlapping Claims 08/431,639	Bates Ranges
Application No. 08/464,510	PTO8-0084539 - 0084655 at PTO8-0084552 - 0084553
Application No. 08/472,041	PTO4-0051767
Overlapping Claims 08/457,211	Bates Ranges
Application No. 08/464,497	PTO10-0308657 - 0308801 at PTO10-0309677 - 0309678
Application No. 08/460,612	PTO10-0244643 - 0244746 at PTO10-0244679 - 0244680

Documents Cited in USPTO Interrogatories 12 - 17		
No.	Application	Bates Ranges
12a.	Application No. 08/459,648, Reply to Office Action, 7/11/2016, Amendment to Claim No. 121	PTO10-0206242 PTO10-0206284 - 0206285
12b.	Application No. 08/459,508, Reply to Office Action, 3/11/2015, Amendment to Claim No. 248	PTO9-0086896 PTO9-0087154 - 0087156
12c.	Application No. 07/493,061, Reply to Office Action, 6/16/2015, Amendment to Claim 3	PTO1-0001435 PTO1-0001478
13a.	Application No. 08/458,144 Claim 263, Amendment date 5/28/2003	PTO6-0093316 PTO6-0093323
	Application No. 08/459,090 Claim 396 to Office Action date 12/03/2013	PTO6-0099006 PTO6-0099081
13b.	Application No. 08/458,144 Claim 265, Amendment dated 5/28/2003	PTO6-0093316 PTO6-0093323
	Application No. 08/459,090 Claim 151, Amendment dated 5/23/2003	PTO6-0099552 PTO6-0099554
13c.	Application No. 08/458,144 Claim 240, Amendment dated 5/28/2003	PTO6-0093316 PTO6-0093320
	Application No. 08/459,090 Claim 398 to Office Action dated 12/03/2013	PTO6-0099006 PTO6-0099081
13d.	Application No. 08/479,097 Claim 269 to Office Action dated 1/13/2014	PTO4-0055784 PTO4-0055826
	Application No. 08/470,665 Claim 183, Amendment dated 10/20/2004	PTO4-0019365 PTO4-0019376 - 0019377
13e.	Application No. 08/479,097 Claim 279 to Office Action dated 1/13/2014	PTO4-0055784 PTO4-0055828
	Application No. 08/470,665 Claim 188, Amendment dated 10/20/2004	PTO4-0019365 PTO4-0019379
13f.	Application No. 08/470,859 Claim 532, Amendment dated 10/20/2004	PTO4-0027792 PTO4-0027810 - 0027811
	Application No. 08/471,434 Claim 255, Amendment dated 10/20/2004	PTO4-0036060 PTO4-0036080
13g.	Application No. 08/418,212 Claim 232 and Amendment dated 5/25/2006	PTO7-0023447 PTO7-0023494
	Application No. 08/417,532 Claim 267, Amendment dated 10/19/2004	PTO7-0010811 PTO7-0010883
13h.	Application No. 08/470,879 Claim 314, Amendment dated 10/20/2004	PTO2-0037926 PTO2-0037969
	Application No. 08/471,599 Claim 173 dated 9/20/2005	PTO2-0069478 PTO2-0069507
13i.	Application No. 08/470,879 Claim 460, Amendment dated 10/20/2004	PTO2-0037926 PTO2-0038007
	Application No. 08/471,713 Claim 229 and Amendment dated 11/04/2004	PTO2-0083546 PTO2-0083583 - 0083584

Documents Cited in USPTO Interrogatories 12 - 17		
No.	Application	Bates Ranges
13j.	Application No. 08/456,339 Claim 169, Reply to Office Action dated 8/8/2016	PTO10-0037763 PTO10-0037771
	Application No. 08/465,201 Claim 310 and Amendment dated 11/15/2004	PTO10-0369281 PTO10-0369435
13k.	Application No. 08/464,034 Claim 124 dated 3/24/2014	PTO10-0302079 PTO10-0302087
	Application No. 08/465,201 Claim 306 and Amendment dated 11/15/2004	PTO10-0369281 PTO10-0369433 - 0369434
13l.	Application No. 08/464,034 Claim 196 dated 3/24/2014	PTO10-0302079 PTO10-0302109
	Application No. 08/465,201 Claim 381 and Amendment dated 11/15/2004	PTO10-0369281 PTO10-0369460 - 0369461
13m.	Application No. 08/464,034 Claim 206 dated 3/24/2014	PTO10-0302079 PTO10-0302112
	Application No. 08/465,201 Claim 536 and Amendment dated 11/15/2004	PTO10-0369281 PTO10-0369510
13n.	Application No. 08/464,034 Claim 220 dated 3/24/2014	PTO10-0302079 PTO10-0302115 - 0302116
	Application No. 08/469,261 Claim 259 to Office Action dated 3/27/2014	PTO10-0432060 PTO10-0432089
	Application No. 08/457,726 Claim 220 and Amendment dated 3/14/2005	PTO10-0116800 PTO10-0116932
13o.	Application No. 08/457,726 Claim 265 and Amendment dated 3/14/2005	PTO10-0116800 PTO10-0116950
	Application No. 08/458,141 Claim 158 and Amendment dated 9/8/2005	PTO10-0144258 PTO10-0144372 - 0144373
13p.	Application No. 08/458,006 ⁷ Claim 193 and Amendment dated 10/12/2005	PTO10-0136166 PTO10-0136295
	Application No. 08/457,726 Claim 575 dated 1/24/2014	PTO10-0114512 PTO10-0114669
13q.	Application No. 08/436,855 Claim 401	PTO8-0025251 PTO8-0025328
	Application No. 08/462,919 Claim 224	PTO8-0050784 PTO8-0050797
13r.	Application No. 08/464,114 Claim 318, Amendment dated 9/8/2003	PTO8-0076253 PTO8-0076351
	Application No. 08/436,855 Claim 197 dated 12/21/2004	PTO8-0025251 PTO8-0025291
13s.	Application No. 08/464,441 Claim 362, Amendment dated 4/30/2004	PTO8-0081272 PTO8-0081334 - 0081335

⁷ Application was listed as 08/456,006 under Interrogatory 13p. The correct application number is 08/458,006.

Documents Cited in USPTO Interrogatories 12 - 17		
No.	Application	Bates Ranges
	Application No. 08/463,117 Claim 269, Amendment dated 5/28/2004	PTO8-0062260 PTO8-0062304 - 0062305
13t.	Application No. 07/774,159 Claim 93, Amendment dated 5/1/2002	PTO9-0006340 PTO9-0006350
	Application No. 08/419,681 Claim 340 to Office Action dated 3/24/2014	PTO9-0017547 PTO9-0017650
13u.	Application No. 08/430,089 Claim 256, Amendment dated 10/20/2004	PTO9-0030142 PTO9-0030193
	Application No. 08/462,306 Claim 275, Amendment dated 7/8/2003	PTO9-0117611 PTO9-0117624
13v.	Application No. 08/430,089 Claim 232, Amendment dated 10/20/2004	PTO9-0030142 PTO9-0030187
	Application No. 08/462,306 ⁸ Claim 296, Amendment dated 7/8/2003	PTO9-0117611 PTO9-0117631
13w.	Application No. 08/431,638 Claim 114, Amendment dated 1/16/2004	PTO9-0035952 PTO9-0035967
	Application No. 08/435,924 Claim 116 to Office Action dated 1/24/2014	PTO9-0176631 PTO9-0176642 - 0176643
13x.	Application No. 08/431,638 Claim 118, Amendment dated 1/16/2004	PTO9-0035952 PTO9-0035968
	Application No. 08/435,924 Claim 176 to Office Action dated 1/24/2014	PTO9-0176631 PTO9-0176658
13y.	Application No. 08/431,638 Claim 120, Amendment dated 1/16/2004	PTO9-0035952 PTO9-0035968 - 0035969
	Application No. 08/435,924 Claim 177 to Office Action dated 1/24/2014	PTO9-0176631 PTO9-0176658 - 0176659
13z.	Application No. 08/431,638 Claim 124, Amendment dated 1/16/2004	PTO9-0035952 PTO9-0035969 - 0035970
	Application No. 08/435,924 Claim 212 to Office Action dated 1/24/2014	PTO9-0176631 PTO9-0176665
14a.	Application No. 08/418,215, Amendment dated 8/21/2014	PTO7-0034396 - 0034734
14b.	Application No. 08/423,081, Amendment dated 1/8/2015	PTO9-0023539 - 0023791
14c.	Application No. 08/423,235, Amendment dated 9/22/2014	PTO7-0108786 - 0109077
14d.	Application No. 08/438,598, Amendment dated 5/19/2015	PTO9-0069063 - 0069316

⁸ Application was listed as 08/462,302 under Interrogatory 13v. The correct application number is 08/462,306.

Documents Cited in USPTO Interrogatories 12 - 17		
No.	Application	Bates Ranges
14e.	Application No. 08/445,458, Amendment dated 11/12/2014	PTO11-0016414 - 0016695
14f.	Application No. 08/454,884, Amendment dated 5/11/2015	PTO5-0015966 - 0016237
14g.	Application No. 08/455,202, Amendment dated 1/26/2015	PTO5-0040623 - 0041053
14h.	Application No. 08/455,303, Amendment dated 11/24/2014	PTO11-0047223 - 0047530
14i.	Application No. 08/456,327, Amendment dated 7/17/2014	PTO6-0011396 - 0011747
14j.	Application No. 08/457,715, Amendment dated 11/17/2014	PTO10-0108215 - 0108507
14k.	Application No. 08/459,090, Amendment dated 11/21/2014	PTO6-0098323 - 0098637
14l.	Application No. 08/463,109, Amendment dated 12/3/2014	PTO8-0053854 - 0054181
14m.	Application No. 08/463,820, Amendment dated 10/30/2014	PTO8-0068066 - 0068295
14n.	Application No. 08/469,061, Amendment dated 10/28/2014	PTO1-0021621 - 0021924
14o.	Application No. 08/471,152, Amendment dated 9/4/2014	PTO2-0052406 - 0052426
14p.	Application No. 08/471,549, Amendment dated 10/17/2014	PTO12-0052528 - 0052742
14q.	Application No. 08/471,553, Amendment dated 5/26/2015	PTO10-0526573 - 0526928
14r.	Application No. 08/471,599, Amendment dated 9/25/2014	PTO2-0068609 - 0068942
14s.	Application No. 08/471,810, Amendment dated 10/3/2014	PTO4-0040789 - 0041060
14t.	Application No. 08/472,041, Amendment dated 11/24/2014	PTO4-0052317 - 0052826
15a.	Application No. 05/101,881 Claim 40 filed 12/28/1970	PTO13-0001988 PTO13-0002128
	Application No. 08/470,879 Claim 314, Supplemental Amendment dated 10/19/1998	PTO2-0038516 PTO2-0038561
15b.	Application No. 05/101,881 Claim 40 filed 12/28/1970	PTO13-0001988 PTO13-0002128
	Application No. 08/471,599 Claim 173 dated 9/20/2005	PTO2-0069478 PTO2-0069507

Documents Cited in USPTO Interrogatories 12 - 17		
No.	Application	Bates Ranges
16a.	Application No. 08/470,879, Claim 186 filed 4/10/2014	PTO2-0036389 PTO2-0036413
16b.	Application No. 08/470,671, Claim 180 filed 1/9/2014	PTO2-0032784 PTO2-0032815
16c.	Application No. 08/471,547 Claim 155 filed 1/9/2014	PTO2-0056256 PTO2-0056280
17a.	Application No. 08/419,586 Claim 38, Amendment filed 1/11/1996	PTO7-0080398 PTO7-0080429 - 0080430
	Application No. 08/454,874 Claim 121, Amendment filed 4/22/1998	PTO11-0027092 PTO11-0027146 - 0027148
17b.	Application No. 08/455,750 Claim 150, Reply to Office Action dated 4/8/2015	PTO5-0063979 PTO5-0064012 - 0064013
	Application No. 08/419,586 Claim 93, Amendment dated 2/22/2016	PTO7-0075763 PTO7-0075843 - 0075844
17c.	Application No. 08/464,114 Claim 154, Reply to Office Action dated 1/25/2015	PTO8-0074801 PTO8-0074833 - 0074834
	Application No. 08/471,815 Claim 112, Reply to Office Action dated 1/27/2015	PTO2-0087174 PTO2-0087201 - 0087202
17d.	Application No. 08/464,114 Claim 159, Reply to Office Action dated 1/28/2015	PTO8-0074801 PTO8-0074839 - 0074840
	Application No. 08/471,815 Claim 381, Reply to Office Action dated 1/27/2015	PTO2-0087174 PTO2-0087300 - 0087301
17e.	Application No. 08/433,307 Claim 68, Reply to Office Action filed 10/7/2014	PTO1-0014160 PTO1-0014196 - 0014197
	Application No. 08/419,584 Claim 27, Reply to Office Action filed 10/10/2014	PTO7-0062852 PTO7-0062882 - 0062884

Dated: July 12, 2017

Respectfully submitted,

CHANNING D. PHILLIPS, D.C. Bar #415793
United States Attorney
for the District of Columbia

DANIEL F. VAN HORN, D.C. Bar #924092
Chief, Civil Division

By: /s/ Robert E. McBride
JASON T. COHEN, ME Bar #004465
Assistant United States Attorney
ROBERT E. McBRIDE
Special Assistant United States Attorney
ROBERT J. McMANUS
Special Assistant United States Attorney
THOMAS W. KRAUSE
Special Assistant United States Attorney
United States Attorney's Office, Civil Division
555 Fourth Street, NW
Washington, DC 20530
Tel: 202.252.2523
Fax: 202.252.2599
Email: Jason.Cohen@usdoj.gov

Counsel for Defendant

CERTIFICATE OF SERVICE

I hereby certify that on July 12, 2017, the foregoing was delivered electronically to the following counsel for Plaintiff:

Aaron M. Panner
Thomas B. Bennett
KELLOGG, HUBER, HANSEN, TODD, EVANS & FIGEL, P.L.L.C.
1615 M Street, N.W.
Suite 400
Washington, D.C. 20036
apanner@khhte.com
tbennett@khhte.com

Andrew M. Grossman
Paul M. Levine
Mark DeLaquil
Baker & Hostetler LLP
1050 Connecticut Ave., N.W.
Suite 1100
Washington, D.C. 20036
agrossman@bakerlaw.com
pmlevine@bakerlaw.com
mdelaquil@bakerlaw.com

/s/ Robert E. McBride

ROBERT E. MCBRIDE
Special Assistant United States Attorney

FORM CD-516 LF (6-93)	U.S. DEPARTMENT OF COMMERCE	<input type="checkbox"/> NEW _____ <input type="checkbox"/> I/A: _____ MR #: 40 - 24, 25, 27 (GS-15) IP #: _____
CLASSIFICATION AND PERFORMANCE MANAGEMENT RECORD		
* Performance Plan	* Performance Appraisal	* Performance Recognition
* Progress Review		* Position Description
Employee's Name: _____ Social Security No: _____ Position Title : Examination Specialist Primary Patent Examiner Pay Plan, Series, Grade/Step: GS-1224-15 Organization: 1. Department of Commerce 4. Technology Center 2600 2. Patent & Trademark Office 5. Technology Center 2600 3. Assistant Commissioner for Patents 6. AU 2615 Rating Period: October 1, 2013-September 30, 2014 Covered By: <input type="checkbox"/> Senior Executive Service <input type="checkbox"/> General Workforce <input type="checkbox"/> Other _____		
PART A - POSITION DESCRIPTION		
POSITION CERTIFICATION: I certify that this is an accurate statement of the major duties and responsibilities of the position and its organization relationships and that the position is necessary to carry out the Government functions for which I am responsible. This certification is made with the knowledge that this information is to be used for statutory purposes relating to appointment and payment of public funds and that false or misleading statements may constitute violation of such statute or their implementing regulations.		
SUPERVISOR'S SIGNATURE	DATE	SECOND LEVEL SUPERVISOR
CLASSIFICATION CERTIFICATION	OFFICIAL TITLE: _____ PP: _____ SERIES _____ FUNC: _____ GRADE: _____ I/A: <input type="checkbox"/> YES <input type="checkbox"/> NO	
I certify that this position has been classified as required by Title 5, US Code, in conformance with standards published by the OPM or, if no published standards applies directly, consistently with the most applicable published standards.		
NAME AND TITLE OF CLASSIFIER	SIGNATURE	DATE
PART B - PERFORMANCE PLAN		
This plan is an accurate statement of the work that will be the basis of the employee's performance appraisal.		
NAME AND TITLE OF THE FIRST LINE SUPERVISOR/RATING OFFICIAL	SIGNATURE	DATE
APPROVAL - I agree with the certification of the position description and approving the performance plan.		
NAME AND TITLE OF APPROVING OFFICIAL OR SES APPOINTING AUTHORITY	SIGNATURE	DATE
EMPLOYEE ACKNOWLEDGEMENT - My signature acknowledges discussion of the position description and receipt of the plan, and does not necessarily signify agreement.	SIGNATURE	DATE
PRIVACY ACT STATEMENT - Disclosure of your social security number on this form is voluntary. The number is linked with your name in the official personnel records system to ensure unique identification of your records. The social security number will be used solely to ensure accurate entry of your performance rating into the automated record system.		

A. Performance Planning. Complete Items 1, 2, and 3 of Section I by following these seven steps:

Step 1. Identify the performance elements of the employee's job (Item 1). Performance elements are brief, two or three word descriptions of the major responsibilities. (Fill out a separate Section I for each performance element.)

Step 2. Identify each element as critical or non-critical. Specify whether it is a management by objective (MBO). (if so, it must be designated as critical.)

Step 3. State the objective of the element by writing a brief statement that defines what the element is intended to accomplish; focus on the overall result. An example of an objective is "To carry out organizational responsibilities by developing and implementing effective administrative procedures."

Step 4. Assign a weight to the element to show the time devoted to accomplishing the element and/or its importance. The total weight of all performance elements in the plan must equal 100.

Step 5. Identify the major activities (Item 2) or results needed to accomplish the performance element, e.g. develop an operating budget for the office, complete performance plans for all staff.

Step 6. Complete Item 3, "Criteria for Evaluation" by listing any performance standards that will be used to supplement the Generic Performance Standards (GPS) listed in Appendix A. The GPS must be used to evaluate employee performance. Supplemental standards must be included if they (a) apply to a particular element and (b) will be used to evaluate the employee's performance of the element.

Step 7. On the cover page of this form: (a) the rating official must certify as to the accuracy of the employee's position description (p.d.) and authorize the performance plan; (b) the approving official or SES appointing authority must approve the p.d. certification and the performance plan; and (c) the employee must acknowledge discussion of the p.d. and receipt of the performance plan.

B. Progress Review. At least once, near the mid-point of the appraisal period, the rating official must conduct a progress review with the employee by completing the following three steps:

Step 1. For each element in the performance plan, discuss: (a) The employee's progress toward accomplishing the element; (b) The need for any changes to the plan; and (c) any performance deficiencies noticed, along with recommendations on how to improve them.

Step 2. Complete Item 4, "Progress Review" of Section I, noting the areas discussed in step 1.

Step 3. Initial and date the appropriate block in Item 4 (for each performance element) and have the employee do the same to indicate that the progress review took place.

C. Performance Appraisal. Near the end of the appraisal period,

the employee's performance during the year must be appraised formally on the basis of the performance plan by completing the following steps:

Step 1. The rating official formally notifies the employee of the date and time for the appraisal meeting.

Step 2. The employee may participate in a pre-appraisal meeting with the rating official to present his/her assessment of his/her performance during the appraisal period.

Step 3. The rating official complete Item 5, "Element Rating and Justification," of Section I for each performance element, noting specific accomplishments resulting from the employee's performance and relating them to the appropriate rating level (5-Outstanding, 4-Commendable, 3-Fully Successful, 2-Marginal, (Minimally Successful for SES) 1-Unacceptable (Unsatisfactory for SES)). Note: Element ratings of Fully Successful do not require written documentation unless employee requests it. To assign a Fully Successful element rating, the rating official need only document that: (a) the fully successful standards were met, and; (b) that the rating was discussed with the employee.

Step 4. The rating official completes Item 1 of Section II, "Performance Summary and Rating," by transferring the appropriate rating information from each performance element to the summary sheet.

Step 5. Item 2, "Performance Rating," of Section II is completed by the rating official and signed by the approving official before the rating is discussed with the employee. NOTE: If any critical element is rated less than fully successful, the final rating can be no higher than the lowest critical element rating.

Step 6. All the information documented in Steps 3-5 above is discussed with the employee at the formal appraisal meeting and a copy of the rating is given to the employee. The employee signs the form acknowledging that an appraisal meeting was held.

Step 7. The employee may comment in writing to the approving official on his/her summary rating within 5 days of receipt. The approving official must respond in writing to any comments within 10 days of receipt. If the approving official changes a rating, he/she must document the reasons in Item 5.a. of 396A. A copy of the final rating must be given to the employee.

Step 8. For SES Employees Only - The rating official completes Item 3 and submits the entire form (and any employee comments) to the appropriate Performance Review Board (PRB) for its review and recommendations. The PRB chair signs the correct block in Item 3 and forwards the recommendations and the form to the SES Appointing Authority who then assigns the final rating by completing Item 3.4. A copy of the final rating must be given to the employee.

Step 9. For general workforce employees only - The rating official completes any recommendations for performance awards in Section III, and forwards through the approving official, to the proper channels for processing the award.

October 1, 2013-September 30, 2014

FORM CD-396 (Rev. 3-89)

FORM CD-516B LF
(REV 1-94)
DAO 202-430

U.S. Department of Commerce

APPENDIX A GENERIC PERFORMANCE STANDARDS

INSTRUCTIONS

The generic performance standards (GPS) are the primary basis for assigning element ratings in the Department of Commerce. The GPS are to be applied to each critical (and non-critical) element in the performance plan. (Summary ratings are assigned by using a point scale after each element has been rated.)

When evaluating an element, the rater should

1. Read carefully each performance standard level beginning with the fully successful one (it is considered the base level standard.)
2. Determine which level best describes the employee's performance on the element. (Each and every criterion in the standards does not have to be met by the employee in absolute terms for the rater to assign a particular rating level. The sum of the employee's performance of the element must, in the rater's judgment, meet the assigned level's criteria.)
3. Provide in writing, on the appraisal form, specific examples of accomplishments which support the assigned rating level.

Element ratings of fully successful do not require full written documentation unless the employee requests it. To assign a fully successful element rating the rating official need only document in writing that: (1) the fully successful standards were met, and, (2) that the rating was discussed in detail with the employee.

Occasionally, when rating some elements, a rating official may determine that an employee's performance on an element was not consistent. For example, the employee may have performed at the commendable level on several major activities within a critical element and at the marginal level on several others. In such a case, the rating official must consider the overall effect of the employee's work on the element and make a judgment as to the appropriate rating he/she will assign. The rationale for the decision must be documented on the rating form citing specific accomplishments which support the decision.

Any additional standards that are included in the performance plan must also be considered by the rating official. Such standards are included in performance plans to supplement GPS, not to supplant them. Rating officials should consider such standards within the context of the GPS and rate elements accordingly.

OUTSTANDING

SES

This is a level of rare high-quality performance. The employee has performed so well that organizational goals have been achieved that would not have been otherwise. The employee's mastery of the technical skills and thorough understanding of the mission have been fundamental to the completion of program objectives.

The employee has exerted a major positive influence on management practices, operating procedures, and program implementation, which has contributed substantially to organizational growth and recognition. Preparing for the unexpected, the employee has planned and used alternate ways of reaching goals. Difficult assignments have been handled intelligently and effectively, the employee has produced an exceptional quantity of work often ahead of established schedules with little or no delay.

In writing and speaking, the employee presents complex ideas clearly in a wide range of difficult communications situations. Desired results are attained.

GENERAL WORK FORCE

This is level of rare, high-quality performance. The quality and quantity of the employee's work substantially exceed fully successful standards and rarely leave room for improvement. The impact of the employee's work is such significance that organizational objectives were accomplished that otherwise would not have been. The accuracy and thoroughness of the employee's work on this element are exceptionally reliable. Application of technical knowledge and skills goes beyond that expected for the position. The employee significantly improves the work processes and products for which he or she is responsible. Thoughtful adherence to procedures and formats, as well as suggestions for improvement in these areas, increase the employee's usefulness.

This person plans so that work follows the most logical and practical sequence; inefficient backtracking is avoided. He or she develops contingency plans to handle potential problems and adapts quickly to new priorities and changes in procedures and programs without losing sight of the longer-term purposes of the work. These strengths in planning and adaptability result in early or timely completion of work under all but the most extraordinary circumstances. Exceptions occur only when delays could not have been anticipated. The employee's planning skills result in cost-savings to the government.

In meeting element objectives, the employee handles interpersonal relationships with exceptional skill, anticipating and avoiding potential causes of conflict and actively promoting cooperation with clients, co-workers, and his or her supervisor.

The employee seeks additional work or special assignments related to this element at increasing levels of difficulty. The quality of such work is high and is done on time without disrupting regular work. Appropriate problems are brought to the supervisor's attention, most problems are dealt with routinely and with exceptional skill.

The employee's oral and written expression are exceptionally clear and effective. They improve cooperation among participants in the work and prevent misunderstandings. Complicated or controversial subjects are presented or explained effectively to a variety of audiences so that desired outcomes are achieved.

SUPERVISORY

The employee is a strong leader who works well with others and handle difficult situations with dignity and effectiveness. The employee encourages independence and risk-taking among subordinates, yet takes responsibility for their actions. Open to views of others, the employee promotes cooperation among peers and subordinates, while guiding, motivating, and stimulating positive responses. The employee's work performance demonstrates a strong commitment to fair treatment, equal opportunity, and the affirmative action objectives of the organization.

COMMENDABLE

SES

This is a level of unusually good performance. It has exceeded expectations in critical areas and shows sustained support of organizational goals. The employee has shown a comprehensive understanding of the objectives of the job and procedures for meeting them.

The effective planning of the employee has improved the quality of management practices, operating

procedures, task assignments, or program activities. The employee has developed or implemented workable and cost-effective approaches to meeting organizational goals.

The employee has demonstrated an ability to get the job done well in more than one way, while handling difficult and unpredictable problems. The employee produces a high quantity of work, often ahead of established schedules with less than normal supervision.

The employee writes and speaks clearly on difficult subjects to a wide range of audiences.

GENERAL WORK FORCE

This is a level of unusually good performance. The quantity and quality of work under this element are consistently above average. Work products rarely require even minor revision. Thoroughness and accuracy of work are reliable. The knowledge and skill the employee applies to this element are clearly above average, demonstrating problem-solving skill and insight into work methods and techniques. The employee follows required procedures and supervisory guidance so as to take full advantage of existing systems for accomplishing the organization's objectives.

The employee plans the work under this element so as to proceed in an efficient, orderly sequence that rarely requires backtracking and consistently leads to completion of the work by established deadlines. He or she uses contingency planning to anticipate and prevent problems and delays. Exceptions occur when delays have caused outside the employee's control. Cost savings are considered in the employee's planning.

The employee works effectively on this element with co-workers, clients, as appropriate, and his or her supervisor, creating a highly successful cooperative effort. He or she seeks out additional work or special assignments that enhance accomplishment of this element and pursues them to successful conclusion without disrupting regular work. Problems which surface are dealt with; supervisory intervention to correct problems occurs rarely.

The oral and written expression applied to this element are noteworthy for their clarity and effectiveness, leading to improved understanding of the work by other employees and clients of the organization. Work products are generally given sympathetic consideration because they are well presented.

SUPERVISORY

The employee is a good leader, establishes sound working relationships and shows good judgment in dealing with subordinates, considering their views. He/she provides opportunities for staff to have a meaningful role in accomplishing organizational objectives and makes special efforts to improve each subordinate's performance.

FULLY SUCCESSFUL

SES

This is the level of good, sound performance. The employee has contributed positively to organizational goals. All critical element activities that could be completed are. The employee effectively applies technical skills and organizational knowledge to get the job done.

The employee successfully carries out regular duties while also handling any difficult special assignments. The employee plans and performs work according to organizational priorities and schedule.

The employee also works well as a team member supporting the group's efforts and showing an ability to handle a variety of interpersonal situations.

The employee communicates clearly and effectively.

All employees at this level and above have followed a management system by which work is planned, tasks are assigned, and deadlines are met.

GENERAL WORK FORCE

This is the level of good, sound performance. The quality and quantity of the employee's work under this element are those of a fully competent employee. The performance represents a level of accomplishment expected of the great majority of employees. The employee's work products fully meet the requirements of the element. Major revisions are rarely necessary; most work requires only minor revision. Tasks are completed in an accurate, thorough, and timely way. The employee's technical skills and knowledge are applied effectively to specific job tasks. In completing work assignments, he or she adheres to procedures and format requirements and follows necessary instructions from supervisors.

The employee's work planning is realistic and results in completion of work by established deadlines. Priorities are duly considered in planning and performing assigned responsibilities. Work reflects a consideration of cost to the government, when possible.

In accomplishing element objectives, the employee's interpersonal behavior toward supervisors, co-workers, and users promotes attainment of work objectives and poses no significant problems.

The employee completes special assignments so their form and content are acceptable and regular duties are not disrupted. The employee performs additional work as his/her workload permits. Routine problems associated with completing assignments are resolved with a minimum of supervision.

The employee speaks and writes clearly and effectively.

SUPERVISORY

The employee is a capable leader who works successfully with others and listens to suggestions.

The employee rewards good performance and corrects poor performance through sound use of performance appraisal systems, performance-based incentives and when needed, adverse actions, and selects and assigns employees in ways that use their skills effectively.

The employee's work performance shows a commitment to fair treatment, equal opportunity, and the affirmative action objectives of the organization.

MARGINAL

SES

This level of performance, while demonstrating some positive contributions to the organization, shows notable deficiencies. It is below the level expected for the position and requires corrective action. The quality, quantity or timeliness of the employee's work is less than Fully Successful, jeopardizing attainment of the element's objective. The employee's work under this element is at a level which may result in removal from the position.

There is much in the employee's performance that is useful. However problems with quality, quantity or timeliness are too frequent or too serious to ignore. Performance is inconsistent and problems caused by deficiencies counterbalance acceptable work. These deficiencies cannot be overlooked since they create adverse consequences for the organization or create burdens for other

personnel. When needed as input into another work process, the work may not be finished with such quality, quantity and timeliness that other work can proceed as planned.

Although the work products are generally of useable quality, too often they require additional work by other personnel. The work products do not consistently and/or fully meet the organization's needs. Although mistakes may be without immediate serious consequences, over time they are detrimental to the organization.

A fair amount of work is accomplished, but the quantity does not represent what is expected of Fully Successful employees. Output is not sustained consistently and/or higher levels of output usually result in decreased quality. The work generally is finished within expected timeframes but significant deadlines too often are not met.

The employee's written and oral communications usually consider the nature and complexity of the subject and the intended audience. They convey the central points of the information important to accomplishing the work. However, too often the communications are not focused, contain too much or too little information, and/or are conveyed in a tone that hinders achievement of the purpose of the communications. The listener or reader must question the employee at times to secure complete information or avoid misunderstandings.

GENERAL WORK FORCE

This level of performance, while demonstrating some positive contributions to the organization, shows notable deficiencies. It is below the level expected for the position, and requires corrective action. The quality, quantity or timeliness of the employee's work is less than Fully Successful, jeopardizing attainment of the element's objective.

There is much in the employee's performance that is useful. However problems with quality, quantity or timeliness are too frequent or too serious to ignore. Performance is inconsistent and problems caused by deficiencies counterbalance acceptable work. These deficiencies cannot be overlooked since they create adverse consequences for the organization or create burdens for other personnel. When needed as input into another work process, the work may not be finished with such quality, quantity and timeliness that other work can proceed as planned.

Although the work products are generally of useable quality, too often they require additional work by other personnel. The work products do not consistently and/or fully meet the organization's needs. Although mistakes may be without immediate serious consequences, over time they are detrimental to the organization.

A fair amount of work is accomplished, but the quantity does not represent what is expected of Fully Successful employees. Output is not sustained consistently and/or higher levels of output usually result in decreased quality. The work generally is finished within expected timeframes but significant deadlines too often are not met.

The employee's written and oral communications usually consider the nature and complexity of the subject and the intended audience. They convey the central points of the information important to accomplishing the work. However, too often the communications are not focused, contain too much or too little information, and/or are conveyed in a tone that hinders achievement of the purpose of the communications. In communications to coworkers, the listener or reader must question the employee at times to secure complete information or avoid misunderstandings.

SUPERVISORY

Inadequacies surface in performing supervisory duties. Deficiencies in areas of supervision over an extended period of time affect adversely employee

productivity or morale or organizational effectiveness. The marginal employee does not provide strong leadership or take the appropriate initiative to improve organizational effectiveness. For example, he/she too often fails to make decisions or fulfill supervisory responsibilities in a timely manner to provide sufficient direction to subordinates on how to carry out programs, to give clear assignments and/or performance requirements, and/or to show an understanding of the goals of the organization or subordinates' roles in meeting those goals.

UNSATISFACTORY

SES

This is the level of unacceptable performance. Work products do not meet the minimum requirements of the critical element.

Most of the following deficiencies are typically, but not always, characteristic of the employee's work.

- * Little or no contribution to organizational goals;
- * Failure to meet work objectives;
- * Inattention to organizational priorities and administrative requirements;
- * Poor work habits resulting in missing deadlines, incomplete work products;
- * Strained work relationships;
- * Failure to respond to client needs; and/or
- * Lack of response to supervisor's corrective efforts.

GENERAL WORK FORCE

The quantity and quality of the employee's work under this element are not adequate for the position. The employee's work products fall short of requirements of the element. They arrive late or often require major revision because they are incomplete or inaccurate in content. The employee fails to apply adequate technical knowledge to complete the work of this element. Either the knowledge applied cannot produce the needed products, or it produces technically inadequate products or results. Lack of adherence to required procedures, instructions, and formats contributes to inadequate work products.

Because the employee's work planning lacks logic or realism, critical work remains incomplete or is unacceptably late. Lack of attention to priorities causes delays or inadequacies in essential work, the employee has concentrated on incidental matters.

The employee's behavior obstructs the successful completion of the work by lack of cooperation with clients, supervisor, and/or coworkers, or loss of credibility due to irresponsible speech or work activities.

In dealing with special projects, the employee either sacrifices essential regular work or fails to complete projects. The employee fails to adapt to changes in priorities, procedures, or program direction and therefore, cannot operate adequately in relation to changing requirements.

The oral and written expression the employee uses in accomplishing the work of this element lacks necessary clarity for successful completion of required tasks. Communication failures interfere with completion of work.

SUPERVISORY

Most of the following deficiencies are typical, but not always, common, characteristics of the employee's work.

- * Inadequate guidance to subordinates;
- * Inattention to work progress; and
- * Failure to stimulate subordinates to meet goals.

Supervisory standards must be applied to SES and General Work Force supervisors.

Examination Review

Art Unit: 2615

Examiner: 0

Item 4. Progress Reviews (Indicate progress toward accomplishing this element, the need for any adjustments to the plan, or areas where performance needs to be improved)

Employee's Initials	Date	Employee's Initials	Date
Supervisor's Initials	Date	Supervisor's Initials	Date

Item 5. Element Rating & Justification (support rating in space below)

5- Outstanding 4- Commendable 3- Fully Successful 2- Marginal 1- Unacceptable

Enter Rating
1-5 in adjacent
block

Item 5.a. Approving/Appointing Authority Comments and Signature (Required only if approving/appointing authority changes rating official's element rating in Item 5.)

Approving/Appointing Authority Signature

Date

Action Taking

Art Unit: 2615

Examiner: 0

Item 4. Progress Reviews (Indicate progress toward accomplishing this element, the need for any adjustments to the plan, or areas where performance needs to be improved)

Employee's Initials	Date	Employee's Initials	Date
Supervisor's Initials	Date	Supervisor's Initials	Date

Item 5. Element Rating & Justification (support rating in space below)

5- Outstanding 4- Commendable 3- Fully Successful 2- Marginal 1- Unacceptable

Enter Rating
1-5 in adjacent
block

Item 5.a. Approving/Appointing Authority Comments and Signature (Required only if approving/appointing authority changes rating official's element rating in Item 5.)

Approving/Appointing Authority Signature

Date

Patentability Determination

Art Unit: 2615

Examiner: 0

Item 4. Progress Reviews (Indicate progress toward accomplishing this element, the need for any adjustments to the plan, or areas where performance needs to be improved)

Employee's Initials	Date	Employee's Initials	Date
Supervisor's Initials	Date	Supervisor's Initials	Date

Item 5. Element Rating & Justification (support rating in space below)

5- Outstanding 4- Commendable 3- Fully Successful 2- Marginal 1- Unacceptable

Enter Rating
1-5 in adjacent
block

Item 5.a. Approving/Appointing Authority Comments and Signature (Required only if approving/appointing authority changes rating official's element rating in Item 5.)

Approving/Appointing Authority Signature

Date

Workflow Management

Art Unit: 2615

Examiner: 0

Item 4. Progress Reviews (Indicate progress toward accomplishing this element, the need for any adjustments to the plan, or areas where performance needs to be improved)

Employee's Initials	Date	Employee's Initials	Date
Supervisor's Initials	Date	Supervisor's Initials	Date

Item 5. Element Rating & Justification (support rating in space below)

5- Outstanding 4- Commendable 3- Fully Successful 2- Marginal 1- Unacceptable

Enter Rating
1-5 in adjacent
block

Item 5.a. Approving/Appointing Authority Comments and Signature (Required only if approving/appointing authority changes rating official's element rating in Item 5.)

Approving/Appointing Authority Signature

Date

Stakeholder Interaction

Art Unit: 2615

Examiner: 0

Item 4. Progress Reviews (Indicate progress toward accomplishing this element, the need for any adjustments to the plan, or areas where performance needs to be improved)

Employee's Initials	Date	Employee's Initials	Date
Supervisor's Initials	Date	Supervisor's Initials	Date

Item 5. Element Rating & Justification (support rating in space below)

5- Outstanding 4- Commendable 3- Fully Successful 2- Marginal 1- Unacceptable

Enter Rating
1-5 in adjacent
block

Item 5.a. Approving/Appointing Authority Comments and Signature (Required only if approving/appointing authority changes rating official's element rating in Item 5.)

Approving/Appointing Authority Signature

Date

SECTION II - PERFORMANCE SUMMARY AND RATING

Name: 0

ITEM 1. Instructions

1. List each element in the performance plan; indicate whether it is critical/non-critical and what weight has been assigned to it.
2. Assign a rating level for each element: (5) Outstanding (4) Commendable (3) Fully Successful (2) Marginal/Minimally Satisfactory (1) Unacceptable/Unsatisfactory (SES)
3. Score each element by multiplying the weight by the rating level.
4. After each element has been scored, compute the total score by summing all individual scores. Total score can range from 100 to 500.

Performance Element	Critical or Non-critical (C or NC)	MBO	Individual Weights (Sum must total 100)	Element Rating (1-5)	Score
I. Examination Review (Patent Examining)	C		30%	0	0
II. Action Taking (Patent Examining)	C		20%	0	0
III. Patentability Determination (Patent Examining)	C		20%	0	0
IV. Workflow Management	C		20%	0	0
V. Stakeholder Interaction	NC		10%	0	0
			100%	TOTAL SCORE	0

For SES: Turn to reverse side and continue with Item 3.

ITEM 2. PERFORMANCE RATING (Based on total score *except that if any critical element is less than fully successful the rating can be no higher than the lowest critical element rating*)☐ Outstanding (460-500)☐ Commendable (380-459)☐ Fully Successful (290-379)☐ Marginal (200-289)☐ Unacceptable (100-199)

Rating Official's Signature	Title	Date:
Approving Official's Signature	Title	Date:
Employee's Signature (Indicates appraisal meeting held)	Employee Comments Attached <input type="checkbox"/> Yes <input type="checkbox"/> No	Date:

Section III. - PERFORMANCE RECOGNITION (General Workforce only)

☐ Performance Award: \$ _____ (_____ %) For performance awards: Has employee been promoted during the appraisal cycle? ☐ Yes ☐ No

☐ QSI (Outstanding rating required)

Appropriation No: _____

Rating Official's Signature	Title	Date:
Approving Official's Signature	Title	Date:
Final Approving Authority's Signature		Date:
Payment Authorized by Personnel Office		Date:

SECTION 1 - PERFORMANCE PLAN, PROGRESS REVIEW AND APPRAISAL RECORD

Name 0 Date 6/20/2018 Sheet No. 1 of 2

Item 1. Performance Element and Objective (Identify as Critical or Non-critical, and if it is being tracked at the department level.)

☒ Critical ☐ Non-Critical ☐ Management-by-Objectives (MBO)

Element: I. Examination Review (Patent Examining)

Objective To formulate appropriate action or recommendation therefor with respect to the grant or denial of a patent to an applicant.

Weighting Factor (Weights reflect the amount of time devoted to accomplishing the element and/or its importance. Weight for performance plans must total 100. Enter Weight for this element in the adjacent box.)

30

Item 2. Major Activities (Identify activities or results that need to be accomplished in support of the performance element.)

With no preliminary instructions, the examiner performs the following patent examining functions and formulates or recommends appropriate action with respect to each: (1) checking applications for (a) compliance with formal requirements and (b) technological accuracy; (2) treating disclosure statements and claims of priority; (3) analyzing amended disclosure and claims for newly presented and amended patent claims for compliance with 35 USC 112; (4) planning field of search; (5) conducting search; and (6) formulating rejections under 35 USC 102 and 103 with supporting rationale, or determining how claim(s) distinguish over the prior art; (7) determining whether amendment introduces new matter; (8) determining whether the newly claimed invention is operable/useful as disclosed; (9) evaluating/applying case law as necessary; (10) evaluating sufficiency of affidavits/declarations; (11) determining whether appropriate line of patentable distinction is maintained between applications and/or patents; (12) evaluating appropriateness of grounds for examination; and (13) Participates in examination review panels for outgoing office actions. The examiner signs Office actions.

Item 3. Criteria for Evaluation (Use the generic performance standards printed in Appendix A. Supplemental performance standards may also be specified below.)

The deficient performance of a patent examining function will be considered as having occurred where a reasonable SPRE could not have permitted the performance of the examiner. If the performance of the examiner is reasonable and that proposed by the SPRE is reasonable, this would represent an honest and legitimate difference of opinion and does not constitute a deficient performance.

The examiner shall be assigned a rating with respect to the patent examining functions in accordance with the maximum error rate criteria and the additional criteria defined below. The error rates specified are the maximum percentage of Office actions containing the deficient performance of a designated patent examining function as defined herein of the total number of Office actions counted during the period under consideration.

Outstanding: Maximum error rate with respect to functions 1(b), 2 to 7 and 11 (above) will be up to 3.49%. Maximum error rate with respect to all other assigned functions will be up to 4.49%. Further, appropriate action is taken or formulated to advance the prosecution, correct other informalities, and develop a complete file wrapper record.

Optional Initial Block

(Continued on next page)

Emp.	Date	Supv.	Date
------	------	-------	------

SECTION 1 - PERFORMANCE PLAN, PROGRESS REVIEW AND APPRAISAL RECORD

Name 0 Date 6/20/2018 Sheet No. 2 of 2

Item 3. Criteria for Evaluation (Use generic performance standards printed in Appendix A. Supplemental performance standards may also be specified below.)

The formulated or recommended work product rarely requires revision and leaves little room for improvement. All oral and written expression clearly and concisely present the positions taken or recommended in the resulting Office actions.

Commendable: Maximum error rate with respect to functions 1(b), 2 to 7 and 11 (above) will be up to 4.49%. Maximum error rate with respect to all other assigned functions will be up to 5.49%. The formulated or recommended work is complete, accurate, and rarely requires revision. Substantially all oral and written expression clearly and concisely present the positions taken or recommended in the resulting Office actions.

Fully Successful: Maximum error rate with respect to all assigned functions will be up to 5.49%. Substantially all the formulated or recommended work is complete and accurate, requiring only minimum revision. Substantially all oral and written expression effectively conveys the positions taken or recommended in the resulting Office actions.

Marginal: Maximum error rate with respect to functions 1(b), 2 to 7 and 11 (above) will be up to 7%. Maximum error rate with respect to all other assigned functions will be up to 7%. Substantially all the formulated or recommended work product is complete and accurate with respect to the performance of functions 1(b), 2 to 7 and 11 (above), requiring only minimum revision. Substantially all oral reports, with respect to final actions, effectively present the positions taken or recommended by the examiner. Substantially all written drafts are complete and accurate, incorporating, where orally reported, the approved action to be taken in the resulting Office actions. Continued or repetitive performance at this level adversely impacts upon the efficiency of the service under the performance Element.

Unacceptable: Performance is not adequate for the position, failing to meet the Marginal level. The following deficiencies may be characteristic of that performance:

- 1) An error rate with respect to functions 1(b), 2 to 7 and 11 (above) is greater than 7% and/or repetitive deficiencies in the same one of functions 1(b), 2 to 7 and 11 (above) occur and/or;
- 2) An error rate with respect to the same one of functions 1(a), 8 to 10, and 12 to 14 (above) is greater than 7% and/or;
- 3) In repetitive instances, the formulated or recommended work product requires major revision because of incompleteness and inaccuracy and/or;
- 4) Oral reports lack the necessary clarity and organization to effectively convey the position taken or recommended by the examiner.

SECTION 1 - PERFORMANCE PLAN, PROGRESS REVIEW AND APPRAISAL RECORD

Name 0

Date 6/20/2018

Sheet No. 1 of 2

Item 1. Performance Element and Objective (Identify as Critical or Non-critical, and if it is being tracked at the department level.)

[X] Critical [] Non-Critical [] Management-by-Objectives (MBO)

Element: II. Action Taking (Patent Examining)

Objective To formulate clear and complete Office actions with respect to the grant or denial of patent to an applicant.

Weighting Factor (Weights reflect the amount of time devoted to accomplishing the element and/or its importance. Weight for performance plans must total 100. Enter Weight for this element in the adjacent block.)

20

Item 2. Major Activities (Identify activities or results that need to be accomplished in support of the performance element.)

The examiner formulates and independently signs Office actions (as set forth M.P.E.P. 1004) in which, without committing clear error, the examiner:

a) 1) The examiner's statements of rejection, objection, and response to arguments clearly and concisely present the positions taken or recommended in the resulting Office actions including a thorough substantive explanation to convey those positions to the applicant.;

b) makes no unreasonable rejection;

c) makes no unreasonable formal requirement;

d) takes no arbitrary or capricious action;

e) makes the record, taken as a whole, reasonably clear and complete; and

f) properly treats all matters of substance in applicant's response.

g) The examiner's Office action usually refer an applicant's attention to relevant and helpful elements, figures, and/or text upon which the examiner relies to support his or her position.

h) The Office actions as well as the file record clearly indicate that the examiner fully complies with the principles of compact prosecution. Note the principle of compact prosecution comprises conducting an initial search which is as complete as possible including consultation with an expert in the art where the examiner lacks such expertise; placing art of record which meets both the concept and the wording of the claims as well as other art which is pertinent to significant though unclaimed features of the disclosed invention; and issuing a first Office action which clearly explains the examiner's position on each essential issue in such detail that absent some unexpected consideration the next Office action may be made final.

Item 3. Criteria for Evaluation (Use generic performance standards printed in Appendix A. Supplemental performance standards may also be specified below.)

"Clear error" in an action taken (or not taken) will be considered as having occurred where a reasonable SPRE could not have permitted the action (or inaction) at the time and under the circumstances that the action (or inaction) was taken. Clear error as defined here is not to be confused with an honest and legitimate difference of opinion as to what action should have been taken. If the action taken by the examiner is reasonable and the action preferred by the SPRE is reasonable, this constitutes an honest difference of opinion and the action taken by the examiner is free of clear error.

An examiner shall be assigned a rating with respect to action taking in accordance with the maximum error rate criteria defined in (1) - (5) below. The error rates specified are the maximum percentage of Office actions containing clear error as defined herein of the total number of Office actions which the examiner has been delegated the authority to independently sign (as set forth in M.P.E.P. 1004) and which have been counted during the period under consideration.

Optional Initial Block

(Continued on next page)

Emp.	Date	Supv.	Date
------	------	-------	------

Form CD-396A (Rev. 5-12)

USCOMM-DC 87-1650

Action Taking

Art Unit: 2615

Fiscal Year: 2012

GS-15 FSA

SECTION 1 - PERFORMANCE PLAN, PROGRESS REVIEW AND APPRAISAL RECORD

Name 0

Date 6/20/2018

Sheet No. 2 of 2

Item 3. Criteria for Evaluation (Use generic performance standards printed in Appendix A. Supplemental performance standards may also be specified below.)

- (1) Maximum error rate for an Outstanding rating will be up to 3.49%.
- (2) Error rate for a Commendable rating will be 3.5 - 4.49%.
- (3) Error rate for a Fully Successful rating will be 4.5 - 5.49%.
- (4) Error rate for a Marginal rating will be 5.5 - 7%.
- (5) An error rate of greater than 7% will result in an Unacceptable rating.

To receive a Commendable rating in action taking, an examiner must demonstrate in his or her work the presence of two of the indicia of outstanding action taking (below). To receive an Outstanding rating in action taking, an examiner must demonstrate in his or her work the presence of all of the indicia of outstanding action taking (below).

Indicia of Outstanding Action Taking

- 1) Ensures that substantially all actions are completed within 1 month of the date of response.
- 2) The explanations of the examiner's position contained in the examiner's Office action are stated clearly, and are accompanied by information or references, as appropriate, such that the patent owner can readily ascertain the propriety of continuing the prosecution
- 3) The Office actions as well as the file record clearly indicate that the examiner fully complies with the principles of compact prosecution. Note the principle of compact prosecution comprises conducting an initial search which is as complete as possible including consultation with an expert in the art where the examiner lacks such expertise; placing art of record which meets both the concept and the wording of the claims as well as other art which is pertinent to significant though unclaimed features of the disclosed invention; and issuing a first Office Action which clearly explains the examiner's position on each essential issue in such detail that absent some unexpected consideration the next Office Action may be made final.

Form CD-396A (Rev. 5-12)

USCOMM-DC 87-1650

Patentability Determination

Art Unit: 2615

Fiscal Year: 2012

GS-15 FSA

SECTION 1 - PERFORMANCE PLAN, PROGRESS REVIEW AND APPRAISAL RECORD

Name 0 Date 6/20/2018 Sheet No. 1 of 2

Item 1. Performance Element and Objective (Identify as Critical or Non-critical, and if it is being tracked at the department level.)

☒ **Critical** ☐ Non-Critical ☐ Management-by-Objectives (MBO)

Element: III. Patentability Determination (Patent Examining)

Objective To determine that all allowed claims in an allowed application are patentable.

Weighting Factor (Weights reflect the amount of time devoted to accomplishing the element and/or its importance. Weight for performance plans must total 100. Enter Weight for this element in the adjacent block.)

20

Item 2. Major Activities (Identify activities or results that need to be accomplished in support of the performance element.)

The examiner formulates and independently signs Office actions (as set forth M.P.E.P. 1004) in which, without committing clear error, the examiner:

- a) determines that all claims are patentable (under 35 USC 102 and 103), over the art of record;
- b) determines that all claims are patentable (under 35 USC 102 and 103), over all art which is not of record but should have been;
- c) determines that all claims are patentable over all other pertinent sections of the statute (e.g. 101, 112, 251, etc.);
- d) determines that all claims are patentable over all non-statutory rejections (e.g. obviousness type double patenting).

Item 3. Criteria for Evaluation (Use generic performance standards printed in Appendix A. Supplemental performance standards may also be specified below.)

"Clear error" in the allowance of a claim will be considered as having occurred where a reasonable SPRE could not have permitted the allowance. Clear error as defined here is not to be confused with an honest and legitimate difference of opinion as to what is and what is not patentable. If the determination made by the examiner is reasonable and the determination proposed by the SPRE is reasonable, this constitutes an honest and legitimate difference of opinion and does not constitute a clear error.

An examiner shall be assigned a rating with respect to patentability determination in accordance with the maximum error rate criteria defined in (1) - (5) below. The error rates specified are the maximum percentage of allowed applications containing "clear error" as defined herein of the total number of allowed applications which the examiner has been delegated the authority to independently sign (as set forth in M.P.E.P. 1004) and for which the examiner has received credit for allowance during the period under consideration.

Optional Initial Block

(Continued on next page)

Emp.	Date	Supv.	Date
------	------	-------	------

Form CD-396A (Rev. 5-12)

USCOMM-DC 87-1650

Patentability Determination

Art Unit: 2615

Fiscal Year: 2012

GS-15 FSA

SECTION 1 - PERFORMANCE PLAN, PROGRESS REVIEW AND APPRAISAL RECORD

Name 0 Date 6/20/2018 Sheet No. 2 of 2

Item 3. Criteria for Evaluation (Use generic performance standards printed in Appendix A. Supplemental performance standards may also be specified below.)

- (1) Maximum error rate for an Outstanding rating will be 0 - 1.49%.
- (2) Maximum error rate for a Commendable rating will be 1.50 - 2.49%.
- (3) Maximum error rate for a Fully Successful rating will be 2.50 - 4.49%.
- (4) Maximum error rate for a Marginal rating will be 4.50 - 7%.
- (5) An error rate of greater than 7% will result in an Unacceptable rating.

To receive a Commendable rating in patentability determination, an examiner must demonstrate in his or her work the presence of two

of the indicia of outstanding patentability determination (below). To receive an Outstanding rating in patentability determination, an examiner must demonstrate in his or her work the presence of all of the indicia of outstanding patentability determination (below).

Indicia of Outstanding Patentability Determination

- 1) The record usually developed by the examiner shows an indication of allowable subject matter at the earliest time which is consistent with the file record and prosecution of the application.
- 2) Through the rejections and arguments made by the examiner, an appropriate line of patentability is normally established which results in amendment(s) properly limiting the scope of an applicant's claims.
- 3) The search record in the application clearly shows that the examiner usually construes the claimed subject matter in its broadest reasonable interpretation and seeks to develop prior art from the appropriate peripherally related art areas.

Form CD-396A (Rev. 5-12)

USCOMM-DC 87-1650

Examination Review

Art Unit: 2615

Fiscal Year: 2012

GS-15FSA

SECTION 1 - PERFORMANCE PLAN, PROGRESS REVIEW AND APPRAISAL RECORD

Name 0 Date 8/24/2005 Sheet No. 2 of 2

Item 3. Criteria for Evaluation (Use generic performance standards printed in Appendix A. Supplemental performance standards may also be specified below.)

- (1) Maximum error rate for an Outstanding rating will be 0 - 1.49%.
- (2) Maximum error rate for a Commendable rating will be 1.50 - 2.49%.
- (3) Maximum error rate for a Fully Successful rating will be 2.50 - 4.49%.
- (4) Maximum error rate for a Marginal rating will be 4.50 - 7%.
- (5) An error rate of greater than 7% will result in an Unacceptable rating.

To receive a Commendable rating in examination review, an examiner must demonstrate in his or her work the presence of two of the indicia of outstanding examination review (below). To receive an Outstanding rating in examination review an examiner must demonstrate in his or her work the presence of all of the indicia of outstanding examination review (below).

1) Proper determination pending patent application.

2) Ensure compliance with Statutes, Rules, Regulations, guidelines and procedures for all incoming and outgoing papers (including responses, office actions, and papers submitted by the appropriate parties) associated with the pending patent application.

3) Ensure the litigation history of the involved patent is reviewed, appropriately noted and taken under consideration when determining the outcome of the examination.

Form CD-396A (Rev. 5-12)

Workflow Management

Art Unit: 2615

Fiscal Year: 2012

USCOMM-DC 87-1650

GS 15 FSA

SECTION 1 - PERFORMANCE PLAN, PROGRESS REVIEW AND APPRAISAL RECORD

Name 0 Date 6/20/2018 Sheet No. 1 of 4

Item 1. Performance Element and Objective (Identify as Critical or Non-critical, and if it is being tracked at the department level.)

☒ **Critical** ☐ Non-Critical ☐ Management-by-Objectives (MBO)

Element: IV. **Workflow Management**

Objective To expedite the flow of patent applications through the examination process in accordance with Office policy and provide appropriate service to the public and peers.

Weighting Factor (Weights reflect the amount of time devoted to accomplishing the element and/or its importance. Weight for performance plans must total 100. Enter Weight for this element in the adjacent box.)

10

Item 2. Major Activities (Identify activities or results that need to be accomplished in support of the performance element.)

Except where the SPE, Director, or other appropriate authority has waived, excused, or directed otherwise, the examiner:

- 1) Handles all applications and proceedings awaiting action in accordance with the time period or special handling instructions prescribed by current Office policy;
- 2) Forwards all work for processing and/or handling promptly or in accordance with prescribed time periods;
- 3) Conducts all interviews and/or other contacts with the public as scheduled with adequate preparation, and in a courteous manner. Further, no interview and/or other is arbitrarily or capriciously refused by the examiner.

Item 3. Criteria for Evaluation (Use generic performance standards printed in Appendix A. Supplemental performance standards may also be specified below.)

I. The following are the respective time periods or the special handling instructions prescribed for completing and submitting for credit an appropriate response in applications or proceedings awaiting action:

- 1) Appeal briefs and amendments responding to non-final Office actions within two (2) months of their receipt by the examiner;
- 2) Post-final rejection amendments or communications within ten (10) calendar days after the examiner's receipt thereof;
- 3) Special cases, designated below, within the prescribed time period or in accordance with special handling instructions noted for the case (below):
 - a) Reissue applications in litigation - next available case after the expiration of two months from the O.G. notice;
 - b) Applications made special by petition - next available case; and
 - c) Reissue applications not involved in litigation - next available case after the expiration of two months from the O.G. notice.

Optional Initial Block

Emp.	Date	Supv.	Date
------	------	-------	------

Form CD-396A (Rev. 5-12)

USCOMM-DC 87-1650

Workflow Management

Art Unit: 2615

Fiscal Year: 2012

GS 15 FSA

SECTION 1 - PERFORMANCE PLAN, PROGRESS REVIEW AND APPRAISAL RECORD

Name 0 Date 6/20/2018 Sheet No. 2 of 4

Item 3. Criteria for Evaluation (Use generic performance standards printed in Appendix A. Supplemental performance standards may also be specified below.)

II. The following items of work are to be processed and/or handled promptly or in accordance with the prescribed time period established for the particular application or proceeding:

- 1) Printer Waiting cases - within the time period established for the particular case; and
- 2) Signing and/or proofreading of Office communications for mailing and/or correction - promptly.

III. In the evaluation criteria below (instances 1 to 12) and the definitions set forth in I and II above, an examiner is responsible for any prescribed time period or special handling instruction. However, an examiner shall not be held responsible for a delay which is beyond his or her immediate control. A prescribed time period or special handling instruction will be waived, excused, or extended provided that the examiner has timely informed his or her immediate supervisor of a delay which is beyond his or her immediate control. Where there is insufficient time to allow the timely completion of all items of work within their respective prescribed time periods or in accordance with special handling instructions, the immediate supervisor may determine the priority in which those items of work are to be completed by the examiner.

IV. An examiner will start at zero (0) points and will be credited base line points for the rating period as follows:
(base line rate) x (the number of biweekly periods which have been completed in the rating period)

where the base line rate is:

- a) for a rating period of seven (7) biweeks or less - 1.5; **114**

- b) for a rating period of more than seven (7) biweeks but less than thirteen (13) biweeks - 1.25; and
 c) for a rating period of thirteen (13) biweeks or more - 1.0.

In each instances set forth below, the designated number of points is added to or subtracted from the base line points:

- 1) Subtract four (4) points for a first valid failure to comply with proper conducting of an interview and/or other contact with the public and subtract six (6) points for a second and each subsequent valid failure to comply with the proper conducting of an interview and/or other contact with the public;
- 2) Subtract two (2) points for a first failure and each second and subsequent failure to process an amendment or communication after final rejection within the prescribed time period; and
- 3) Subtract one (1) point for a first failure and each second and subsequent failure to comply with any other prescribed time period or special handling instruction as set forth in Sections I and II above.

Form CD-396A (Rev. 5-12)

USCOMM-DC 87-1650

Workflow Management

Art Unit: 2615

Fiscal Year: 2012

GS 15 FSA

SECTION 1 - PERFORMANCE PLAN, PROGRESS REVIEW AND APPRAISAL RECORD

Name 0

Date 6/20/2018

Sheet No. 3 of 4

Item 3. Criteria for Evaluation (Use generic performance standards printed in Appendix A. Supplemental performance standards may also be specified below.)

A failure to process an amendment or communication after final rejection shall occur when the same has not been completed by the examiner and submitted for credit within the prescribed time period, and thereafter, when the amendment or communication after final rejection has not been completed by the examiner and submitted for credit within the next, and thereafter, each subsequent prescribed time period after the expiration of the previous prescribed time period.

A failure to comply with any other prescribed time period as set forth in Section I (above) shall occur when the application has not been completed by the examiner and submitted for credit within the biweek in which that application is due. Each second and subsequent failure to comply with any prescribed time period as set forth in Section I (above) shall occur when the applications has not been completed by the examiner and submitted for credit within the next, and thereafter, each subsequent biweek period after the biweek period in which that application was due.

A failure to comply with any other prescribed time period or special handling instruction as set forth in Section II (above) shall occur when the item of work has not been processed and/or handled within the prescribed time period established for the particular application or proceeding. Each second and subsequent failure to comply with any prescribed time period or special handling instruction as set forth in Section II (above) shall occur when the item of work has not been processed and/or handled within the next, and thereafter, each subsequent time period after the time period established for the particular application or proceeding.

4) Add one (1) point for exceptional courtesy to the public and peers throughout any quarter of the fiscal year or equivalent thereof during the rating period;

5) During each biweek, add one-fifth (0.2) point for each application completed by the examiner and submitted for credit within an appropriate response to available amendments responding to non-final Office actions and appeal briefs within one (1) month of their receipt by the examiner. The examiner will not receive this addition if any points are deducted for any other reason under 1-5 above during the biweek period;

6) Add one-half (0.5) point if throughout any quarter of the fiscal year or equivalent thereof during the rating period all responses to an amendment or communication after final rejection are mailed within thirty (30) days of their receipt in the Office. It is Office policy that all responses to these amendments or communications will be mailed within thirty (30) days of their receipt in the Office;

7) Add one-half (0.5) point if throughout any quarter of the fiscal year or equivalent thereof during the rating period all date cases having the oldest effective filing date and the oldest actual filing data are completed by the end of every other biweek period;

Form CD-396A (Rev. 5-12)

Workflow Management

Art Unit: 2615

Fiscal Year: 2012

USCOMM-DC 87-1650

GS 15 FSA

SECTION 1 - PERFORMANCE PLAN, PROGRESS REVIEW AND APPRAISAL RECORD

Name 0

Date 6/20/2018

Sheet No. 4 of 4

Item 3. Criteria for Evaluation (Use generic performance standards printed in Appendix A. Supplemental performance standards may also be specified below.)

8) Add one-half (0.5) point for frequently providing consultation services to the public and peers throughout any quarter of the fiscal year or equivalent thereof during the rating period including: technological advice, fields of search, pulling specific references, and advice with respect to current Office practice and appropriate case law;

9) Add one-half (0.5) point if throughout any quarter of the fiscal year or equivalent thereof during the rating period all typed Office communications are promptly processed and the examiner takes exceptional initiatives to ensure that all such communications are mailed within thirty (30) days of the count date; and

10) Add one-half (0.5) point if throughout any quarter of the fiscal year or equivalent thereof during the rating period all typed communications are mailed within fifteen (15) days of their count date.

An equivalent of any quarter of the fiscal year as used above is either six (6) or seven (7) consecutive biweekly periods within the rating period. However, for any rating period, consecutive bonus quarters of the fiscal year or equivalents thereof may not overlap.

Upon completion of the computations set forth above, a rating is assigned by comparing the point total obtained by the examiner with the following:

<u>Outstanding*</u> :	$\geq 0.92 \times$ base line points for the rating period under consideration
<u>Commendable*</u> :	$\geq 0.81 \times$ base line points for the rating period under consideration
<u>Fully Successful:</u>	$\geq 0.58 \times$ base line points for the rating period under consideration
<u>Marginal**:</u>	$\geq 0.23 \times$ base line points for the rating period under consideration
<u>Unacceptable:</u>	$< 0.23 \times$ base line points for the rating period under consideration

* To obtain a rating at either the outstanding or commendable level, in addition to meeting the requisite point total, the examiner must have met all statutory examination determinations in such proceedings assigned during the rating periods.

** Continued or repetitive performance at this level adversely impacts upon the efficiency of the service under the performance element.

Form CD-396A (Rev. 5-12)

USCOMM-DC 87-1650

Stakeholder Interaction

Art Unit: 2615

Fiscal Year: 2012

GS 15 FSA

SECTION 1 - PERFORMANCE PLAN, PROGRESS REVIEW AND APPRAISAL RECORD

Name 0

Date 6/20/2018

Sheet No. 1 of 2

Item 1. Performance Element and Objective (Identify as Critical or Non-critical, and if it is being tracked at the department level.)

☐ Critical ☒ Non-Critical ☐ Management-by-Objectives (MBO)

Element: V. Stakeholder Interaction

Objective: To provide appropriate service to our stakeholders.

Weighting Factor: (Weights reflect the amount of time devoted to accomplishing the element and/or its importance. Weight for performance plans must total 100.)
Enter Weight for this element in the adjacent box:

10

Item 2. Major Activities (Identify activities or results that need to be accomplished in support of the performance element.)

1. Treat external stakeholders with courtesy and professionalism by:

- a. Returning phone calls from external stakeholders, generally in one business day.
- b. Reviewing email messages generally at least once every workday, and responding, if necessary, by any appropriate means.
- c. Providing normal schedule information via voice mail if working other than a Monday through Friday schedule.
- d. Providing voice mail notice of extended absences of three or more business days.
- e. Directing external stakeholders to appropriate office or person, in accordance with a list provided or posted by Management.
- f. Conducting all interviews and/or other contacts with external stakeholders as scheduled with adequate preparation, and in a courteous manner. Further, no interview and/or other contact is arbitrarily or capriciously refused by the examiner.
- g. Displaying proper decorum in official communications (e.g., Office action or interview summary) to external stakeholders.

Item 3. Criteria for Evaluation (Use generic performance standards printed in Appendix A. Supplemental performance

standards may also be specified below.)

Ratings will be based on demonstrated behavior of the following criteria:

Outstanding - All major activities identified are routinely performed in a timely and courteous manner and, except for rare exceptions, the employee demonstrates all of the identified indicia.

Commendable - All major activities identified are routinely performed in a timely and courteous manner and the employee demonstrates all of the identified indicia in substantially all circumstances.

Indicia:

Optional Initial Block

(continued on next page)

Emp.	Date	Supv.	Date
------	------	-------	------

Form CD-396A (Rev. 5-12)

Stakeholder Interaction

Art Unit: 2615

Fiscal Year: 2012

USCOMM-DC 87-1650

GS 15 FSA

SECTION 1 - PERFORMANCE PLAN, PROGRESS REVIEW AND APPRAISAL RECORD

Name 0

Date 6/20/2018

Sheet No. 2 of 2

- Routinely uses interview practice to facilitate compact prosecution
- Is accessible and responsive regardless of physical location
- Provides appropriate information to address stakeholder inquiries
- Responds to internal stakeholders in a timely manner
- Responds appropriately to requests for personal interviews in a timely manner
- Is always well prepared for interviews

Fully Successful - All major activities identified are normally performed in a timely and courteous manner.

Marginal - Demonstrates some contribution to the element. However, a significant number of documented deficiencies in at least one of the major activities have been identified to the examiner.

Unacceptable - Performance is not adequate for the position, failing to meet the Marginal level. Numerous instances of documented deficiency in at least one of the major activities have been identified to the examiner.

"Business Day" - shall refer to each Monday through Friday except Federal holidays. Business hours shall run from 8:30 A.M. to 5:00 P.M. Eastern Time.

"Work Day" - is defined as a normal Monday through Friday and when the examiner is working for a substantial portion of the day. Such excludes holidays, days in which adjusted work dismissal occurs, day in which "the employees is not expected to work" (or Agency is closed), and days in which employees are excused from duty early.

GS-1224-15

Full Signatory Authority

Art of Masters Level

Generalist

Introduction

The position will be filled on a temporary basis in an electrical technology center. The purpose of this position is to consolidate and process to conclusion sensitive patent examination cases in the electrical arts. This position provides expert technical evaluation for the most difficult and sensitive examination of cases. The incumbent may also be called upon to render technical evaluation in other sensitive cases. The incumbent will be supervised by a Supervisory Patent Examiner. These sensitive cases pose difficult technical and legal problems, frequently involve litigation among various parties, and may be subject to extensive national publicity. This position may not be filled on a permanent basis.

Factor 1, Nature and Extent of Performance of Examining Functions

Incumbent independently performs “Basic”, “Advanced”, and “Legal” patent examining functions with no preliminary instructions from the supervisor. References used to determine whether or not the claimed invention is new and patentable are rarely, if ever, reviewed. All Patent Office actions, including the substantive evaluation in terms of both statutory and precedent law, of the legal sufficiency of the evidence submitted by the applicant are presented to the supervisor in final form for approval, except as modified in Factor II below.

Incumbent’s determinations are reviewed, if at all, for conformance with Patent Office policy only upon final allowance or rejection of an application. This review is normally restricted to such matters as may determine (1) the extent to which the Patent Office will assist or advise inventors and others, or (2) the nature and extent of evidence required to warrant reopening the examination of a case that has previously been rejected.

Factor 2, Contact and Commitment Authority

Incumbent, having been officially delegated FULL SIGNATORY AUTHORITY, makes and effects wholly independent determinations with respect to any Patent Office action--the incumbent’s action or that of another--which does not result in the final allowance or rejection of an application.

Factor 3, Technological Complexity of Art

Art is at the Master’s Level. The art includes all the subject matter for a Technology Center that results in examination of sensitive cases in electrical arts. The examination cases in this art present technological problems at a highly advanced level of difficulty embracing a significant number and diversity of concepts that, on the basis of prerequisites, cannot normally be acquired through an undergraduate education. Such concepts arise in at least 25 percent of the incumbent’s time.

N.B. Since this position is filled only on a temporary basis, no conclusion may be derived from any work assigned under this position description concerning any incumbent’s mastery of the concepts as recognized by supervisors and others.

ADDITIONAL CREDIT, GENERALIST:

The incumbent acts in a Generalist capacity since the subject matter area of this work equates, in terms of technological complexity, to no less than Level B of Factor III and embraces all arts in a Technology Center. The incumbent acts as a “troubleshooter” with respect to examination of sensitive cases. In addition, the incumbent has demonstrated a foundation in patent examining functions at least the equivalent of that described at Level B of Factor I.

N.B. Although this position is classified with respect to the Generalist criteria, because it is to be filled only on a temporary basis, no conclusions may be drawn concerning any incumbent’s personal qualifications, capacities, and recognized professional stature.

Full Signatory Authority

Art of Masters Level

Generalist

FACTOR LEVELS AND POINTS CREDITED:

Factor 1:	Level:	<u>A</u>	;	Points:	<u>45</u>
Factor 2:	Level:	<u>F</u>	;	Points:	<u>15</u>
Factor 3:	Level:	<u>A</u>	;	Points:	<u>10</u>
EXTRA CREDIT ITEM:		<u>G</u>	;	Points:	<u>5</u>

Total Points:	<u>75</u>
Grade:	<u>15</u>

Exhibit EE

**UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA**

GILBERT P. HYATT,
Plaintiff,

v.
MICHELLE K. LEE,
Defendant.

Civil Action No. 1:09-cv-1864 (RCL)

FILED UNDER SEAL

GILBERT P. HYATT,
Plaintiff,

v.
MICHELLE K. LEE,
Defendant.

Civil Action No. 1:09-cv-1869 (RCL)

FILED UNDER SEAL

GILBERT P. HYATT,
Plaintiff,

v.
MICHELLE K. LEE,
Defendant.

Civil Action No. 1:09-cv-1872 (RCL)

FILED UNDER SEAL

GILBERT P. HYATT,
Plaintiff,

v.
MICHELLE K. LEE,
Defendant.

Civil Action No. 1:05-cv-2310 (RCL)

FILED UNDER SEAL

DEFENDANT’S MOTION TO DISMISS FOR PROSECUTION LACHES

Pursuant to Rule 41(b) of the Federal Rules of Civil Procedure, Defendant hereby moves this Court, by and through undersigned counsel, for an order dismissing the complaint with prejudice due to Plaintiff’s conduct and delay in pursuing his patent applications, which forfeits Plaintiff’s right to a patent and which would render any patent that may issue unenforceable due to prosecution laches. The facts and law supporting this Motion are set forth in the accompanying Memorandum. A proposed order granting the requested relief is attached.

Dated: September 30, 2016

Respectfully submitted,

CHANNING D. PHILLIPS, D.C. Bar #415793
United States Attorney
for the District of Columbia

DANIEL F. VAN HORN, D.C. Bar #924092
Chief, Civil Division

By: /s/ Carl E. Ross

CARL E. ROSS, D.C. Bar #492441
Assistant United States Attorney
ROBERT E. McBRIDE, D.C. Bar #488172
Special Assistant United States Attorney
ROBERT J. McMANUS, D.C. Bar # 472414
Special Assistant United States Attorney
THOMAS W. KRAUSE, D.C. Bar #430552
Special Assistant United States Attorney
Civil Division
555 Fourth Street, NW
Washington, DC 20530
Tel: 202.252.2533
Fax: 202.252.2599
Email: Carl.Ross@usdoj.gov

Counsel for Defendant

CERTIFICATE OF SERVICE

I hereby certify that on September 30, 2016, the attached Defendant's Motion to Dismiss, Memorandum of Points and Authorities, and all Exhibits thereto, were delivered electronically to the following counsel for Plaintiff:

Aaron M. Panner
Thomas B. Bennett
KELLOGG, HUBER, HANSEN, TODD, EVANS & FIGEL, P.L.L.C.
1615 M Street, N.W., Suite 400
Washington, D.C. 20036
apanner@khhte.com
tbennett@khhte.com

/s/

CARL E. ROSS
Assistant United States Attorney

**UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA**

GILBERT P. HYATT, Plaintiff, v. MICHELLE K. LEE, Defendant.	Civil Action No. 1:09-cv-1864 (RCL)
GILBERT P. HYATT, Plaintiff, v. MICHELLE K. LEE, Defendant.	Civil Action No. 1:09-cv-1869 (RCL)
GILBERT P. HYATT, Plaintiff, v. MICHELLE K. LEE, Defendant.	Civil Action No. 1:09-cv-1872 (RCL)
GILBERT P. HYATT, Plaintiff, v. MICHELLE K. LEE, Defendant.	Civil Action No. 1:05-cv-2310 (RCL)

ORDER

Upon Consideration of Defendant's Motion to Dismiss for Prosecution Laches, for good cause shown, and the entire record herein, it is hereby **ORDERED** that the motion is **GRANTED** and the Complaint in each of the above-captioned cases is dismissed with prejudice due to Plaintiff's unreasonable delay in prosecution of the underlying patent applications, which serves to forfeit Plaintiff's right to a patent and would render any patent that may ultimately issue unenforceable under the doctrine of prosecution laches.

It is **SO ORDERED** this _____ day of _____, 2016.

Royce C. Lamberth
United States District Judge

Exhibit FF

